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No. 94-

IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

ROBERT W. KEARNS,

Petitioner,

v.

CHRYSLER CORPORATION, and
AMERICAN MOTORS CORPORATION,

Respondents.

On Petiton for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

ROBERT W. KEARNS, Ph.D.
Manufacturing-Inventor
301 Houghton Laboratory Lane
Queenstown, Maryland 21658
(410) 827-9337

PRESS OF BYRON S. ADAMS, WASHINGTON, D.C. 1-800-347-8208

354 PP

QUESTIONS PRESENTED

(1) Whether 35 U.S.C. § 281 civil actions are to remedy the public's interest in the patent system from acts of patent infringement?

(2) If they are, whether available patentee remedies permit the remedy of the public interest?

(3) When the Court accepts under 35 U.S. Code § 281 the inventor's Complaint which does not come to trial for 17 years, whether the inventor has "lost" his Constitutional standard of compensation - 'time?'

(4) Whether a patent must be within its routine-'time' at the start of trial for the Court to secure the inventor's Constitutional standard of compensation - 'time?'

(5) Whether an equitable remedy for Dr. Kearns will include Article 46 *Other Remedies* of GATT? (*See* p. 66.)

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PETITION FOR WRIT OF CERTIORARI

Petitioner, Robert W. Kearns, ("Dr. Kearns") prays that the Court issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit ("CAFC") in *Robert W. Kearns* v. *Chrysler Corporation and American Motors Corporation*, No. 93-1470 (August 11, 1994).

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported as *Robert W. Kearns* v. *Chrysler Corporation and American Motors Corporation*, xxx F.2d xxx (1994), and the No. 93-1470 portion of the CAFC opinion is attached to this petition at Appendix A ("A-A"). The district court's Final Judgment of the No. 82-70748 portion of the opinion is attached at (A-B).

JURISDICTION

The Court of Appeals opinion and judg-

ment was entered on August 11, 1994. Dr.Kearns' Suggestion for Rehearing in Banc was filed on August 25, 1994 and was declined by the CAFC on September 28, 1994. On November 3, 1994 Dr. Kearns filed an application for enlargement of times to file a petition for writ of certiorari in *Kearns* v. *General Motors Corp.* (now No. 94-1106) and to file this petition in *Kearns* v. *Chrysler Corporation and American Motors Corporation* and for the two petitions to be serialized. (A-L) The application was granted by order of this Court to and including January 26, 1995. Jurisdiction to review the judgment by writ of certiorari is conferred upon the Court by 28 U.S.C. § 1254(1) (1988). The district court had jurisdiction over the claim in the first instance under the provisions of 35 U.S.C. § 1338(a) (1970).

CONSTITUTIONAL PROVISION INVOLVED

Article I, Section 8, Clause 8

"The Congress shall have the power:

> To promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

TREATY INVOLVED

General Agreement on Tariffs and Trade ("GATT") to the Uruguay Round Agreements was signed on April 15, 1994, submitted to Congress on September 27, 1994 and enacted on January , 1995 and includes in relevant part at (15) The Agreement on Trade-Related Aspects of Intellectual Property Rights which in turn includes in relevant part:

PART I
GENERAL PROVISIONS AND BASIC PRINCIPLES

Article 1
Nature and Scope of Obligations

1. Members shall give effect to the provisions of this Agreement. Mem-

bers may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement. Members shall be free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

PART III
ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS
SECTION 1: GENERAL OBLIGATIONS

Article 41

1. Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements. These procedures shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Article 46
Other Remedies

In order to create an effective deterrent to infringement, the judicial authorities shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to avoid any harm to the right holder, or, unless this would be contrary to existing constitutional requirements, destroyed. The judicial authorities shall also have the authority to order that materials and implements the predominant use of which has been in the creation of the infringing goods be, without compensation of any sort, disposed of outside the channels of commerce in such a manner as to minimize the risks of further infringements. In considering such requests, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

STATUTES INVOLVED

35 U.S.C. § 281, Patents, provides:

§ 281. Remedy for infringement of patent: A patentee shall have remedy by civil action for infringement of his patent. July 19, 1952, c. 950, § 1, 66 Stat. 812.

35 U.S.C. § 283, Patents, provides:

§ 283. Injunction: The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable. July 19, 1952, c. 950, § 1, 66 Stat. 812.

SIXTH CIRCUIT RULE INVOLVED

That a Senior Judge cannot adjudge a case outside his district if a case on his docket is there for more than five years.

TITLE 28 § 1654 RULE INVOLVED

§ 1654. Appearance personally or by counsel

In all courts of the United States the parties may plead and conduct their own cases personally or by counsel as, by the rules of such courts, respectively, are permitted to manage and conduct causes therein. (As amended May 24, 1949, c. 139, § 91, 63 Stat. 103.)

STATEMENT OF THE CASE

This case entails

This case entails the annals of invention[1] by a boy who grew up in a working-class neighborhood in the shadow of the largest industrial complex in the world. When a young man, he gradually saw a specific mechanism written in the U.S. Constitution for the people to use to gain equal rights, equal opportunities, and, for himself, an entering wedge into that industry where he too could bring improvements to the public through his manufacturing enterprise while providing secure jobs for his employees and a higher standard of living for his neighbors.

What he saw first was:

The Congress shall have the power:

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[1] *The New Yorker*, Annals of Invention: Windshield-wiper wars: *The Flash of Genius* by John Seabrook, January 11, 1993 issue.

> "To promote the progress of science and the useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Const. Art. I § 8 Cl. 8

What he saw second was:

> "(T)he patent system provides a **protected market** with the opportunity for **unusual profit** necessary to justify the heavy investment in time, effort, and capital necessary to bring the improvement to the public. This same **protected market** provides an **entering wedge** by which a business enterprise entering a new field can overcome the obstacles that otherwise discourage entry into an industry already populated[2]." page 5 of Study No. 2 of the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary, 84th Cong., 2d sess. (**1957**), entitled *The Patent System and the Modern Economy*.

In **1957** he founded Kearns *Engineers* to manufacture the U.S. and foreign patented products he invents.

35 patents in Intermittent Windshield Wiper Systems

Dr. Kearns has been awarded 29 U.S.

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[2] Congressional Library Microfilm #11997.

patents. Nominally, he has been awarded 12 foreign patents with other foreign patents pending. Thirty-five (35) of those patents and the foreign patents pending are in the art of Intermittent Windshield Wiper System ("IWWS").

Dr. Kearns has never licensed any of the patents he has been awarded.

Computer Central© exported to France and Japan

Dr. Kearns has supplied one of his patented inventions to Chrysler's Missile Division.

Dr. Kearns supplied with his quotation to Chrysler Corporation's purchasing department 20 pre-production IWWS electronic modules that Kearns *Engineers* personnel pre-tested against Chrysler Performance Standard PS-6338.

Dr. Kearns supplied with his quotations to both Daimler-Benz ("Mercedes") Aktien-

gesellschaft; and, to Dr. Ing. h.c.f. Porsche A.G. two of the pre-production IWWS electronic modules. Dr. Kearns demonstrated his IWWS to personnel of the Ford Motor Company, Chrysler Corporation and General Motors Corporation among others.

He supplied another of his inventions[3] from 1964 through 1978 to companies and universities located throughout the U.S. (CAFC Appendix pp. 904 to 1445) and through export licenses issued by the U.S. Department of Commerce to France and Japan (A-N).

Civil actions

Dr. Kearns demonstrated the external features of his IWWS to Ford and Chrysler engineers in October 1963. Dr. Kearns

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[3] Dr. Kearns' manufactured-inventions were sold under the U.S. trademark *Computer Central*© as shown at (A-M).

demonstrated the features of his IWWS to an array of personnel of General Motors Corporation and built his IWWS into a General Motors' model of automobile. Dr. Kearns was awarded a doctorate in engineering from Case Institute of Technology the following June.

IWWS are assembled into models of every automobile assembled in the western world. Dr. Kearns sought IWWS supply contracts from every automobile assembler in the western world. Through infringement of Dr. Kearns' patents each automotive assembler in the western world controls its segment of the market comprising the industry. (A-O)

Dr. Kearns has or maintains civil actions for infringement against every assembler of automobiles in the western

world except Fiat[4]. Dr. Kearns had positioned himself to be a major supplier of IWWS to the automotive industry if his U.S. patents were enforced under 35 U.S.C., as acknowledged by District Judge Pratt in denying Dr. Kearns his Motion for a Preliminary Injunction filed in 1979. (A-P)

Adjudged infringers

The Ford Motor Company lawyers admitted that all 20.5 million of their electronic IWWS sold, which included IWWS sold by Ford to American Motors Corporation, infringed Dr. Kearns' patents if his patents were valid. Chrysler Corporation and American Motors Corporation lawyers stipulated to be bound by the validity trial in *Kearns* v. *Ford Motor Co.*, 726 F. Supp. 59 (E.D. Mich. 1989) ("*Ford*"). The

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[4] Fiat no longer does business in the U.S.

Ford jury found all six of Dr. Kearns' U.S. patents litigated in that trial to be valid. The *Chrysler and American Motors* jury found all four of the six *Ford* patents litigated in the *Chrysler and American Motors* trial to be infringed. Dr. Kearns, his lawyers, and, his patent expert found in preparing for the *Kearns* v. *General Motors* trial that General Motors Corporation infringed 207 claims of nine of Dr. Kearns' U.S. patents.

All the civil actions were filed in the District Court in Detroit since Dr. Kearns hired in 1977 Harness, Dickey & Pierce of the Detroit area to be his trial lawyers; founded Kearns *Engineers* in Detroit; developed and invented his IWWS in Detroit; and his employees who witnessed his IWWS developments and inventions were living in the Detroit area.

Kearns *Engineers* expansion

In 1957 at age 30, Dr. Kearns, with only his Masters (M.S.E.M.), founded Kearns *Engineers* in Detroit, Michigan to manufacture and sell his patented products. In 1958 Kearns & Law *Engineers* expanded to Livonia, Michigan. (CAFC A-1122) In 1960, Kearns & Law *Engineers* expanded a second time back into Detroit, Michigan. (CAFC A-1098)

Seeking specifications

On October 29, 1963, Dr. Kearns contacted management at the Chrysler Engineering Center in Highland Park, Michigan to speak to windshield wiper engineers to obtain engineering specifications of the automotive environment to complete his work on Intermittent Windshield Wiper Systems ("IWWS").

Management first required Dr. Kearns to sign a Non-Confidential Disclosure Agreement. That Agreement stated that Chrysler

would "respect valid U.S. patents." Dr. Kearns signed the Agreement and, secondly, at the request of management, demonstrated to four managers of Product Planning for each car line, the external features of his IWWS which he had installed on a 1962 Ford Galaxie convertible. That IWWS provided a continuously-variable continuous speed driver-rotated control in the continuous position of the driver-controlled-wiper-switch and a variable-dwell continuously-variable continous dwell period in the 'park' position with the same driver-rotated control when the driver-controlled-wiper-switch was in the intermittent position.

Third, management allowed Dr. Kearns to talk to the windshield wiper lab supervisor and his assistant, but they provided no specifications to Dr. Kearns.

The week before Dr. Kearns went to Ch-

rysler seeking specifications, he had gone twice to the Ford Motor Company engineer-ing center seeking automobile environmental specifications for his IWWS. Again, Dr. Kearns was required to sign a Non-Confidential Disclosure Agreement prior to talking to their engineers. Ford's Agreement said they would honor U.S. patents. Accordingly, Dr. Kearns signed that Agreement and demonstrated his IWWS to Ford general parts division management and numerous windshield wiper engineers.

Dr. Kearns learned during the demonstrations that the environment under the hood was 270° F. and that the wiper motor had to be subjected to 3 million cycles in a life test. Mr. Neill, the manager, requested an approximate price for an IWWS.

Disappointed, as he had expected more specifications, Dr. Kearns went to

Chrysler, was disappointed again and returned to his laboratory where he succeeded on June 29, 1964 in being able to adapt his IWWS technology for any temperature and then started his life test which completed 3.4 million cycles on November 16, 1964. He filed a specification for his first IWWS U.S. patent on December 1, 1964.

Subcontractor agreements

During this time, Dr. Kearns and his family started to manufacture and sell through Kearns *Engineers* other of his patented products throughout the USA (CAFC A-1389-1424) under the trademark *Computer Central*©. (CAFC A-904-947) Still later, Dr. Kearns and his family, through export licenses issued by the U.S. Department of Commerce sold the *Computer Central*© patented products in France and Japan. (CAFC A-604) Dr. Kearns advertised

his patented products in technical magazines. (CAFC A-1369 to 1385)

Dr. Kearns' IWWS patents Constitutionally permit him the exclusive right to supply a IWWS sub-assembly for automobile-assembler installation.

Accordingly, in an effort to set up the manufacturing of Dr. Kearns' products, Dr. Kearns, through Kearns *Engineers,* entered into agreements: on 30 November 1964, with Prestolite company officials for them to supply 3-brush permanent-magnet field windshield wiper motors (CAFC A-1091-093); on July 11, 1967 with Lake Center Switch to design and build prototype driver-actuated-controls for his IWWS which they would supply (CAFC A-1082); and, on October 6, 1967 with Essex Wire to supply IWWS wiring harnesses (CAFC A-1096).

With the agreement of these sub-contrac-

tors and Dr. Kearns' IWWS patents, Kearns *Engineers* was prepared to manufacture and supply IWWS sub-assemblies in volume to automobile-assemblers worldwide.

Moisture responsive dwell time = safety

Dr. Kearns' filed specification claims were based upon: synchronizing the operations of the IWWS with the position of the wiper blade on the windshield to achieve an intermittent dwell period in the 'park' position outside the vision of the driver with minimal circuitry that was independent of the engine; a continuously-variable continuous wiping feature that used the same driver rotary control for both setting the time period of the intermittent dwell in the INTERMITTENT driver-switch position and set the continuous speed of the wiper blade in the CONTINUOUS driver-switch position; and, as the number of raindrops *in the wiped*

viewing area increased between each wiping stroke to a threshold number, the IWWS would automatically leave intermittent operation and operate in continuous speed.

This feature ensured the clearest visability thereby increasing the publics' safety.

Accordingly, Dr. Kearns considered the INTERMITTENT feature without the moisture responsive feature not to be as safe as the continuous wiping feature in the rain. The IWWS without the 'safety' moisture responsive feature is the product being used throughout the western world to this date.

Kearns' contacts with Chrysler engineers

On December 9, 1964, Dr. Kearns again demonstrated his IWWS to Chrysler personnel from Depts. 3840, and 3880. He gave them a complete system schematic

engineering drawing which document (CAFC A-134) showed "Dept. 3840 has received a system schematic and is reviewing it."

Dr. Kearns visited Chrysler Engineer Mr. S.R. Ward on 16 January 1965, and received a copy of Mr. Ward's drawing showing Dr. Kearns' IWWS in a Chrysler windshield wiper system. (CAFC A-140)

On February 5, 1965, an IWWS in Chrysler cars "had been approved by all concerned." (CAFC A-146)

Dr. Kearns had designed his IWWS for the Barracuda at Chrysler's request and he had installed it in a car for Chrysler testing.

Mr. Bouwkamp, Chief Engineer & Manager of Dodge Product Planning wrote to David Tann and Dr. Kearns that he had been testing the car with Dr. Kearns' IWWS for nine months. (CAFC A-147)

Kearns' PROPOSED CHRYSLER

CIRCUITS report to Chrysler

On November 17, 1967, Mr. Glen Farison, a Chrysler engineer, reported to Chrysler's Chief Patent Counsel Mr. Baldwin information on Dr. Kearns' IWWS which he had learned from other Chrysler engineers. (CAFC A-148) Mr. Farison was given permission by Mr. Baldwin to "look at the device." On May 2, 1968, Mr. Farison reported to the Chief Patent Counsel Mr. Baldwin that "There were assertions they (Dr. Kearns) had IWWS pretty well patented."

On May 1, 1968, Dr. Kearns had prepared a "Chrysler Circuits and Report for Mr. Farison" (CAFC A-151) (The PROPOSED CHRYSLER CIRCUITS and PATENTABILITY FEATURES REPORT is given at CAFC A-154). Fig. I-1 (CAFC A-158) will be important later. The PROPOSED CHRYSLER CIRCUITS and a letter listing "IWWS Features and Model

Numbers" were delivered to Mr. Farison by Dr. Kearns on June 6, 1968.

Santo-Orris meeting on Kearns' patents

On June 17, 1968, a Chrysler engineer, Mr. Chunn, from the Huntsville, Alabama Missile Division submitted a capacitor-silicon controlled rectifier timing element concept for Chrysler's IWWS. (CAFC A-186) This element would never appear in Chrysler's models.

Meanwhile, on February 23, 1972, Ford lawyers first raised the defense of Dr. Kearns' patents invalidity. Later, Chrysler's lawyers signed a stipulation with Dr. Kearns' lawyers to be bound by the validity challenge by Ford Motor Company lawyers.

On May 23, 1974, in Chrysler's Sourcing Committee Presentation, it was acknowledged that Chrysler's premium WWS was 3-continuous-speeds while Chrysler's compe-

titors used 2-continuous speeds plus intermittent. They predicted a "recurring profit of $13.4 million annually" from the use of IWWS. In order to stay competitive and increase profits, Engineering was ordered to develop and tool IWWS for Job #1 1976 models as that was desired by Product Planning. (CAFC A-198)

In 1968, SWF-Specialfabrik fur Autozebehor Gustav Rau G.m.b.H., a corporation of the Federal Republic of Germany, had obtained from the U.S. Patent Office, at the cost of 50¢, a copy of Dr. Kearns' '836 patent. It then circulated this patent among its engineers and six months later was supplying IWWS to Mercedes and Porsche. Once Mercedes recognized and admitted that it was infringing on Dr. Kearns' patents, it asked Dr. Kearns for a quote of production of 505,000 IWWS for its worldwide market. (CAFC A-481-584)

Kearns *Engineers* quoted Mercedes a cost averaging $5.74 per unit for 505,000 units; Porsche a cost averaging $8.20 per unit for 44,000 units; and Chrysler a cost averaging $8.25 with mounting brackets per unit for 556,000 units with an additional $67,000 for tooling. (CAFC A-587, 589, and 1032, respectively)

In response to the internal Chrysler order, on June 14, 1974, Chrysler engineer, Mr. Orris, submitted a patent disclosure for IWWS based on two capacitor to ground transistor timing and one silicon-controlled rectifier designs. (CAFC A-201)

On June 16, 1974, a SOURCE PLANNING LETTER was released by Chrysler's management for a 2-speed IWWS for Job #1, 1977 model year (which is in dealer's showrooms by August, 1976). This release officially ordered Engineering to devise a 2-speed IWWS for the 1977 Chrysler mod-

els.

Chrysler establishes $500,000 fund for patent liability

On July 10, 1975, Mr. Santo, called Mr. Orris and a Mr. Gohkole to his office to disuss the patent implications and status of the intermittent wipe program for 1977 in relation to management's source planning letter of June 16, 1975.

During that meeting Mr. Santo reviewed Dr. Kearns' patents with them. He identified three specific patents that he thought "involved on the controller portion for the intermittent wipe system per se." Dr. Kearns' 3,351,836 (intermittent system); 3,564,374 (capacitor between motor-driven switch and transistor input); and, 3,581,178 (transistor to relay motor drive and brake with 3-brush 2-speed wiper motor). In view of the patent liability, Mr. Santo proposed a $500,000

fund be set up "for when the patentees would present a charge of patent infringement." (CAFC A-368)

Fourteen days later, on July 24, 1975, Mr. Santo wrote to engineering the results to date of his patent investigation. The three Chrysler IWWS designs developed over the past two years had "objectional aspects" (CAFC A-376) found by the Huntsville, AL reliability engineers (CAFC A-365) and that Huntsville proposed a fourth design. Mr. Santo informed engineering that regardless of which of the four designs were used

> "there are at least two known circuit patents and at least one possible additionally known circuit patent that may affect the controller portion of the intermittent wipe proposal (1)."

Mr. Santo advised Engineering that he had recommended $500,000 and $250,000 funds be established for patent liability.

A memorandum by F. Zubrzycki of Dept.

3840 dated August 8, 1975 confirmed Chrysler management had established the $500,000 fund. (CAFC A-388) [Chrysler presented no evidence at trial that management had ever withdrawn the $500,000 patent liability fund.]

Orris 'conceives' Fig. I-1 of PROPOSED CHRYSLER CIRCUITS report

Meanwhile, four days later or 19 days after the July 10, 1975 Santo-Orris-Gohkole meeting, Mr. Orris 'conceived' as his own (on p. 2) the totality of Mr. Farison's report of Kearns' CHRYSLER PROPOSED CIRCUIT Fig. I-1; Kearns' '836 Fig. 1; Kearns' '178 Fig. 1 (CAFC A-381) of Orris' (p. 1) schedule (CAFC A-380) of

> "Phase I circuit must be received by 29 September 1975 with prototype samples by 5 January 1976."

Dr. Kearns submitted Fig. I-1 to Chrysler because their wiper motor used a one-movable-contact one-stationary-con-

tact motor switch. On August 11, 1975 Mr. Orris made the final conception circuit shown at CAFC A-390.

Santo says, Kearns' '836, '374 and '178 may be infringed by Orris

On May 6, 1967 Mr. Santo issued a CONFIDENTIAL ATTORNEY OPINION (CAFC A-390) that included Dr. Kearns' '836, '374 and '178 circuits as possible infringements and went on to include all Dr. Kearns' patents in the opinion at CAFC A-409, with Mr. Santo relying on a Hopper 2,327-,791 patent to invalidate the Kearns '374 patent.

Copying: Similarity plus access to electronic model or to electronic schematic?

Notice there is no #58 resistor in series with the input of the transistor as is shown in Kearns' '178 Fig. 1. On January 5, 1979 an Engineering Change Order was issued to install the missing #58 resistor. Three weeks later, on January

25, 1979, a second Engineering Change Order was issued to install the one-movable contact two-stationary contact switch on the motor the same as that used by Dr. Kearns in his '178 Fig. 1. With two Engineering Change Orders the imperfect copying of Mr. Orris was now perfected and Dr. Kearns' patents were once again being infringed!

On May 15, 1992, a hearing was held at which Judge Cohn threw out the Kearns' copying charge. Chrysler's Mr. Conley argued that in the law of copying the product itself, not the schematic drawings, had to be copied citing *Windsurfing International, Inc.* v. *AMF, Inc.*, 782 F.2d 995, 1003 n.12 (Fed. Cir.), *cert. denied*, 477 U.S. 905 (1986). It was further argued that Mr. Orris' role and environment was that of a monastic priest whom Chrysler isolated from the other

Chrysler engineers and files thereby denying Mr. Orris access to any of Dr. Kearns' models. Judge Cohn agreed with this argument and instructed the jury to disregard the copying issue that Dr. Kearns' lawyers had been pursuing. On May 19, 1992, Dr. Kearns responded with a Motion to Litigate Similarity as a Basis for Copying (Docket Event #448) pointing out that in transistorized electronic circuits the copier would not copy the product but would draw an electronic schematic engineering drawing of the product to be copied in real life as a first part of the copying process. But Judge Cohn said his ruling was behind us and that Dr. Kearns' point of copying a schematic instead of the product could always be appealed.

In *Ford*, Ford Motor Company never claimed to have an inventor for its IWWS.

In *Chrysler*, Chrysler claims that Mr. Orris is the inventor of their IWWS technology. In testifying in the *Chrysler and American Motors* case, the appearance of Mr. Orris was scheduled in relation to the demands of Mr. Orris' employer - who was **not** Chrysler.

Entitlement to equitable relief for Kearns hearing denied

What stimulated Dr. Kearns' inventions of the IWWS, and what Dr. Kearns believed came out at trial in Dr. Kearns' cross-examination of Chrysler Corporation and American Motors Corporation expert, George Frost, the elderly past Chief Patent Counsel of General Motors Corporation, at Transcript p. 2581. (A-V)

* * *

In the *Ford* trial, Dr. Kearns' trial lawyer, Mr. Aitken, submitted a Motion for an Evidentiary Hearing at which he

would present evidence of Dr. Kearns' right to equitable relief under 35 U.S.C. § 283. Judge Cohn denied the Motion.

In *Chrysler*, Chrysler lawyers moved the Court for summary judgment on the matter of equitable relief for Dr. Kearns (Docket Event #263) ORDER (Equitable Relief) which Judge Cohn granted (Docket Event #293).

Bring judgment into accord with USA's position on GATT

Dr. Kearns moved the Court to alter or amend that Order (Equitable Relief) (Docket Event #305) followed by a supplement Motion for Reconsideration of the ORDER (Equitable Relief) (Docket Event #310); followed by a second Motion for Reconsideration of ORDER (Equitable Relief) (Docket Event #360); followed by a Motion to Yet Allow Evidence to Grant Dr. Kearns Equitable Relief to Bring Judgment into

Accord with the USA's Position Under the General Agreement on Tariffs and Trade in the Uruguay Round (Docket Event #653) which was dismissed as frivolous. On April 15, 1994, the USA signed the GATT Treaty which was sent to Congress for approval on September 27, 1994 and approved by Congress on January , 1995.

On February 24, 1992, Judge Cohn entered summary judgment on Dr. Kearns' claims for lost profits (Docket Event #292) opining:

> "[I]nventor's assertion of the right to loss of profits are not so different than in *Kearns* v. *Ford Motor Co.*, 726 F. Supp. 59 (E.D. Mich. 1989).

* * *

Whether the District Court erred when it granted summary judgment based upon inventor's assertion of the right to loss of profits are not so different than in *Ford* that occurred more than two years

earlier and inventor had discharged for cause his *Ford* lawyers who had not submitted then the loss of profits evidence available?

Dr. Kearns sought reconsideration of the ORDER (Lost Profits) (Docket Event #347); followed by a Request for Reconsideration of the Memorandum and Order of October 2, 1992.

* * *

REASONS THIS WRIT SHOULD BE GRANTED

With Kearns = 60 to 250 thousand $25,000 per year jobs

Dr. Kearns, the inventor of IWWS, is in the Supreme Court to inquire whether the public interest in the patent system is to be received through the inventor's remedy. If the answer is "Yes," 60,000 to 250,000 $25,000 per year (on-average) jobs would be created through Kearns

Engineers; the US foreign exports would increase by 4.8%; the purchasing power of the dollar would rise; and, the standard-of-living of the average person in the United States would drastically improve!

Ford, Chrysler and General Motors cannot achieve this result, and have not done so over the past 27 years since the first infringing IWWS came on the market in 1968. The former-'Big-3' have denied Kearns *Engineers* as a supplier of IWWS by internally supplying only the USA portion (at an 82% profit margin[5]) of the world-wide market, a market recognized but satisfied only by Dr. Kearns' 35 IWWS foreign and U.S. patents that include improved public driving safety which the former-'Big 3' and foreign designers had ignored. Only Dr. Kearns at this time,

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[5] Testimony of Dr. Robert W. Crandall, Brookings Institution of Washington, D.C. (A-Q)

can achieve these results as will be shown *infra*.

For Public to receive their interest benefits requires § 283 remedy

Title 35 U.S. Code **§ 281.**

Remedy for infringement of patent

"A patentee shall have remedy by civil action for infringement of his patent."

§ 281 proffers a remedy only to the inventor but the following cases cite that the public interest is dominant or of equal importance with the inventor's interest.

"[I]t is not the private use but ... the public interest which is dominant in the patent system[6]." *Mercoid Corp.*

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[6] *Pennock* v. *Dialogue*, 2 Pet. 1; *Kendall* v. *Winsor*, 21 How. 322, 329; *Adams* v. *Burke*, 17 Wall. 453; *Motion-Picture Co.* v. *Universal Film Co.* 243 U.S. pp. 510-511; *Morton Salt Co.* v. *G.S. Suppiger Co.*, 314 U.S. 488, 493; *United States* v. *Masonite Corp.*, 316 U.S. 265, 278 ... The patent is a privilege. But it is a privilege which is conditioned

v. *Mid-Continent Co.*, 320 U.S. 661, 665.

Dawson Chem. Co. v. *Rohm and Haas Co.*, 448 U.S. 176, 221 (1980), reflects a shift towards recognition that the patent holder's rights and the public interest should be accorded equal weight in deciding patent cases.

The only remedy the patent law provides against infringement is to the patentee under §281. The patentee can only receive **§283 Injunction** relief and **§284 Damages** relief. **§284 Damage** relief is money to the inventor. Neglecting taxes, that money to the inventor does not return to the USA public its interest in the USA invented-product.

Where the invented-product is infringed and sold in high volume in a market segment controlled by the infringer within the worldwide market, the only place left for the public to gain its rightful in-

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by a public purpose ..."

terest from the invented-product under 35 U.S.C. is through a **§283 Injunction** remedy to the inventor. An injunction would enable the inventor to supply the present markets in the USA with the aid of his foreign patents.

Although the USA infringers could try to sell the invented product to others operating in their own segment of the worldwide market, they do not have the interest, bases for a legal right nor the patent base on which tc support the effort. But if the inventor manufactured and made those sales, as is his Constitutional right, the public would gain the extra jobs income; the benefits of more balanced/surplus foreign trade; higher purchasing power for each dollar; and, a higher standard-of-living.

With each USA and foreign infringer having control of its segment of the

worldwide market, upon expiration of Dr. Kearns' patents, the inequality in favor of 'foreign' families is locked-in to the permanent trade deficit result. There is no other person than Dr. Kearns with the patent bases to achieve the USA market. That market, being 50% of the worldwide market, offers economies of scale to supplement Dr. Kearns' foreign patents.

But, if this Court finds the above scenario-position by infringers at this stage of the civil action, each of whom are controlling their segment of the worldwide market, is a violation of Dr. Kearns' right secured by patent under the principles of equity and should be prevented both for the sake of the inventor and the public, then a § 283 injunction must be entered against at least Ford, Chrysler and American Motors.

This equitable result requires that the

Kearns IWWS patents be shown to be 'alive' against at least the adjudged and alleged infringers in the alleged infringers' civil actions being pursued. The reasoning roadmap to argue that Dr. Kearns' patents are alive resumes *infra* at p. 56 after we present conflicting opinions which effect how we proceed that this Court may choose to resolve.

Conflicting opinions

* I *

CAFC Decision at p. 19, line 23, says Dr. Kearns has lost his 'time' because:

> "Here, all the asserted patents expired before the commencement of trial. Therefore, Kearns "can no longer obtain injunctive relief with respect to [those patents]." *See Kinzenbaw* v. *Deere & Co.*, 741 F.2d 383, 386, 222 USPQ 929, 931 (Fed. Cir. 1984), *cert. denied*, 470 U.S. 1004 (1985); *See also Standard Oil Co.* v. *Shokuba Kagaku Kogyo, Ltd.*, 754 F.2d 345, 347, 224 USPQ 863, 865 (Fed. Cir. 1985).

But the page-break may have confused the

CAFC at *Kenzenbaw* p. 386, because on turning to p. 387, it is made clear the Keeton Patent was not enforceable because it was the subject of a Settlement Agreement entered into on April 1, 1983, a year before it expired. While Standard Oil was not entitled to a remedy because the last infringing acts of Shokuba occurred more than six years before the filing of the Complaint.

35 U.S.C. § 281 makes clear the remedy to the patentee is available upon the start of the civil action. Dr. Kearns filed suit against Chrysler in 1982 before any of his IWWS patents expired and while the infringements by Chrysler and all the other defendants were on-going.

> "Grounds of equitable relief may arise other than by way of injunction." *Root* v. *Lake Shore, etc. R. Co.*, Ill. 1882, 105 U.S. 189.

The "purpose of the United States [is] . . . to confer on the authors

of useful inventions the exclusive right in their inventions." *Grant* v. *Raymond*, 31 U.S. 218, 241 (1832).

"The fundamental requirements for an injunction in the federal courts are a showing that one party will suffer irreparable harm unless the other party is restrained from taking a threatened action and that there is no adequate remedy at law. *Gilley* v. *U.S.*, 649 F.2d 449, 454 (6th Cir. 1981). *See, e.g., Weinberger, supra*, 456 U.S. at 312 ("The Court has repeatedly held that the basis for injunctive relief in the federal courts has always been irreparable injury and the inadequacy of legal remedies"). "An 'adequate remedy at law' is a remedy that is plain and complete and as practical and efficient to the ends of justice as the remedy in equity by injunction." *USACO Coal Co.* v. *Carbomin Energy, Inc.*, 689 F.2d 94, 99 (6th Cir. 1982). Moreover, "[i]n exercising their sound discretion, courts of equity should pay particular regard for the public consequences in employing the extraordinary remedy of injunction." *Weinberger, supra* at 312. "...the extended time or lack thereof could directly effect the economic interests of the United States. Further, a negative result will have a chilling effect on United States' inventors as our unfair trading partners will simply sit it out

and reap the fruits of American ingenuity.[7]"

First, because "the principal value of a patent is its statutory right to exclude", *H.H. Robertson Co.*, 820 F.2d at 390, injunctive relief must be readily available if the fundamental purposes of the patent law are to be fostered:

> Without this injunctive power of the courts, the right to exclude granted by the patent would be diminished, and the express purpose of the Constitution and Congress, to promote the progress of the useful arts, would be seriously undermined. The patent owner would lack much of the "leverge" afforded by the right to exclude, to enjoy the full value of his invention in the marketplace. Without the right to obtain an injunction, the right to exclude granted to the patentee would have only a

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[7] Private correspondence. Letter from J. Morgan Greene, Chairman, "Invent America - bringing bright ideas out of young minds" of the United States Patent Model Foundation to Bob Kearns April 9, 1992.

fraction of the value it was intended to have, and would no longer be as great an incentive to engage in the toils of scientific and technological research."

Congressional hearings results - no compulsory licensing in 35 U.S.C.

Smith International, Inc. v. *Hughes Tool Co.*, 718 F.2d 1573, 1577-78 (Fed. Cir.), *cert. denied*, 464 U.S. 996 (1983)."If monetary relief were the sole relief afforded by the patent statute then injunctions would be unnecessary and infringers could become compulsory licensees for as long as the litigation lasts." *Glasstech, Inc.* v. *AB Kyro Oy*, 635 F. Supp. 465 (N.D. Ohio 1986)(quoting *Atlas Powder Co.* v. *Ireco Chemicals*, 773 F.2d 1230, 1233 (Fed. Cir. 1985).

CAFC Decision p. 20

"Granting the relief requested by Kearns would impermissibly extend the statutory term beyond that established by Congress."

* II *

Money alone doesn't suffice

Nature of patent grant weighs against holding that monetary damages will always suffice to make infringed patentee whole, in that principal value of patent is at statutory right

to exclude. See *Connell* v. *Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) ("right to exclude recognized in a patent is but the essence of the concept of property"). The presumption of irreparable harm in patent cases is analogous to that applicable to other forms of intellectual property, as discussed in *Roper Corp.* v *Litton Systems, Inc.*, 757 F.2d 1266, 1271-72 (Fed. Cir. 1985).

Money alone is a compulsory license that "has been rejected by every Congress that has considered the matter for the past 20 years,..."

APPENDIX B[8]

McFarlane Compulsory Licensing Bill; Hearing on H.R. 9259 before the O'Malley Committee, 75th Cong., 3rd Sess. (1938)

"The public's appraisal of the patent system has been elicited more than once by legislative proposals to introduce into it a compulsory licensing provision. Such a provision, while ostensibly leaving the system

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[8] *There is no Mystery About Patents*, by William R. Ballard, J.M. Barrett Corp., *Publishers*, 220 East 42nd Street, New York 17, N.Y. 1946.

intact, would in fact reduce the value of the patent grant to a mere shadow, as the testimony on each occasion has made clear. The latest attempt was in March, 1938 when extended hearings were held on H.R. 9259 - the McFarlane bill.

. . .

Seventy of the seventy-four witnesses vigorously opposed the bill.

The entire testimony of over a thousand pages is of interest ... the testimony show(ed) the viewpoint of the kind of people that the public relies upon to make inventions and to promote American industry."

RECOVERY IN PATENT INFRINGEMENT SUITS,

Hearing before the U.S. Congress, House Committee on Patents. House of Representatives, 79th Congress, 2d sess., on H.R. 5231, A Bill to Amend Revised Statutes, 4921 (U.S.C. Title 35, Patents, Sec. 70), Providing That Damages be Ascertained on the Basis of Compensation for Infringement, as in Actions for Infringement in the U.S. Court of Claims. (Subsequently amended, reintroduced, and reported as

H.R.5311) January 29, 1946

Mr. C. Henry. ... How would such an arrangement work out in cases of trespass to realty? Suppose we had a law that only a reasonable rental could be collected for any such trespass, wouldn't that amount to a compulsory leasing of realty? Is it unreasonable to suppose that a person intending to trespass upon and occupy the realty would first offer to purchase a lease and, upon refusal, proceed to trespass and occupy anyway knowing full well that he wouldn't be out of pocket any more than if his offer had been accepted in the first place? The right to injunction in cases of patent infringement does not alter the situation because the granting of an injunction is not mandatory.

. . .

Mr. C. Henry. Gentlemen, before we close I would like to make the suggestion that this committee reject every compulsory license proposal regardless of how it is hidden or in whatever disguised form it may be submitted to this committee. It has been rejected by every Congress that has considered the matter for the past 20 years, often after voluminous testimony.

The Chairman. All in favor of rejecting everything Mr. Stedman has said with reference to the last amendments, indicate by saying "Aye"; opposed, "No."

(The motion was unanimously carried.)
(Whereupon at 12:15 p.m., the committee adjourned.)

* III *

CAFC Decision p. 20

Kearns argues that our decision in *Roche Prods., Inc.* v. *Bolar Pharmaceutical Co., Inc.* 733 F.2d 858, 221 USPQ 937 (Fed. Cir.), *cert. denied*, 469 U.S. 856 (1984), suggests that the availability of post-expiration equitable relief is simply a matter within the discretion of the trial court. In *Roche*, the trial court denied the patent owner's request for a permanent injunction because it found there was no infringement. Although the trial court's finding of noninfringement was reversed on appeal, the request for injunctive relief became "no longer ... necessary" because the patent had expired. Despite the patent's expiration, the case was remanded to the lower court with directions to fashion an appropriate equitable remedy to redress the harm to the patent owner caused by past acts of infringement. *Id.* at 865, 221 USPQ at 942. Kearns argues that the district court should consider taking action similar to that contemplated in Roche. Kearns, however, is not in a position to benefit from such relief.

CAFC Decision (con't.)

However, § 283 relief is available

only to "prevent the violations of any right secured by patent." Thus, when the rights secured by a patent are no longer protectable by virtue of expiration or unenforceability, entitlement to injunctive relief becomes moot because such relief is no longer available. *See Illinois Tool Works, Inc.* v. *Grip-Pak, Inc.*, 906 F.2d 679, 681, (Fed. Cir. 1990).

Professor Chisum's view

In Chisum, REMEDIES FOR PATENT INFRINGEMENT, page 397:

The possibility of post-expiration equitable relief was raised but not resolved in *Roche Prods., Inc.* v *Bolar Pharmaceutical Co.*, 733 F.2d 858 (Fed. Cir. 1984).

CAFC Decision p. 21

Moreover, entitlement to an injunction implementing the right to exclude, as compared with only assessing damages against an infringer, is not absolute even during the life of a patent, but is discretionary. *See* 35 U.S.C. § 283 ("courts having jurisdiction of cases under this title may grant injunctions" (emphasis added); *see also City of Milwaukee* v *Activated Sludge, Inc.*, 69 F.2d 577, 593, 21 USPQ2d 69, 85-86 (7th Cir. 1937); *Vitamin Technologists, Inc.* v. *Wisconsin Alumni Research Found.*,

Inc., 146 F.2d 941, 944-45, 63 USPQ 262, 267 (9th Cir. 1944).

Dr. Kearns has completed two District Court trials before Judge Cohn. Because § 283 is discretionary, he denied Dr. Kearns §283 relief in both judgments. First, he opined he did not have the power to grant equitable relief. Secondly, -- from the Proceedings of July 23, 1992 page 22:

> JUDGE COHN: "If I had discretion to grant equitable relief in the form that Dr. Kearns prays for, in either the *Ford* case or the *Chrysler* case, based upon the fact the jury found infringement was not willful, I would never exercise that discretion in favor of an injunction. So that while I have heretofore taken the position that I had no power to grant equitable relief Dr. Kearns prays for, I think it should be made clear as we move forward in this case, had I the power, absent a finding of willfulness that was affirmed on appeal, I would never consider the exercise of it. That should not give you any comfort, Dr. Kearns, but I think it should allow you to think even further on that point.

CAFC Decision p. 22

Here, because Kearns' patents have expired, the district court certainly did not abuse its discretion in denying injunctive relief.

An equitable judgment in analogous situation to Kearns'

Amicus Curiae Brief to CAFC
by Houston Inventors Association

An analogous situation to Dr. Kearns is represented by the decision in *Burr* v. *Ambarch*, 883 F.2d 1071, 1078, *vacated*, 492 U.S. 902 (1989), *reaffirmed on remand*, 888 F.2d 258 (2d Cir. 1989). In this case, a statute provided that a handicapped student was entitled to free appropriate education between the ages of 3 and 21. The plaintiff in this suit had been denied this appropriate education and, at the time the case was decided, the plaintiff was about to pass the age of 21. The argument was made that the school board could not then grant to the plaintiff an appropriate education because the plaintiff would be past the age limit. The court held that the school board's reasoning was faulty and enjoined the school board to grant the plaintiff compensatory education for a limited period of time to correspond to the time that the plaintiff was denied an appropriate education when he was supposed to have it. The analogy to the situation of Dr. Kearns is obvious. Dr. Kearns has been denied his exclusive right during the term of his patent, and the court, by grant-

> ing an injunction against Chrysler can give back to Dr. Kearns a rough partial equivalent of what Chrysler's infringement wrongfully took from him.

[M]ake effective the congressional purpose of statutes enacted by Congress

As held in J.I. Case Co. v. Borak, 377 U.S. 426, 433 (1964), federal courts have a duty to be alert to provide such remedies as are necessary to make effective the congressional purpose of statutes enacted by Congress. In enacting the patent statute, the Congress has clearly expressed its intent that holders of valid patents be afforded a period of exclusivity to provide a protected market to enable the patentee to break into markets with high entry barriers. The court below was not only not alert to provide the needed remedy to Dr. Kearns, it would not even hear evidence to see whether any such relief is warranted.

"[F]ederal courts possess wide discretion to impose any remedy...to make good a violation of federal law."

In *Franklin* v. *Gwinnett County Schools*, 90-918 argued 11 December 1991 and decided 26 February 1992, the Supreme Court stressed, via a majority opinion written by Justice White:

> "... a longstanding principle [is] that federal courts possess wide discretion to impose any remedy ... to make good a violation of federal law."
>
> Justice White further noted, "Congress likewise made no effort ... to alter the traditional presumption in favor of any appropriate relief for violation of a federal right."

* IV *

"Granting to plaintiff such other and further relief as justice may require."

Dr. Kearns prayed for the following in his Complaint in *Kearns* v. *Chrysler Corp. and American Motors Corp.*:

> "Granting to plaintiff such other and further relief as justice may require."

and he inquires further:

The patentee should not be denied the § 281 remedies during the time that Judge Pratt was sick; under lapses in Fed. R. Civ. P. Rule 1; nor should Judge Cohn be denied the emoluments of his public service by the Sixth Circuit Rule: (transcript of 23 July 1992 starting p. 16:)

> "THE COURT: And I have a new problem. All these cases are more than five years old, and the Sixth Circuit has adopted a rule that you con't go out of the circuit as a visiting judge if you have any case on your docket more than five years old. So these cases are likely to pin me to the Eastern District of Michigan. If I want to go to the Northern District of Illinois, or the Middle District of Florida as a visiting judge, I may not be able to do so because of these cases. You know, that's an incentive to get rid of them.
>
> I'm not going to ask you to dismiss them, Dr. Kearns, and then refile them so the five years starts running all over again. I mean, I could do

that, but we don't want to do that."[9] All of Dr. Kearns' civil actions have now been dismissed in Judge Cohn's court.

* * *

Dr. Kearns' Argument Cont. from p. 43-

* * *

Some basic economics involved.

The public within the U.S.A. borders can be considered a family. It is necessary for someone in our U.S. family to go outside our borders and earn money for us to pay for Saudi oil and Japanese electronics.

In the last quarter of this year, the U.S.A. usual trade deficit rose from $30 billion to $41 billion.

The number of cars made by foreign 'families' sold in the USA that are assembled

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[9] The patentee requires that his patents be within their 'life' to re-file them to not lose his remedy.

by Mercedes and Porsche may not become fewer (since they are sold to the wealthy) if Dr. Kearns does not receive his equitable remedy, but the standard-of-living of the USA populace will go down and the standard-of-living of the German populace will go up. About two-percent of each of those cars will not receive exported sub-assemblies from the USA under the Kearns patents for assembly in Germany and an additional two-percent will be assembled by Germans and exported to the USA to make a four-percent difference in trade. Should Dr. Kearns receive equitable remedy, the cost to the USA of exporting the system parts will be less as its cost to even the Germans will be less because Dr. Kearns will obtain the economies of scale of the USA part production as the USA does assemble half of the world's automobiles.

The USA populace's 'general Welfare' in the words of the Constitution will be better served if Dr. Kearns is treated equitably.

* * *

The 'routine life' of a patent is 17 years. That raises the next question.

(3) When the Court accepts under 35 U.S.C. § 281 the inventor's Complaint which does not come to trial for 17 years, whether the inventor has "lost" his Constitutional standard of compensation - 'time?'

This situation has occurred in this case because Judge Cohn gave priority for trial to both the *Ford* and *Chrysler & AMC* cases over the first action Dr. Kearns filed:

> Civil No. 78-CV-70642 of WOODS MOTORS, INC., DAIMLER-BENZ AKTIENGESELLSCHAFT ("Mercedes"); DR. ING. h.c.f. PORSCHE A.G. ("Porsche"); and SWF-SPECIALFABRIK fur AUTOZEBEHOR GUSTAV RAU G.m.b.H., ("SWF"), a corporation of the Federal Republic of Germany (CAFC A-434-48; 481-84; 527-84).

Judge Cohn denied Dr. Kearns relief under

§ 283 Injunction. The CAFC Decision said the patent has to be within its routine-'time' at the start of trial. Under these lower court decisions the public interest in Civil No. 78-70642 is wiped out - win or lose - because after Dr. Kearns filed his Complaint, 17 years went by in waiting for Civil No. 78-70642 to be called for trial. Dr Kearns'invention was 'too successful' with many IWWS infringement cases before Judge Cohn. In short, one District Judge's conduct alone negated the 39 Founding Fathers who signed the Constitution.

For the public to receive any benefit the answer to question (1)(c) has to be that the patent needs to be 'alive' only when the patentee files his Complaint, and, for the public interest to be preserved for trial, the patentee still has to be eligible for relief under § 283.

The CAFC said in their Decision that the patent has to be 'alive' at the later date when the patentee starts trial.

That raises the question:

(4) Whether a patent must be within its routine-'time' at the start of trial for the Court to secure the inventor's Constitutional standard of compensation - 'time?'

The cover of a U.S. patent reads:

> [F]or the term of SEVENTEEN years from the date of this grant..." (A-S)

But that phrase is not in the repealed 35 U.S. Code §40 **Same; contests and duration** (A-T) A duration is:

> (Webster's) 1 continuance in time 2 the time that a thing continues or lasts

so under repealed 35 § 40, it could be argued that because the word duration was used in the title the grant started with the issuance of the patent. But in 1952 Congress changed repealed 35 § 40 and renumbered and enacted § 154 and used the

word 'term' exclusively in place of 'duration' in describing the time to the inventor. A term:

(Webster's) 3 a set period of time

The change in words from eliminating duration to the use of word term exclusively in § 154 could be the answer to the question, (A-U)

> "How can an exclusive right be granted when the patent was in 'use' by others on the day of issuance?"

as is true with Dr. Kearns' IWWS patents. Dr. Kearns asked the CAFC that question but did not receive an answer. Both the Ford Motor Company and the Chrysler Corp. were "using" Dr. Kearns' IWWS patents on November 7, 1967 ('836); February 16, 1971 ('374); May 25, 1971 ('178); June 1, 1971 ('747); August 31, 1971 ('790); and March 12, 1974 ('936) while developing-/selling their infringing IWWS against Dr. Kearns' business interests. *See Roche*

Prods., Inc. v *Bolar Pharmaceutical Co.*, 733 F.2d 858, (Fed. Cir. 1984). The patents issued on the above six dates were found valid by the jury and admitted infringed by Ford in *Kearns* v. *Ford Motor Co.* and stipulated valid and found infringed in *Kearns* v. *Chrysler Corporation* and *American Motors Corporation*. Since,

> There is no affirmative obligation on Congress to explain why it deems a particular enactment wise or necessary, or to demonstrate that it is aware of the consequences of its action. *See Harrison* v. *PPG Industries, Inc.*, 446 U.S. 578, 592, 100 S.Ct. 1889, 1897, 64 L.Ed.2d 525 (1979). Rather, because "laws are presumed to be passed with deliberation, and with full knowledge of all existing ones on the same subject, T. Sedgwick, *The interpretation and Construction of Statutory and Constitutional Law* 106 (2d ed. 1874), we must presume that ... as cited with approval in *Roche*, *supra* at p. 864;

Congress must have had a reason when it removed the word 'duration' from repealed 35 § 40 and used the word 'term' exclusively in enacted 35 §154.

Moreover, Dr. Kearns Motion for a Preliminary Injunction was denied with the Judge opining: (A-P)

> It is true that if plaintiff's patent were to expire prior to a decision finding the patent valid and infringed the plaintiff's anticipated position as a major supplier of the windshield wiper systems would be undermined. The short answer to this contention is that this action will be completed before the expiration date of plaintiff's patent. The Court would therefore be able to enjoin the infringement of this patent if plaintiff is successful on the merits and plaintiff would be allowed the marketing foothold which he fears would otherwise be lost.

Dr. Kearns' remedy and the remedy of the public has been known to both Judges and the Detroit Court for 17 years.

The defenses to a patent infringement civil action, as Dr. Kearns told the Court of Claims, CAFC and Supreme Court back in 1984[10], are so well known, with

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[10] *Kearns* v. *United States* (Court of Claims) No. 436-84C August 23, 1984; *Kearns* v. *United Sta-*

delay so tolerated by the Courts, as to deny the inventor his Constitutional rights. As Galileo remarked in his petition for the privilege[11], he said if he were granted the privilege, "I shall the more attentively apply myself to new inventions for universal benefit."In short, he was not inclined to divulge his invention only to have it copied; but if the government would give him some reasonable protection he would not only divulge it and build it but might even apply himself to making some more inventions. Dr. Kearns does not aspire to 'save the univer-

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tes (Court of Appeals for the Federal Circuit) No. 84-1849; *Kearns* v. *United States* (Supreme Court) No. 85-645 May 25, 1985

[11] Kettering Award Address, Honorable Giles W. Rich in The Vague Concept of "Invention" as Replaced by Sec. 10-3 of the 1952 Patent Act, 46 J. Pat. Off. Soc'y 855, at 857 (1964)

se' but he does aspire to helping his earthly-Biblical neighbors.[12]Dr. Kearns can be aided by GATT Article 46 *Other Remedies*. Dr. Kearns stands ready to use his damages to buy the materials and implements of production and to retain every person[13] in his applicable job so there is not a ripple in Chrysler's assembly production.To make the changeover easier, simply change the name over the door.

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[12] With 55,000 traffic deaths in the USA annually, and having developed the USA's primary standard for the measurement of the skid-resistance of highways for the Federal Highway Administration as their principal investigator at the (then) National Bureau of Standards in Gaithersburg, Maryland, Dr. Kearns would like to manufacture his moisture responsive IWWS dwell-time technology as more than half the traffic deaths occur in wet-weather and rain occurs less than half the time.

[13] Chrysler would provide each person's paid-up benefits fund reserve.

United States Court of Appeals for the

Federal Circuit

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant,

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

Robert W. Kearns, of Queenstown, Maryland, argued Pro Se.

Robert P. Taylor, Pillsbury, Madison & Sutro, of Washington D.C., argued for defendant/appellant. With him on the brief was Lawrence F. Scinto, Fitzpatrick, Cella, Harper & Scinto, of New York, New York. Of counsel were Deanne C. Siemer and Michael A. Conley.

William D. Durkee, Arnold, White & Durkee, of Houston, Texas, was on the

brief for Amicus Curiae, Arnold, White & Durkee. Of counsel were William B. Allison and James G. Munisteri, Sewell & Riggs, of Houston, Texas.

Richard L. Aitken and Andrew C. Aitken, Lane, Aitken & McCann, of Washington, D.C., were on the brief for Amicus Curiae, Houston Inventors Association.

Appealed from: U.S. District Court for the Eastern District of Michigan

Judge Cohn

United States Court of Appeals for the

Federal Circuit

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant,

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

DECIDED: August 11, 1994

Before LOURIE, RADER, and SCHALL,

Circuit Judges.

LOURIE, Circuit Judge.

Chrysler Corporation and Robert W. Kearns appeal and cross-appeal, respectively, from the final judgment of the United States District Court for the

Eastern District of Michigan awarding Kearns $18,740,465.43. The judgment was entered on jury verdicts that three patents owned by Kearns were infringed by Chrysler. Kearns v. Chrysler Corp., Civil No. 82-70748 (E.D. Mich. Oct. 30, 1992). The court denied Chrysler's motion for judgment as a matter of law or in the alternative for a new trial. Kearns v. Chrysler Corp., Civil No. 82-70748 (E.D. Mich. June 3, 1993). We affirm the judgment in all respects.

BACKGROUND

In 1982, Kearns filed an action against Chrysler alleging infringement of U.S. Patents 3,351,836, 3,564,374, 3,602,790, and 3,581,178, all relating to electronic intermittent windshield wipers (IWWs) for use in automotive vehicles. At the time the suit was filed, Kearns had three similar suits pending against

other automobile manufacturers and distributors involving the same patents, Kearns v. Ford Motor Co., Civil Action No. 78-70740 (E.D. Mich.); Kearns v. Wood Motors, Inc., Civil Action No. 78-70642 (E.D. Mich.); SWF-Spezialfabrik fur Autozubehor Gustav Rav GmbH v. Kearns, Civil Action No. 79-74451 (E.D. Mich.).[1]

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[1]Kearns subsequently filed other infringement actions involving patents relating to IWWs, e.g., Kearns v. General Motors Corp., Civil Action No. 85-70461 (E.D. Mich.), aff'd, No. 93-1535 (Fed. Cir. July 25, 1994); Kearns v. Toyota, Civil Action No. 85-70459 (E.D. Mich.); Kearns v. Ferrari SpA., Civil Action No. 85-70459 (E.D. Mich.); Kearns v. American Motors Corp., Civil Action No. 85-70460 (E.D. Mich.) (consolidated with the in-

On October 22, 1982, proceedings in the Chrysler action were stayed pending resolution of the earlier filed suits. The stay was instituted pursuant to Chrysler's stipulation that it would be "bound by the judgment as to the validity of . . . U.S. patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790" in either Ford, Wood Motors, or SWF, whichever was the last to be adjudicated. The stipulation expressly provided, however, that Chrysler would "not be bound by any consent judgment."

In 1989, shortly before the Ford case went to trial, Chrysler renewed its stipulation regarding the issues of invalidity and unenforceability. Subject to continuation of the court-ordered stay,

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stant case by order of the district court on February 3, 1990).

Chrysler agreed to be "bound by the judgment (excluding a consent judgment) in the Kearns v. Ford case, C.A. 78-70740 as to the validity and enforceability of the patents involved in that action that are also involved in this action. Those patents included United States Patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790." That stipulation was subsequently entered by the court on February 15, 1990.

1. The Ford Litigation

The liability phase of the Ford case commenced on January 3, 1990. On January 29, 1990, the jury returned a unanimous verdict for Kearns, finding that Ford had not proved by clear and convincing evidence that claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790 patent, and claim 6 of the '178 patent were invalid or unenforceable. On

March 9, 1990, the district court entered partial judgment that the specified claims were valid, enforceable, and infringed by Ford. That partial judgment was eventually "made final" upon entry of the court's final judgment on November 14, 1990.

The damage phase of Ford was tried before the same jury in April 1990. The jury, however, was unable to reach a unanimous verdict and a second trial on damages was held in July 1990. The second jury ultimately returned a unanimous verdict in favor of Kearns, awarding $5,163,842 for the period from April 3, 1978 through 1988. On July 13, 1990, partial judgment was entered on the damage award assessed by the second jury. Although damages for the period from 1972 to April 3, 1978 remained in dispute, Ford and Kearns eventually reached a

settlement as to the total amount of liability. Consequently, the partial judgment on damages was vacated and Ford withdrew its pending post-verdict motions for judgment notwithstanding the verdict or in the alternative for a new trial and waived its appellate rights.

2. The Chrysler Litigation

The Chrysler case returned to active status in early 1991. On February 20, 1991, the district court issued a pretrial order stating that the issues to be adjudicated at trial concerned "infringement, damages, and willfulness." On May 3, 1991, Chrysler filed a motion to have the pretrial order modified to add patent validity as an issue for trial. In support of its motion, Chrysler argued that the pretrial stipulations of October 15, 1982 and February 15, 1990 did not bar Chrysler from challenging the patents in

suit. Chrysler claimed that because the final judgment in Ford was entered pursuant to a settlement agreement between Ford and Kearns, it was a "consent judgment" within the meaning of the stipulations.

The district court denied the motion and limited trial to the issues stated in the pretrial order. In reflecting Chrysler's argument, the district court noted that although a settlement had been reached in Ford on the issue of damages, the issue of validity was "hotly" contested by the parties at trial, resulting in a unanimous jury verdict and a final judgment in favor of Kearns. Moreover, the court found that the stipulations did not obligate Ford to pursue post-trial motions and exhaust all rights or appeal in order for the judgment in Ford to be binding on the parties in Chrysler.

By order of the court, the Chrysler action was bifurcated into separate jury trials on the issues of liability and damages. On December 10, 1991, the jury returned verdicts that Chrysler's accused IWW circuits, designated the "1977 Circuit" and the "1980 Circuit," infringed claim 12 of the '836 patent, claim 6 of the '374 patent, and claim 14 of the '790 patent.[2] On June 11, 1992, the same jury

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[2]The jury also found that Chrysler infringed claim 7 of the '178 patent. Due to an inconsistency between the jury's general verdict of infringement and its answer to a special question, the district court set aside the jury's finding and entered judgment on noninfringement pursuant to Fed. R. Civ. P. 49(b). The court's judgment respecting claim 7 is not at issued in this appeal.

returned a verdict that Chrysler's infringement was not willful and assessed a reasonable royalty of $.90 per unit for a total of 12,564,107 infringing units.[3] Pursuant to the jury's verdicts, the district court entered final judgment in favor of Kearns in the amount of $18,740,465.43, including prejudgment interest and costs.[4]

Chrysler subsequently filed a motion for judgment as a matter of law (JMOL),

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[3]The Court subsequently revised the number of infringing units downward to 12,563,107 units.

[4]Specifically, the judgment consisted of $11,306,696.30 for infringement damages, $8,075,193 for prejudgment interest, and $25,898.75 for costs, less $667,322.62 in costs, expenses, and attorneys' fees awarded to Chrysler.

asserting that the jury's findings of infringement were not supported by substantial evidence. Alternatively, Chrysler moved for a new trial, claiming that the district court improperly excluded evidence and misinstructed the jury on critical legal issues. The district court denied Chrysler's post-verdict motions. The court considered the expert testimony adduced at trial together with the documentary evidence of record to be a sufficient basis upon which the jury could have supported its findings of infringement. Further, the court determined that the exclusion of evidence was not prejudicial to Chrysler's substantive rights and that the jury was correctly instructed on the interpretation of the claims and their application to the accused circuits.

DISCUSSION

Chrysler now appeals, asserting that the district court's judgment should be reversed as a matter of law because the underlying jury verdicts of infringement were not supported by substantial evidence, or in the alternative, that a new trial is warranted in view of the prejudicial error committed by the district court in barring Chrysler from introducing prior art evidence necessary to properly construe the claims at issue and to challenge their validity and enforceability. Kearns cross-appeals certain rulings of the court that allegedly deprived him of the total compensation to which he claims he is entitled.

New Trial

We first address the district court's denial of Chrysler's motion for a new

trial. "The denial of a motion for new trial can be reversed only if the district court abused its discretion." Arachnid, Inc. v. Medalistic Marketing Corp., 972 F.2d 1300, 1301, 23 USPQ2d 1946, 1948 (Fed. Cir. 1992) (citation omitted); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1367, 21 USPQ2d 1321, 1326 (Fed. Cir. 1991), cert. denied, 113 S. Ct. 60 (1992). An abuse of discretion may be established by showing that the district court either made an error of law, a clear error of judgment, or made findings which were clearly erroneous. See Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1569, 28 USPQ2d 1081, 1091 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1540 (1994).

1. Invalidity and Unenforceability

In support of its contention that a new trial is required, Chrysler claims that the district court erred as a matter of law in excluding evidence allegedly showing that the patents in suit are invalid and unenforceable. Chrysler claims that the district court's decision to exclude such evidence was based on an erroneous interpretation of the pretrial stipulation of February 15, 1990,[5] in which Chrysler agreed to be bound by the

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[5]The district court did not rely on the first stipulation of October 15, 1982 in making its disputed evidentiary rulings. The court considered that stipulation to be functus officio in view of the February 15, 1990 stipulation. We will therefore limit our discussion to the latter stipulation.

judgment rendered in the Ford case on the issues of invalidity and unenforceability. It is Chrysler's position that the Ford judgment was in fact a consent judgment, which, under the terms of the stipulation, was not binding on Chrysler.

The proper interpretation of the parties' pretrial stipulation, like any contract, presents a legal question that we address de novo. See Intel Corp. v. ULSI Sys. Technology, Inc., 995 F.2d 1566, 1569, 27 USPQ2d 1136, 1138 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 923 (1994). As always, our inquiry begins with the language of the agreement memorializing the intent of the parties.

The controlling language of the agreement between Chrysler and Kearns provides that Chrysler "shall be bound by the [Ford] judgment (excluding a consent

judgment) . . . as to the validity and enforceability" of the patents in suit. [Emphasis added.] Chrysler asserts that the existence of the "consent judgment" exception in the stipulation indicates that it only intended to be bound by a judgment respecting invalidity and unenforceability where those issues were "fully litigated" by Ford, i.e., only after Ford vigorously defended its position at trial and exhausted all available post-trial remedies. Chrysler insists that the final judgment entered in Ford was a "consent judgment" because the parties in that case reached a settlement on the issue of damages that effectively mooted Ford's post-trial motions and forced Ford to forfeit its appellate rights.

We reject Chrysler's attempts to avoid the consequences of its stipulation by

redefining its terms. The fact that Ford was precluded from proceeding with its post-trial motions or seeking appellate review because of its damage settlement does not render the court's judgment a "consent judgment." In our effort to give effect to the original intent of the parties, we adhere to the well-settled rule that words in an agreement are interpreted in accordance with their ordinary and commonly accepted meanings. See Hol-Gar Mfg. Corp. v. United States, 351 F.2d 972, 979 (Ct. Cl. 1965). The term "consent judgment" is defined as "[a] judgment, the provisions and terms of which are settled and agreed to by the parties to the action." Black's Law Dictionary 842 (6th ed. 1990). This meaning is in contradistinction to a judgment that is rendered by a court without agreement of the parties. The

commonly accepted meaning of the term "consent judgment" prevails here because the stipulation is devoid of any indication that the parties intended a different meaning.

Although it is undisputed that Ford settled the amount of compensation due Kearns, no such settlement or agreement was reached between the parties in Ford respecting the issues of validity, enforceability, and infringement of the asserted patent claims. Indeed, as the trial court noted, those issues were "hotly," "vigorously," and "fully" contested by the parties during a lengthy jury trial.[6] Pursuant to unanimous ver-

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[6]The judge who presided over the Ford litigation also presided over the Chrysler litigation. In rejecting Chrysler's initial attempts to avoid its stip-

dicts returned by the jury, the court entered partial (and later final) judgment holding claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790 patent, and claim 3 of the '936 patent valid, enforceable, and infringed. Because neither party in Ford "settled and agreed" on the issues of validity and enforceability, the district court's

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ulation, Judge Cohn stated, "I know that I entered a Partial Judgment of Validity, after a hotly contested trial. To my way of thinking . . . there was no Consent Judgment on Validity. Validity was contested. Kearns won, Ford lost and it chose not to appeal, and it withdrew its Motions JNOV or New Trial. That doesn't obviate the fact that it was judgment contested arising in a contested environment."

judgment respecting those issues was not a "consent judgment" within the meaning of the stipulation. Chrysler is thus bound by that judgment. See Restatement (Second) of Judgments § 40 (1982) ("A person who agrees to be bound by the determination of issues in an action between others is bound in accordance with the terms of his agreement.").

In a further attempt to avoid the consequences of its stipulation, Chrysler urges that "public policy" favors allowing it to challenge the patents' validity and enforceability. Even were we to agree with this proposition, we do not see how it aids Chrysler here. Chrysler was certainly entitled to raise the defenses of invalidity and/or unenforceability when it was accused of infringement, but it chose instead to rely on the judgment rendered in Ford on those issues.

Public policy will not rescue Chrysler from a decision which it later finds to be imprudently made. On the contrary, public policy favors preventing Chrysler from reneging on an agreement into which it freely entered and upon which Kearns and the district court relied. See Interspiro USA Inc. v. Figgie Int'l Inc., 18 F.3d 927, 930, 30 USPQ2d 1070, 1072 (Fed. Cir. 1994); Bank of America Nat'l Trust and Savings Assoc. v. United States, No. 93-5059, slip op. at 4-5 (Fed. Cir. April 29, 1994).

Accordingly, we agree with the district court that Chrysler was barred under the stipulation from introducing prior art evidence directed toward challenging the validity and enforceability of the asserted patents in this case.

2. Interpretation of Claims

Next, Chrysler contends that the district court committed reversible error by excluding prior art evidence allegedly essential to the proper construction of the claims at issue. As a result of that error, Chrysler asserts that a new trial is warranted because the jury's infringement analysis was predicated on distorted claim interpretations.

"The decision to admit or exclude evidence is within the sound discretion of the trial court and will be reversed on appeal only for a clear abuse of that discretion." Smith & Lee Assocs., Inc. v. City of Taylor, Mich., 13 F.3d 920, 928 (6th Cir. 1993). In order to show that the district court abused its discretion in excluding the prior art evidence, Chrysler must demonstrate that the exclusion prejudiced its substantive rights. See DMI, Inc. v. Deere & Co.,

802 F.2d 421, 428, 231 USPQ 276, 280-81 (Fed. Cir. 1986). Here, Chrysler has failed to make that showing.

It is well-settled that reference may be had to prior art when it will assist a court in determining how a disputed claim is understood by those skilled in the art. See Palumbo v. Don-Joy Co., 762 F.2d 969, 975, 226 USPQ 5, 8 (Fed. Cir. 1985); Tandon Corp. v. International Trade Comm'n, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). However, when claim language is clear and unambiguous on its face, resort to prior art may be unnecessary.

Whether a claim has been infringed requires first interpreting the claim and then comparing the properly construed claim to the accused device. See Read Corp. v. Portec, Inc., 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992).

When, as here, prior art is not required to resolve the underlying legal question concerning what a claim means, it necessarily has little relevance to the ultimate factual question of infringement. Such evidence is by definition "irrelevant" and need not be admitted by a trial court. See Fed. R. Evid. 401, 402.

At trial, Chrysler attempted to introduce prior art patents ostensibly for the purpose of aiding in the interpretation of the claims at issue. Specifically, Chrysler intended to show that under Kearns' interpretations of the claims, the claims were impermissibly broad because they read upon or were obvious over the prior art. The district court, however, concluded that the claims could be construed according to their plain meaning and that reference to prior art was

not required.[7] Moreover, and highly significant here, the district court believed that Chrysler's attempts to offer such evidence constituted a disguised, "back door" attack on the validity of the patents, which was expressly proscribed by the binding stipulation.

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[7]The claims at issue contain limitations expressed in "means-plus-function" format. 35 U.S.C. § 112 ¶ 6 (1988). The court's ruling is consistent with the rule that "[i]t is not necessary to consider the prior art in applying section 112, paragraph 6. Even if the prior art discloses the same or an equivalent structure, the claim will not be limited in scope thereby." Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 842, 20 USPQ2d 1161, 1179 (Fed. Cir. 1991).

The district court's reasoning adequately supports its refusal to admit the proffered evidence. "[That] we might have reached a different result or might have affirmed had the district court gone the other way are insufficient bases for reversal under the abuse of discretion standard which applies to our review of this part of the court's judgment." RCA Corp. v. Data General Corp., 887 F. 2d 1056, 1065, 12 USPQ2d 1449, 1457 (Fed. Cir. 1989). Moreover, even if the court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced. The district court's denial of Chrysler's motion for a new trial is therefore affirmed.

Judgment as a Matter of Law

We now consider Chrysler's argument that the district court erred in denying its motion for judgment as a matter of law on the issue of infringement. Chrysler contends that no substantial evidence supports the jury's findings that Chrysler literally infringed claim 14 of the '790 patent, claim 16 of the '836 patent, and claim 6 of the '374 patent.

"We reverse a denial of a motion for JMOL only if the jury's factual findings, presumed or express, are not supported by substantial evidence or, if they are, that the legal conclusions implied from the jury's verdict cannot in law be supported by those findings." Arachnid, Inc. v. Medalistic Marketing Corp., 972 F.2d at 1301, 23 USPQ2d at 1948 (citation omitted). The "substantial evidence" standard "requires us to decide for ourselves whether reasonable jurors viewing

the evidence as a whole could have found the facts needed to support the verdict in light of the applicable law. If we conclude that no reasonable findings of fact, supported by substantial evidence, could support the verdict that was incorporated into the trial court's judgment, then we must conclude that the trial court erred in not granting the motion for [JMOL]." Lemelson v. General Mills, Inc., 968 F.2d 1202, 1207, 23 USPQ2d 1284, 1288 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993). Moreover, we review the evidence in the light most favorable to Kearns, the nonmoving party, drawing all reasonable inferences in his favor. See Amsted Indus. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 181, 30 USPQ2d 1462, 1464 (Fed. Cir. 1994).

Chrysler devotes the bulk of its appeal to challenging the jury's findings

that the accused circuits performed the functions required by each of the asserted means-plus-function clauses by means of structure taught in the specification or an equivalent of those structures. In doing so, Chrysler pays mere lip service to the substantial evidence standard by ignoring the evidence upon which the jury reasonably relied in reaching its verdicts and by rearguing the merits of the infringement issues. An appeal, however, is not to be used as a means of retrying a case. See DMI, 802 F.2d at 4266, 231 USPQ at 279. Under the substantial evidence standard, the appellate court's function is exhausted once a sufficient evidentiary basis is deemed to exist to support the jury's findings. See Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1235, 9 USPQ2d 1913, 1919 (Fed. Cir.), cert. denied, 493 F.2d 853 (1989).

Trial on the issue of infringement lasted approximately four weeks, during which expert testimony was introduced by both parties. Specifically, as the district court stated, "the expert testimony first construed each of the asserted claims and then went on to describe how the Chrysler system responded to each of the elements of each of the claims. . . . It is this expert testimony together with admissions in Chrysler's documents describing the gestation of the Chrysler system which constituted, for the most part, the substantial evidence supporting the jury's verdict of infringement." After receiving instructions on the law governing infringement of means-plus-function claims,[8] the jury returned ver-

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[8]"In order to meet a means-plus-function limitation, an accused device must

dicts that the asserted claims were literally infringed by Chrysler's accused IWW circuits. Each of the jury's verdicts of infringement was supported by a number of detailed special interrogatories (referred to at trial as "special questions") that addressed specific issues that had been the focus of expert testimony at trial.[9]

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(1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure." Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994).

[9]The jury decided some 39 special questions concerning the issue of infringement. Five special questions were

We have recognized that "[t]he use of special interrogatories . . . facilitates appellate review . . . for such use frees the court from having to survey every possible basis for the jury's decision." American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1361, 220 USPQ 763, 773 (Fed. Cir.), cert. denied, 469 U.S. 821 (1984). The district court, in denying Chrysler's post-trial motions, analyzed all of the special interrogatories answered by the jury and cited evidence presented to the jury pertinent to each interrogatory, including expert witness testimony. Thus, it is clear

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directed to infringement of claim 5 of '790 patent, 17 special questions to claim 16 of the '836 patent, and five special questions to claim 6 of the '374 patent.

that the jury verdicts were supported by substantial evidence. The detailed nature of the special interrogatories, as well as the extensive analysis by the trial judge in considering Chrysler's post-trial motions, are impressive indeed, giving great credibility to the decisions reached.

We conclude that Chrysler has failed to show that on the entirety of the record reasonable persons could not have found the facts necessary to support the jury's verdicts of infringement. Because substantial evidence supports the jury's verdicts and because the legal conclusions implied from those verdicts are consistent with the jury's findings, the district court's denial of Chrysler's motion for judgment as a matter of law is affirmed.

Cross-Appeal

Kearns now cross-appeals a number of rulings issued by the district court that Kearns claims precluded him from obtaining all the relief and compensation to which he was entitled under the law. At issue are the district court's orders (1) granting Chrysler's motion for summary judgment on Kearns' right to seek injunctive relief, (2) granting Chrysler's motion for summary judgment on Kearns' right to recover lost profits as damages, (3) denying Kearns' motion to disqualify Chrysler's counsel for conflict of interest, (4) precluding Kearns from challenging the number of infringing units without filing supporting documentary evidence, (5) denying Kearns' motion to offer separate evidence of willful infringement by American Motors, (6) granting Chrysler's motion for a directed verdict on the issue of willfulness, (7)

assessing prejudgment interest for the period from March 2, 1982 to June 11, 1992 at simple interest rather than 2% above the prime rate, and (8) awarding Chrysler $677,332.62 for attorneys' fees and expenses. We will address each of these rulings in turn to the extent necessary.

1. Post-expiration Injunctive Relief

Shortly before trial, Kearns expanded his claim for relief to include injunctive relief. Kearns believed that Chrysler's infringement deprived him of the "full value" of his patents during their respective terms by effectively extinguishing his exclusive right to sell his patented IWW systems to automobile manufacturers. Kearns urged that Chrysler should be enjoined from manufacturing infringing IWW systems for a period of sufficient duration "to put him in [a]

position where the harm [caused by] past infringement during the terms of the patents in suit is rectified." The district court refused to grant such relief because the patents had already expired.[10] The court concluded that "there is nothing in statute or common law giving [Kearns] the right to an injunction against practicing the disclosures in an expired patent."

In arguing that the district court erred in denying him post-expiration relief, Kearns claims that the $11 million damage award is not adequate to compensate him for the loss he sustained as a result of Chrysler's infringement. Kearns contends that Chrysler's infringe-

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[10]The '836 patent expired in 1984 and the '790 and '374 patents both expired in 1988.

ment stripped him of "exclusive time" over his patents in violation of his rights under the U.S. Constitution and the patent laws, and that he is entitled to have that time restored to him. That contention, however, finds no basis in the statutory scheme governing patent infringement remedies.

Under the laws enacted by Congress, a patent grants the patent owner the right to exclude others from making, using, or selling the claimed invention in the United States for the term of seventeen years. 35 U.S.C. § 154 (1988). When that exclusive right is infringed, the patent owner is authorized to obtain compensation in the form of damages, measured, e.g., by lost profits or a reasonable royalty. 35 U.S.C. §§ 281, 284 (1988). Moreover, the statute expressly provides for the grant of injunc-

tions "in accordance with the principles of equity." 35 U.S.C. § 283 (1988). In view of the fact that the principal right afforded by a patent is the "right to exclude," we have noted that "[t]he nature of the patent grant . . . weighs against holding that monetary damages will always suffice to make the patentee whole." H.H. Robertson Co. v. United Steel Deck, Inc., 820 F.2d 384, 387-88, 2 USPQ2d 1926, 1930 (Fed. Cir. 1987). Indeed, "[w]hile monetary relief is often the sole remedy for past infringement, it does not follow that a monetary award is also the sole remedy against future infringement." Atlas Powder Co. v. Ireco Chemicals, 773 F.2d 1230, 1233, 227 USPQ 289, 292 (Fed. Cir. 1985) (emphasis added). However, § 283 relief is available only to "prevent the violations of any right secured by patent." Thus, when the

rights secured by a patent are no longer protectable by virtue of expiration or unenforceability, entitlement to injunctive relief becomes moot because such relief is no longer available. See Illinois Tool Works, Inc. v. Grip-Pak, Inc., 906 F.2d 679, 681, 15 USPQ2d 1307, 1308 (Fed. Cir. 1990).

An invention claimed in a patent passes into the public domain upon termination of the patent's 17-year statutory term. Because the rights flowing from a patent exist only for the term of the patent, there can be no infringement once the patent expires. Here, all the asserted patents expired before the commencement of trial. Therefore, Kearns "can no longer obtain injunctive relief with respect to [those patents]." See Kinzenbaw v. Deere & Co., 741 F.2d 383, 386, 222 USPQ 929, 931 (Fed. Cir. 1984),

cert. denied, 470 U.S. 1004 (1985); see also Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo, Ltd., 754 F.2d 345, 347, 224 USPQ 863, 865 (Fed. Cir. 1985). Granting the relief requested by Kearns would impermissibly extend the statutory term beyond that established by Congress. Congress has the power to provide for patent term extension in appropriate circumstances, see 35 U.S.C. §§ 155, 156 (1988), but it has not done so here and we cannot legislate in its place. See Denkler v. United States, 782 F.2d 1003, 1008 (Fed. Cir. 1986) ("Should Congress wish to extend the [statute's scope], it knows how to do so."). The expiration of Kearns' patents precludes the grant of injunctive relief and the judgment for $11 million in damages thus amounts to adequate and full compensation under the

law for Chrysler's past violation of his patent rights.

Kearns argues that our decision in Roche Prods., Inc. v. Bolar Pharmaceutical Co., Inc., 733 F.2d 858, 221 USPQ 937 (Fed. Cir.), cert. denied, 469 U.S. 856 (1984), suggests that the availability of post-expiration equitable relief is simply a matter within the discretion of the trial court. In Roche, the trial court denied the patent owner's request for a permanent injunction because it found there was no infringement. Although the trial court's finding on noninfringement was reversed on appeal, the request for injunctive relief became "no longer . . . necessary" because the patent had expired. Despite the patent's expiration, the case was remanded to the lower court with directions to fashion an appropriate equitable remedy to redress the harm to

the patent owner caused by past acts of infringement. Id. at 865, 221 USPQ at 942. Kearns argues that the district court should consider taking action similar to that contemplated in Roche. Kearns, however, is not in a position to benefit from such relief.

The post-expiration relief discussed in Roche was intended to return the parties to the status quo before infringement (e.g., destruction of data obtained as a result of the infringement) and was not intended to prohibit future use of the invention. Importantly, the relief was also considered in the context of harm to a patent owner that had been selling the patented product. Thus, deferral of competition by an infringer who had entered the market prematurely, i.e., before the patent expired, was considered as a means of equitably com-

pensating the patent owner. In contrast, because Chrysler has been manufacturing and selling its infringing IWWs for many years and Kearns has not (see infra), there is no basis for granting relief similar to that contemplated by the court in Roche.

We sympathize with Kearns' complaint that his patents have expired without his ever being able to exclude others from practice of his invention, especially since he is an individual inventor contending with a multitude of giant corporations.[11] While it is of course the essence of a patent that it provides the right to exclude, the same statute that

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[11]The fact that Kearns has fired several of his attorneys and attempted to conduct massive multiple suits pro se may be relevant to his dilemma.

grants that right also permits other parties, including accused infringers, to challenge the validity of a patent and to contest a charge of infringement. See 35 U.S.C. § 282 (1988). Moreover, entitlement to an injunction implementing the right to exclude, as compared with only assessing damages against an infringer, is not absolute even during the life of a patent, but is discretionary. See 35 U.S.C. § 283 ("courts having jurisdiction of cases under this title may grant injunctions" (emphasis added)); see also City of Milwaukee v. Activated Sludge, Inc., 69 F.2d 577, 593, 21 USPQ2d 69, 85-86 (7th Cir. 1937); Vitamin Technologists, Inc. v. Wisconsin Alumni Research Found., Inc., 146 F.2d 941, 944-45, 63 USPQ 262, 267 (9th Cir. 1944). Here, because Kearns' patents have expired, the district court certainly did

not abuse its discretion in denying injunctive relief.

It is unfortunate that Kearns feels that he never enjoyed an exclusive status under his patents, but that is simply a consequence of the right of others to challenge his patents and the fact that his patents have expired. The patent statute does provide for increased damages and attorney fees as additional relief for aggrieved patent owners, see 35 U.S.C. §§ 284, 285 (1988), but Kearns did not persuade the district court that he was entitled to such relief.

We therefore conclude that the district court properly granted summary judgment in favor of Chrysler on Kearns' request for post-expiration injunctive relief.

2. Lost Profits

Kearns argues that the district court erred in granting Chrysler's motion for summary judgment on Kearns' claim for damages based on lost profits, rather than a reasonable royalty. A patent owner bears the burden of proof on damages. Fromson v. Western Litho Plate and Supply Co., 853 F.2d 1568, 1574, 7 USPQ 1606, 1612 (Fed.Cir. 1988). Kearns has not carried that burden with respect to lost profits.

A lost profits award is appropriate only if the patent owner can prove there was a reasonable probability that "but for" the infringement, it would have made the infringer's sales. Water Technologies Corp. v. Calco, Ltd., 850 F.2d 660, 671, 7 USPQ2d 1097, 1106 (Fed.Cir.), cert. denied, 488 U.S. 968 (1988). One way to establish "but for" causation is to meet the four-part test pronounced in

Panduit Corp. v. Stahlin Bros. Fiber Works, 575 F.2d 1152, 1156, 197 USPQ 726, 729-30 (6th Cir. 1978). See Standard Havens Prods., 953 F.2d at 1372-73, 21 USPQ2d at 1331. To recover under that test, the patent owner must prove (1) a demand for the patented product, (2) an absence of acceptable noninfringing substitutes, (3) manufacturing and marketing capability to exploit the demand, and (4) the amount of profit the patent owner would have made. Id. (emphasis added).

In ruling against Kearns, the district court concluded that Kearns failed to prove the Panduit requirements for lost profits, particularly with regard to whether he possessed the capability to manufacture and market IWWs. The court determined that "[a]t best plaintiff's offer of proof demonstrates plans for manufacture that were tentative, specula-

tive and contingent. Plaintiff does not suggest he ever made any sales of intermittent windshield wipers or had the manufacturing capability in hand to do so." Kearns disputes the court's finding, stating that his company "Kearns Engineers" had the capacity to manufacture, market, and sell IWWs since the 1960's and that Chrysler's infringement prevented him from selling his IWWs to Chrysler. That contention, however, is not supported by the record.[12] Where, as here, a patent owner fails to prove lost profits, the court is left with no alter-

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[12]We note that the appendices filed by Kearns on appeal contain documents not considered by the district court. We, of course, must limit our review to the record produced at trial. DMI, 802 F.2d at 426, 231 USPQ at 279.

native but to have damages determined on the basis of a reasonable royalty. See Water Technologies, 850 F.2d at 673-74, 7 USPQ2d at 1108.

Accordingly, we affirm the district court's grant of summary judgment in favor of Chrysler on the issue of lost profits.

3. Other Rulings

We have carefully reviewed the district court's other rulings respecting willful infringement, disqualification of counsel, prejudgment interest, and attorneys' fees and costs. The rulings are adequately supported by the record and are consistent with governing law. We need not address Kearns' contentions in detail. For purposes of our decision, suffice it to say that Kearns has not identified any reversible error in law or fact made by the district court in reach-

ing its decisions. Accordingly, we affirm the district court's rulings.

CONCLUSION

The district court did not err in denying Chrysler's post-verdict motions. Nor did the district court commit any reversible error in ruling on the various issues disputed by Kearns. Accordingly, the district court's judgment is affirmed in all respects.

AFFIRMED

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CLERK

U.S. DISTRICT COURT

EASTERN DIVISION

DETROIT

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 82-70748

CHRYSLER CORP.,

Defendant.

FINAL JUDGMENT

This case came on for trial beginning October 16, 1991 before the Court and a jury, the Honorable Avern Cohn, United States District Judge presiding.

On November 22, 1991 the issue of whether plaintiff, Robert Kearns

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(Kearns), proved by a preponderance of the evidence that defendant Chrysler Corporation (Chrysler) infringed the following patent claims: U.S. Patent No. 3,351,836, claim 16; U.S. Patent No. 3,564,374, claim 3; U.S. Patent No. 3,602,790, claim 14; and U.S. Patent No. 3,581,178, claim 7, was submitted to the jury. On December 10, 1991 the jury returned a unanimous verdict in favor of Kearns. On April 28, 1992 the Court granted Chrysler's motion to set aside the verdict and directed entry of judgment in favor of Chrysler on U.S. Patent No. 3,581,178, claim 7.

On April 27, 1992 the issue of whether Kearns proved by clear and convincing evidence that Chrysler willfully infringed and what damages Kearns proved by a preponderance of the evidence was submitted to the same jury. On June 11,

1992 the jury returned a unanimous verdict that Kearns did not prove by clear and convincing evidence willful infringement by Chrysler and that Kearns proved damages in the form of a reasonably royalty, for the total of 12,563,107 infringing units produced by Chrysler during the time period from May 1977 to August 1988, of 90 cents per unit. On June 11, 1992 a judgment was entered in favor of Kearns and against Chrysler in the amount of $11,307,696.30 and on July 31, 1992 an amended judgment was entered in favor of Kearns and against Chrysler in the amount of $11,306,696.30. Thereafter the Court determined the remaining unresolved matters.

IT IS THEREFORE ORDERED, ADJUDGED AND DECREED in substitution for the judgments entered June 11, 1992 and July 31, 1992.

1. Chrysler infringed the U.S. Patent No. 3,351,836, claim 16; U.S. Patent No. 3,564,374, claim 3; and U.S. Patent No. 3,602,790, claim 14, during the period May 1977 to August 1988.

2. The number of infringing units is 12,563,107.

3. The damages suffered by Kearns in the form of a reasonable royalty is 90 cents per unit.

4. Chrysler is indebted to Kearns in the amount of $11,306,696.30 for infringement.

5. Chrysler is indebted to Kearns in the amount of $8,075,193 for prejudgment interest and in the amount of $25,898.75 for costs taxed while Chrysler is entitled to a credit of $667,322.62 under

the Order of August 27, 1992 making the total amount due Kearns under this final judgment $18,740,465 43.

6. All claims, prayers, requests, and motions for relief not specifically adjudged herein are denied and dismissed with prejudice.

7. Still pending is chrysler's motion for a judgment as a matter of law or in the alternative for a new trial.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: OCTOBER 26, 1992 AS OF JUNE 11, 1992

Detroit, Michigan

I hereby certify that the foregoing is a true copy of the original on file in this Office.

CLERK, U.S. DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN

By /s/ Judy Cassady
Deputy

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 82-70748

CHRYSLER CORPORATION,

Defendant.

ORDER (Equitable Relief)

Chrysler has moved for summary judgment on the issue of plaintiff's claim to a right to injunctive relief asserting that the Court's ruling of June 6, 1990 in Kearns v. Ford Motor Co., Civil No. 78-70740, correctly states the law and there is no good reason for the Court to rule otherwise in this case. No useful purpose would be served by oral argument. Plaintiff's patents have expired. There is nothing in statute or common law giving plaintiff the right to an injunction

H-C

against practicing the disclosures in an expired patent. Circumstances where pre-expiration activities carried beyond the expiration of a patent held to be infringed are so different from the circumstances here as to require no discussion. The motion is GRANTED.

SO ORDERED.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: FEB 24 1992

Detroit, Michigan

UNITED STATES OF AMERICA

IN THE UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Honorable Avern L. Cohn

CHRYSLER CORP.

and AMERICAN

MOTORS CORP.,

Defendants.

KEARNS MOTION TO LITIGATE

SIMILARITY AS A BASIS FOR COPYING

The importance of similarity is the basis of Kearns' Motion for this Court and jury to find copying. Kearns' case of similarity is strong. This Court ruled last week that to be a copy, the infringer had to have access to the product, rather than the patent drawings.

In the electronic art, given a product from which to copy a circuit, the in-

A-D

fringer would first have to make a drawing of the circuit. The drawing of the circuit is no different than the drawing of the best embodiments shown in the patent(s).

In Adamson v. Gilliland, 242 U.S. 350, 351-2 (1917) the Supreme Court found copying based on the similarity of the devices of plaintiff and defendant.

In Grepke v. General Electric Co., 280 F.2d 508, 510-11 (7th Cir. 1960) the Court held:

> We might add that this Court in Smith v. Dravo Corp., 203 F.2d 369, 377, said:
>
> 'As a general rule, the similarity standing alone is an adequate basis upon which to find misappropriation. Thus, in Hoeltke v. C.M. Kemp Mfg. Co., 4 Cir., 80 F.2d 912, 924 the Court said:
>
> "The similarity of defendant's device to that of complainant is stron [sic] proof that one was copied from the other."

* * *

As the court said in Golding v. R.K.O. Pictures, 1950, 35 Cal.2d 690, 221 P.2d 95, 98:

> ". . . Was the Plaintiff's material copied by the defendant? There will seldom be direct evidence of plagiarism, and necessarily the trier of fact must rely upon circumstantial evidence and the reasonable inferences which may be drawn from it to determine the issue. An inference of copying may arise when there is proof of access coupled with a showing of similarity. ... Where there is strong evidence of access, less proof of similarity may suffice. ..."

See also, Orange Crush Co. v. American Ornamental Co., 60 F.2d 518, 520 (4 Cir. 1932) and A.C. Aukerman Co. v. General Motors Corp., 202 F.2d 642 646 (4 Cir. 1953) (Parker, C.J.)

The leading modern case on copying is TWM Mfg. Co. v. Dura, 213 U.S.P.Q. 423, 427 (E.C. Mich. 1981), Aff'd 722 F.2d 1261, 1268 (6 Cir. 1983) which was cited with approval in Bott v. Four Star Corp., 807 F.2d 1567, 1576 (Fed. Cir. 1986).

The Federal Circuit citting [sic] in banc cited Bott and TWM as the law on copying in a laches contest, see A.C. Aukerman Co. supra. In TWM, supra, the District Court (p. 427) said that the inventor Turner sent a copy of his patent application to defendant, and there was no evidence as to what happened to it. The Court further said that defendant's officer McGee sai [sic] that he never heard of Turner an [sic] that he got the idea from Verdi (p. 427) who was a consultant to the company (p.427). The Court also noted the coincidence between the inventor's submission and certain acts of defendant. Access plus similarity was held to overcome defendant's evidence that Verdi made the invention independently.

TWM was cited with approval on the copying issue by the Federal Circuit

sitting in banc in the case of Aukerman v. R.L. Chaides decided March 31, 1992.

The Sixth Circuit affirmed, saying:

> "The Court's shifting of the burden of proof to Dura was reasonable, in the light of the difficulties of proving an actual act of copying."

In Bott v. Four Star Corp., 807 F.2d 1567, 1576 (Fed. Cir. 1986) the Court said:

> "In TWM Manufacturing Co. v. Dura Corp., 722 F.2d 1261, 1268, 221 U.S.P.Q. 25, 30, (6th Cir. 983[sic]), the court affirmed the district court's holding that the plaziarizing [sic] of the plaintiff's patent constituted egregious behavior, which defeated the defendant's plea of laches. The district court supported its holding by relying on principles of copyright law and trademark law and held that the plaintiff's proof; that the defendant had access to the patent and had contemporaneously produced an infringing device, shifted the burden to the defendant to prove independent development of the infringing device."

In M.Kramer Mfg. Co. v. Andrews, 783 F.2d 421, 445 (4 Cir. 1986), the Court found that defendant copied plaintiff's

game. The Court said that access plus similarity was usually the form of evidence that proves copying but said that "This case if unusual, however, in that compelling substantial direct evidence of copying was presented." (Emphasis added).

The similarity between two things may be so striking that it will outweigh any evidence of independent development as Judge Soper noted in Orange Crush, supra. For example, if someone in 1992 claimed that he wrote a speech word for word identical with Lincoln's speech at Gettysberg [sic] and had 100 witnesses that said that the speech was independently created, no one would believe the story. The similarity of the two speeches would be just too great. Thus, since the evidence here is that Xerox has made a Chinese copy of the invention shown in the

patent, it is a jury question as to the weight to be given to similarity and to Xerox's assertions of independant [sic] development.

The above cases show the stronger the case of access (to the patent) the less similarity is required. Also, the stronger the case of similarity, the less proof of access is required. Once the patentee makes out a case of access plus similarity, the burden shifts to the defendant to prove that it did not copy.

Access is proved once the Kearns patents were in the hands of Chrysler. The closer the patents got to the engineers who did the work, the stronger the case of access. Similarity is obvious. To Kearns' knowledge, the only two IWWS patents in the world with a capacitor located between the movable arm of the park switch and the base of the transis-

tor controlling the energization; and deenergization of the motor is Chrysler and Kearns. Kearns applied for his patent thirteen years before Chrysler.

WHEREAS, the plaintiff prays that the Court will respond favorably to his Motion and Order that the copying issue will go forward based on the similarity of the Kearns circuit to Chrysler's and that Ford's access was sufficient to shift the burden to Chrysler to prove that it did not copy Kearns. A jury instruction to that effect will issue at an appropriate time.

Respectfully submitted,

/s/ Robert W. Kearns

Robert W. Kearns, Pro Se
211 W. Fort Street, #1401
Detroit, Michigan 48226
(313) 963-2878
(313) 963-2963 (Fax-Voice)

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Washington, D.C.

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UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 87-70748

CHRYSLER CORPORATION

and

AMERICAN MOTORS CORPORATION,

Defendants.

MEMORANDUM AND ORDER

I.

This is a patent case. Now before the Court is the motion of plaintiff Robert W. Kearns (Kearns) styled "Motion to Disqualify Counsel for Defendants," seeking to disqualify the law firm of Harness, Dickey and Pierce (HD&P) from rep-

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resenting defendants Chrysler Corporation (Chrysler) and American Motors Corporation (AMC). For the reasons stated, the motion will be denied.

II.

A.

Kearns argues that because he was represented by HD&P from 1977 to 1979, attorneys Bernard Cantor (Cantor), Robert Nolan (Nolan), who became members of HD&P in 1988, and Gary Newtson (Newtson), who became a member of HD&P in 1990, cannot represent Chrysler in this action. In response, Chrysler and AMC say that Cantor, Nolan and Newtson should not be disqualified. They do not discuss whether HD&P should be disqualified. Specifically, they argue that: 1) Kearns consented to the representation; 2) Kearns' motion is not timely filed; 3) HD&P has made full disclosure and set up an elabo-

rate Chinese wall preventing Cantor, Nolan and Newtson from obtaining any confidential information; and 4) disqualification of Cantor, Nolan and Newtson at this stage of the case would inflict undue hardship.

B.

The relevant facts are set forth in full in the Court's Memorandum And Order, entered August 1, 1991. Also in that Memorandum And Order, the Court found that Kearns did not consent to the representation and that Kearns' motion was timely filed. The Court is satisfied, for the reasons stated in the Memorandum And Order, that the issue presented by this motion is governed by the Michigan Rules of Professional Conduct, but that the facts of this case present a matter of first impression. To that end, the Court posed the following question to the

State Bar of Michigan Professional and Judicial Ethics Committee (Committee):

> May a firm represent a client in a matter in which the client's interests are substantially adverse to the interests of a former client, where the lawyer handling the matter was not associated with the firm at the time of the former client's representation, and where the lawyer handling the matter was representing the client at the time the lawyer became associated with the firm, if appropriate screening devices are in place as required by MRPC 1.10(b) and the lawyer was not associated with the firm at the time that it represented the former client?

The response of the Committee, which is appended in full to this Memorandum And Order, provides in pertinent part:

> MRPC 1.10(b) allows the new firm to continue representation of a client whose interests conflict with those of a former client of the new lawyer, or a former client of the new lawyer's former firm. We see no reason to disallow a similar result when the parties are reversed, with the new lawyer continuing to represent a current client whose interests are adverse to those of the new law firm's former clients, as long as screening is adequate and timely. The Chinese Wall protection is designed

> to quarantine the new lawyer from exposure to confidences of the plaintiff while that plaintiff was a former client of the law firm. the new lawyer is prevented from obtaining confidential information available when plaintiff was the law firm's client nearly 14 years ago, and the law firm is prevented from participating in the representation of a client whose interests conflict with the firm's duties to a former client. Analytica v. NPD Research, 708 F2d 1263 (CA 7, 1983). The Chinese Wall substantially insures that the lawyer in question will have no access to or knowledge of the information, confidences, and/or secrets related by plaintiff in the 1977-1979 representation. Schielssle v Stephens, 717 F2d 417 (CA 7, 1983).

C.

The Court is satisfied that the response of the Committee is well-reasoned and comprehends the entirety of the issue presented by Kearns' motion. Given that a Chinese Wall was properly erected to screen Cantor and Nolan, and later, Newtson, from HD&P, the representation of Chrysler and AMC by these three new law-

yers is not prohibited by HD&P's former representation of Kearns.

III.

A.

Kearns responds that the representation of Chrysler and AMC by Cantor, Nolan and Newtson is prohibited by the MRPC, even in light of the opinion of the Committee. Kearns says that the Committee identified three requirements: 1) the lawyer was not associated with the firm when it represented the former client; 2) the lawyer was representing his client at the time he became associated with the firm; and 3) adequate and timely procedures are in place to screen the firm from the lawyer's client. Kearns would have the Court read the MRPC and the opinion of the Committee to require the disqualification of Cantor and Nolan because they did not represent Chrysler

and AMC at the time they joined HD&P. Kearns would have the Court further find that Newtson must be disqualified, unless an adequate Chinese Wall were also erected to screen Newtson from Cantor and Nolan.

B.

The position of the Chinese Wall is not, as Kearns says, determined by the present representation of Chrysler and AMC. Rather, it is determined by HD&P's previous representation of Kearns. The Chinese Wall with HD&P on one side and Cantor and Nolan on the other was erected, in part, because Cantor and Nolan were representing several defendants in cases brought by Kearns involving the "same or a substantially related matter" to HD&P's prior representation of Kearns. The quarantine of Cantor and Nolan was properly established to safeguard the

confidences of HD&P's former client. That Chinese Wall was enlarged to screen HD&P and Newtson for the same purpose.

Kearns' interpretation of the MRPC and the opinion of the Committee, as requiring a second Chinese Wall screening Newtson from Cantor and Nolan, is incorrectly narrow and formalistic. The protection of the confidences of HD&P's former client was fully and properly effectuated by erecting a wall screening HD&P from the new lawyers representing parties adverse to the firm's former client. It is not relevant to the purposes for quarantining the new lawyers that they did not all represent the same parties prior to their arrival at HD&P, but only that they all represented parties with interests adverse to those of HD&P's former client. To further screen the new lawyers by erecting another Chi-

nese Wall with Newtson on one side and Cantor and Nolan on the other does not provide any additional safeguard to the former client of the already screened firm. A second wall could, however, impede the ability of the new lawyers to provide their current clients with adequate representation.

IV.

For the reasons stated, the Motion to Disqualify Counsel for Defendants is DENIED.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: SEP 25 1991

Detroit, Michigan

UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,	)	Hon. Avern Cohn
Plaintiff,	)	Civil No. 82-70748
v.	)	
CHRYSLER CORP.,	)	
Defendant.	)	

ORDER

Plaintiff's motion styled "Motion for Judgment Notwithstanding the Verdict/Judgment According to Law that American Motors Corporation Willfully Infringed Dr. Kearns' Patents," is denied without prejudice.

Plaintiff's claim that American Motors willfully infringed his patents has never been adjudicated in this case. No judgment with respect to the issue of whether American Motors infringed any of Dr.

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Kearns' patents has been entered in this case.

SO ORDERED.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

Dated: July 28, 1992

Detroit, Michigan

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UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 82-70748

CHRYSLER CORPORATION,

Defendant.

ORDER (Loss of Profits)

Chrysler has moved for summary judgment on the issue of loss of profits as damages for its infringement of plaintiff's patents asserting that plaintiff cannot make the requisite showing of sales of the patented product of the manufacturing and marketing capability for the patented product. No useful purpose would be served by oral argument. The factual predicate for plaintiff's assertion of the right to loss of profits are not so different than in Kearns v. Ford Motor

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Co., Civil No. 78-70740, as to require a different ruling. See Kearns v. Ford Motor Co., 726 F. Supp. 159, 162 (E.D. Mich. 1989). At best plaintiff's offer of proof demonstrates plans for manufacture that were tentative, speculative and contingent. Plaintiff does not suggest he ever made any sales of intermittent windshield wipers or had the manufacturing capability in hand to do so. The motion is GRANTED.

SO ORDERED.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: FEB 24 1992

Detroit, Michigan

UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,	)	Hon. Avern Cohn
Plaintiff,	)	Civil No. 82-70748
v.	)	
CHRYSLER CORP.,	)	
Defendant.	)	

ORDER

The number of infringing units shall be presented to the jury as follows:

The Court has marked as Exhibit 1 a list of numbers of intermittent windshield wiper controller units admitted by Chrysler to have been produced in each year by Chrysler Corporation and American Motors Corporation.

Dr. Kearns may not offer evidence with regard to infringing units for Chrysler and American Motors above those set forth in Exhibit 1 without filing with the

A-4

Court, prior thereto, the documentary evidence that supports additional units.

SO ORDERED.

see attached (handwritten)

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

Dated: April 28, 1992

Detroit, Michigan

CHRYSLER CORPORATION
INTERMITTENT WINDSHIELD WIPER VOLUME INFORMATION
(all data by model year)

YEAR	U.S. Automobiles	U.S. Trucks	Canadian Automobiles	Canadian Trucks	Exports	After Market Parts	Total
1977	26,771	0	0	0	0	0	26,771
1978	462,244	13,235	75,271	1,393	309	0	553,452
1979	452,663	23,782	775,843	2,525	10,503	0	575,316
1980	216,103	7,346	47,998	4,387	6,442	0	282,276
1981	255,431	31,817	33,056	6,943	3,643	0	344,900
1982	311,715	58,242	37,654	3,496	3,935	0	415,042
1983	582,521	89,457	79,605	5,659	5,916	0	763,158
1984	837,692	256,411	124,486	15,256	6,576	0	1,241,431
1985	1,068,203	376,564	148,401	32,451	6,923	0	1,632,542
1986	1,038,093	341,593	125,573	37,188	7,922	95,081	1,645,450
1987	1,034,530	485,151	129,547	49,536	13,524	11,901	1,724,189
1988	985,698	564,512	140,788	71,291	24,910	11,266	1,798,465
1989	153,237	137,250	20,506	15,356	11,377	0	337,729
TOTAL WIPER INSTALLED	7,449,901	2,325,360	1,038,738	246,494	101,980	118,248	11,340,721

EXHIBIT 1

AMERICAN MOTORS
INTERMITTENT WINDSHIELD WIPER VOLUME INFORMATION
(all data by model year)

	AMC	JEEP™	TOTALS
1979	23,069	8,285	31,354
1980	199,613	4,097	203,710
1981	16,621	22,236	38,857
1982	15,676	28,058	43,734
1983	37,997	51,748	89,745
1984	38,394	16,973	55,331
1985	0	158,441	158,441
1986	12,905	137,161	150,066
1987	13,297	173,177	186,474
1988	47,621	217,017	264,638
TOTAL IWW INSTALLED	405,193	817,193	1,223,386

RECEIVED AUG 27 1992

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. CIVIL NO.

CHRYSLER CORPORATION, 82-CV-70748-DT

Defendant. HONORABLE

AVERN COHN

ORDER

On June 24, 1992, defendant filed a motion styled Defendant Chrysler Corporation's Motion for Costs, Expenses and Attorney Fees. On July 9, 1992, defendant filed a supplement styled Chrysler Corporation's Supplemental Submission on Costs Sought to be Recovered from Plaintiff. A summary of these two papers is set out in Exhibit A attached. On August 12, 1992, plaintiff filed a paper styled

H-I

Kearns' Opposition to Defendant Chrysler Corporation's Motion for Costs, Expenses and Attorney Fees. The paper is not altogether responsive to the motion and in particular does not take issue with the categorization, hours, hourly charges and expenses set forth in the supplement. On July 31, 1992, the Court scheduled the motion for hearing on August 18, 1992. The Court heard argument on the motion on August 18, 1992. Plaintiff did not present any argument against the motion. Under the circumstances the Court finds defendant's categorization, hours, hourly charges and expenses accurate and reasonable.

The motion cuts too broad. There is no authority to parse the results of a trial and award costs to the successful party on particular issues. Defendant

was not the prevailing party for the purpose of awarding costs.

The record reflects two significant changes in counsel by plaintiff under circumstances where the trial date was delayed, additional expenses incurred as a consequence by defendant should be paid by plaintiff. These additional expenses were incurred because the Joint Pretrial Statement had to be revised, stipulations renegotiated, additional discovery taken, additional conferences held, and additional research and preparation of papers necessary. Plaintiff's papers fairly describe these events except as will be commented on below. Additionally, plaintiff persisted in advancing legal theories which the Court by its previous orders made clear had no merit. Plaintiff's persistence in pursuing these

theories resulted in additional expenses by defendant.

Particularly:

A. Plaintiff had no good reasons to change counsel. By ultimately discharging counsel and proceeding pro se, plaintiff required several postponements of the trial date. Chrysler had every right to act on the trial date set for July and acted reasonably in incurring extraordinary expense to meet that date. Had plaintiff acted reasonably in the matter of counsel, defendant would not have had to incur such additional expenses but could have proceeded at a normal pace. Plaintiff [sic] is entitled to reimbursement for such additional expenses as caused by plaintiff's unreasonable conduct with regard to counsel.

B. Defendant had a right to expect to go to trial on Claim 6 of the '178

patent. The change to a claim of infringement of Claim 7 was due solely to plaintiff. The additional expenses incurred by defendant should be paid by plaintiff under these circumstances.

C. There was no significant change in plaintiff's damage theory which allows for charging him with any of defendant's expenses. Defendant made no effort to limit plaintiff to the $.70 per unit royalty consistent with the interrogatory answer. Some latitude is inherent in defining a reasonable royalty in a patent case. Experience should have cautioned defendant of the likelihood of some different royalty rates at trial.

D. The revisions to the Joint Pretrial Statement were solely due to the change of counsel by plaintiff. The additional expenses incurred by defendant

in negotiating the revisions properly should be borne by plaintiff.

E. The disqualification motion was not inappropriate. Defendant's response was excessive. Each party properly should bear the expenses incurred in resolving this matter.

F. An offer of judgment should be kept confidential. Plaintiff's withholding of consent was unreasonable. Plaintiff's failure to agree to confidentiality which resulted in additional expenses to defendant should be borne by plaintiff.

G. The involvement of American Motors Corporation in this case was not well handled by plaintiff, defendant or the Court. Defendant is not entitled to its expenses on this matter.

H. The change in counsel should not have necessitated the reopening of dis-

covery since the change took place after discovery closed. Plaintiff's counsel which conducted discovery had previously been successful in a like case for plaintiff. Defendant's expenses resulting from the reopening of discovery should be charged to plaintiff.

I/J. "Lost Profits" and "equitable relief" should not have been an issue in this case. The Court's position was well known to plaintiff and the likelihood of success by plaintiff on these issues was nil. It would have been a simple matter for plaintiff to protect the record on these issues for appeal. The additional expenses incurred by defendant in defending against these claims are properly chargeable to plaintiff.

K. The plaintiff's lack of skills in legal matters oftentimes resulted in his filing papers that were either redundant,

unnecessary, or excessive. Many times such papers required a response by defendant even though there was no good reason for their being filed. The expenses incurred by defendant in this regard should be charged to plaintiff.

L. Plaintiff's copying case was based on conjecture and not on evidence. A reasoned preliminary view of the evidence available to him should have made it clear to plaintiff that copying was not properly an issue. Defendant's expenses incurred in meeting this assertion are properly chargeable to plaintiff.

In summary, plaintiff is chargeable with the expenses incurred by defendant as follows:

A. Postponement of Trial Date	$136,209.20
B. Change in Liability Theory of the Case	381,063.02

D. Revisions to the Previously-Agreed Pretrial Order	$ 13,843.00
F. Protective Order Motions to Prevent Kearns from Disclosing the Amount of the Rule 68 Offer	2,881.20
G. American Motors Issue	5,555.60
H. Re-Opening of Discovery	40,741.00
I. The Lost Profits Pleading	14,705.00
J. The Equitable Relief Pleadings	5,452.30
K. Other Frivolous Pleadings	36,710.00
L. Copying Case	30,162.30
TOTAL	$667,322.62

The $667,322.62 shall be applied as a credit against the amounts due plaintiff as a consequence of the judgment and award of prejudgment interest and costs

in plaintiff's favor. This amount is not independently recoverable by defendant.

The Court, in charging plaintiff for defendant's expenses, relies on 28 U.S.C. § 1927. which reads:

> Any attorney or other person admitted to conduct cases in any court of the United States ... who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct

and the Court's inherent power. See In re Reuben, 825 F.2d 977, 982-984 (6th Cir. 1987).

SO ORDERED.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: August 27, 1992

Detroit, Michigan

EXHIBIT A

I. Defendant Chrysler Corporation's Motion For Costs, Expenses And Attorney Fees.

A. The Court Should Award Costs, Expenses And Fees To Chrysler Under 28 U.S.C. § 1927 or, in the Alternative, Pursuant to the Court's Inherent Equitable Power.

1. Dr. Kearns' Repeated Changes in Counsel.

a. Revocation and Revisions of Agreements and Stipulations.

b. Revision of Case Theory.

c. Discovery Related Expenses.

d. Additional Conferences and Hearings.

e. Additional Research and Preparation of Pleadings.

2. Dr. Kearns' Insistence on Advancing Frivolous Theories.

B. Pursuant to Rule 54(d) of the Federal Rules of Civil Procedure, Chrysler is Entitled to Recover its Costs Because it is the Prevailing Party on the Issue of Willfulness.

(i) Fees of the Court Reporter.

(ii) Fees for Copies.

(iii) Fees for Charts.

(iv) Costs for Taking Depositions.

II. Chrysler Corporation's Supplemental Submission on Costs Sought To Be Recovered From Plaintiff.

A. Postponement of the Trial Date.

Partner hours	
222.25 hours	$ 57,785.00
Associate hours	
159.50 hours	27,912.50
Paralegal hours	
489.59 hours	26,922.50
Secretarial overtime	3,738.00
Temporary clerical personnel	7,738.38
Rush work on Exhibits	326.25
Extra transportation for experts	3,677.58
Emergency rentals of computers and other equipment	681.64
Extra use of fax, Network Courier and Federal Express	4,149.25

Charges for expediting deposition	$ 3,278.10
TOTAL	$136,209.20

B. Change in Liability Theory of the Case.

1. Experts

Lynn Conway	$ 18,838.50
George Frost	19,775.00
LeRoy Silva	14,080.00
Paul Enlow	7,926.00
Kathleen Cloffy	540.00
William Rubbens	3,166.25
TOTAL	$ 64,325.75

2. Exhibits

Geographical Demonstrative Evidence	$ 2,998.20
Forensic Technologies International	65,964.07
TOTAL	$ 68,962.27

3. Lawyers

Partner time

512 hours $133,120.00

Associate time

452 hours 79,000.00

Paralegal time

356 hours 35,655.00

TOTAL $247,775.00

B. = TOTAL $381,063.02

C. Change in the Damages Theory of the Case.

1. Experts

Price Waterhouse $ 3,500.00

2. Exhibits

Graphics and Demonstrative Exhibits $ 4,588.20

3. Lawyers

Partner time

10 hours $ 2,600.00

Associate time

2 hours 350.00

Paralegal time

5 hours 275.00

Duplicity

250 pages 25.00

TOTAL $ 3,250.00

C. = TOTAL $ 11,338.20

D. Revisions to the Previously-Agreed Pretrial Order.

Partner time

45 hours $ 11,700.00

Associate time

3 hours 525.00

Paralegal time

28 hours 1,540.00

Duplicating charges

780 pages 78.00

TOTAL $ 13,843.00

E. Disqualification Motions

Partner time

15 hours $ 3,900.00

Associate time	
10 hours	1,750.00
Paralegal time	
8 hours	440.00
Mayer, Brown & Platt	
Charges	244,466.50
Duplicating Charges	
357 pages	35.70
TOTAL	$250,592.20

F. Protective Order Motions to Prevent Kearns from Disclosing the Amount of the Rule 68 Offer.

Partner time	
2 hours	$ 520.00
Associate time	
13 hours	2,275.00
Paralegal time	
1.5 hours	82.50
Duplicating Charges	3.70
TOTAL	$ 2,881.20

G. American Motors Issue.

Partner time	
7 hours	$ 1,820.00
Associate time	
20 hours	3,500.00
Paralegal time	
4 hours	220.00
Duplicating Charges	
156 pages	15.60
TOTAL	$ 5,555.60

H. Re-Opening of Discovery.

Partner time	
80.50 hours	$ 20,930.00
Associate time	
6.75 hours	9,931.80
Paralegal time	
96.25 hours	5,293.75
Duplicating Charges	
pages	62.00
Transcript Costs	3,233.45

	Travel Costs	1,290.00
	TOTAL	$ 40,741.00
I.	The Lost Profits Pleading.	
	Partner time	
	12 hours	$ 3,120.00
	Associate time	
	52 hours	9,875.00
	Paralegal time	
	20 hours	1,100.00
	Duplicating Charges	
	610 pages	610.00
	TOTAL	$ 14,705.00
J.	The Equitable Relief Pleadings.	
	Partner time	
	10 hours	$ 2,600.00
	Associate time	
	15 hours	2,625.00
	Paralegal time	
	4 hours	220.00
	Duplicating Charges	

	73 pages	7.30
	TOTAL	$ 5,452.30
K.	Other Frivolous Pleadings.	
	Partner time	
	38 hours	$ 9,880.00
	Associate time	
	120 hours	21,000.00
	Paralegal time	
	100 hours	5,500.00
	Duplicating Charges	
	3,300 pages	330.00
	TOTAL	$ 36,710.00
L.	Copying Case.	
	Partner time	
	73 hours	$ 18,980.00
	Associate time	
	15 hours	2,625.00
	Paralegal time	
	10 hours	550.00
	Expert Witness time	
	20 hours	8,000.00

Duplicating Charges	
73 pages	7.30
TOTAL	$ 30,162.30
OVERALL TOTAL	$916,553.02

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UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS

Plaintiff,

-vs- Civil No. 82-70748

CHRYSLER CORPORATION,

Defendant.

MEMORANDUM

This memorandum supplements the Memorandum and Order of August 24, 1992 awarding plaintiff prejudgment interest in this patent case. It elaborates on the reasons the Court exercised its discretion in favor of an award with minimal exceptions for plaintiff caused delay.

The record fairly read does not reflect "circumstances in which it may be appropriate not to award prejudgment interest" General Motors Corporation v.

A-J

Devex Corporation, 461 U.S. 648, 657 (1983), particularly in light of the admonition that "prejudgment interest should ordinarily be awarded where necessary to afford the plaintiff full compensation for the infringement." Id. at 654.

Defendant initiated the stay which figures so prominently in its argument against an award. See Defendant's Motion to Stay Proceedings and Memorandum In Support of Defendant's Motion To Stay Proceedings filed September 1, 1982 ("Therefore, rather than spend the Court's time and substantial amount of money on behalf of Chrysler Corporation, which it can ill afford, it is respectfully requested that proceedings in this case be stayed as requested in the motion.").

The case when filed was assigned to a judge other than the judge on whose dock-

et the other of plaintiff's patent cases were pending. No effort was made to reassign it to that judge. In 1987, the case was administratively dismissed without opposition. See Order of Removal of Action as a Pending Matter filed June 30, 1987 ("Counsel have concurred in the entry of this order."). There is no record of a protest to Ford Motor Company that it was delaying pursuit of its defense in Kearns v. Ford Motor Company, Civil. No. 78-70740, the result in which this case was linked, to defendant's detriment. There is no record of a request of the judge in the Ford case to move it forward or of an effort to unlink this case because of a detriment being suffered by defendant by delay. While the docket of the Ford case reflects long periods of inaction, overall there was a good deal of movement in plaintiffs other

cases, albeit mostly laterally. Indeed, a composite docket of this case, the Ford case and Case Nos. 78-70642, 82-70749 & 85-70459, would likely show no period of inaction.

This case was taken off the inactive list and assigned to the docket of this Court on March 23, 1989. The stipulated stay was extended on February 16, 1990, with no mention made of a detriment to defendant begin caused by the delay in bringing this case to trial. The first formal effort to abate prejudgment interest was made on January 6, 1992. Defendant was apprised of the Court's attitude on the issue on September 27, 1990 when the Court awarded prejudgment interest in the Ford case. See Memorandum and Order on Award of Interest in Civil No. 78-70740 filed September 27, 1990.

In sum, this case simply does not reflect the fact circumstances the Supreme Court had in mind when it noted in Devex that "it may be appropriate to limit prejudgment interest, or perhaps even deny it altogether ... " 461 U.S. at 657[1]

The Court is satisfied its exercise of an informed discretion awarding prejudgment interest is free of abuse; that is all that is required of it.

/s/ Avern Cohn

AVERN COHN

United States District Judge

Dated: AUG 27, 1992

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[1] See the cases, treatises and law review note cited by the Supreme Court in Devex, 461 U.S. at 657 fn 11, which confirm this view.

UNITED STATES COURT OF APPEALS FOR THE

FEDERAL CIRCUIT

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT

EASTERN DISTRICT

OF MICHIGAN

in CASE NO(S) 82-70748

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED.

AFFIRMED

A-K

ENTERED BY ORDER

DATED AUG 11 1994 OF THE COURT

/s/ Francis X. Gindhart, Clerk

Francis X. Gindhart, Clerk

ISSUED AS A MANDATE: October 5, 1994

EXHIBIT F

No.

In The

SUPREME COURT of the UNITED STATES

October Term, 1995

ROBERT W. KEARNS,

Petitioner,

vs. CAFC No. 93-1535

GENERAL MOTORS

CORPORATION,

Respondent.

---

and

ROBERT W. KEARNS,

Petitioner,

vs. CAFC Nos.

CHRYSLER CORPORATION 93-1450,-1470

and

AMERICAN MOTORS

H-L

CORPORATION,

Respondents.

Application for Enlargement of Times to file under Supreme Court Rule 30.3. Petitions for Writs of Certiorari to the Court of Appeals for the Federal Circuit for the above two cases, and, for the Due Dates to be Appropriately Serialized

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ROBERT W. KEARNS, Pro Se
301 Houghton Laboratory Lane
Queenstown, Maryland 21658
(410) 827-9337 (Tel/Fax)

28 U.S.C. §2403(a) may be applicable.

Purpose

The purpose of this application is to seek the enlargement of times for petitioner, Robert W. Kearns, ("Dr. Kearns") a *pro se* manufacturing-inventor, to file Petitions for Writs of Certiorari to review Judgments, Opinions and Rules pertaining to the Court of Appeals for the Federal Circuit ("CAFC") for the two styled cases shown on the cover, and, for the enlarged-times due dates to be appropriately serialized with on-going Appellant Briefs scheduled at the CAFC.

Jurisdiction

Jurisdiction of this Supreme Court follows from that of Title 28 § 1338(a) & § 1254(1). This application is made under Supreme Court Rule 30.3.

The Judgment sought to be reviewed in *Kearns* v. *General Motors Corporation* is attached at Exhibit A. The Petition

for Rehearing is attached at Exhibit B. The Order on rehearing is attached at Exhibit C.

The Opinion announcing the Judgment sought to be reviewed in *Kearns* v. *Chrysler Corporation* and *American Motors Corporation* is attached at Exhibit D. The suggestion for rehearing is attached at Exhibit E. The order respecting rehearing is attached at Exhibit F.

Background

Dr. Kearns has created patented-products, and with his family manufactured and sold them throughout the United States. They sold and exported same under licenses from the U.S. Department of Commerce to France and Japan as well. [Exhibit G[1]]

In addition, Dr. Kearns invented,

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[1] Kearns Engineers products were sold under the registered trademark Computer Central®.

"Windshield Wiper System with Intermittent Operation", U.S. patent 3,351,836, which he and his family are capable of manufacturing and exporting as components and sub-systems. [Exhibit H]

Intermittent windshield wiper systems ("IWWSs") are now commonly assembled into models from every automobile manufacturer in the western world. In *Kearns* v. *Ford Motor Company* ("Ford") the jury result found six of Dr. Kearns' IWWS U.S. patents valid with Ford admitting infringement if the patents were valid. In *Kearns* v. *Chrysler Corporation and American Motors Corporation*, the jury result found four of Dr. Kearns' IWWS U.S. patents infringed. Dr. Kearns also had filed and maintains actions against the remaining automobile manufacturers in the

western world except Fiat[2] and against others [Exhibit I]. All the cases shown stem from the same Windshield Wiper art litigation. The life of a U.S. patent is seventeen years. Dr. Kearns has been waiting for some of his windshield wiper litigation to get to trial for seventeen years! All of Dr. Kearns' infringement suits have now been dismissed from the U.S. District Court for the Eastern District of Michigan Southern Division ("in Detroit"). Dr. Kearns is functioning *pro se* under a Federal Court order [Exhibit J]. Are Dr. Kearns and U.S. citizens to be punished for his inventing a "too successful" pro-duct in seeking his 'remedy' under Title 35 § 281 and under Title 35 § 283 for the - time - due him for

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[2] Fiat no longer does business in the U.S. of A.

these many infringements[3] from the Judiciary operating under the Title 28 statute and the Rules of the Fed. R. of Civ. P. which the U.S. Congress authorized the U.S. Supreme Court to promulgate to the lower courts after enacting enabling legislation?

The Need

The U.S. Constitution established and defined the authority of the U.S. Supreme Court. The U.S. Constitution established the standard of compensation of the U.S. inventor - time - (not money) if Congress chose to promote the progress of science and the useful arts. The Congress establishes only the length of that 'exclusive right' time, now that 'to promote' has been chosen.

---

[3] The writ of certiorari concerning General Motors Corporation's past damage-actions total 70 million infringements. The writ of certiorari concerning Chrysler Corporation and American Motors Corporation damage actions total 17 million infringements.

It is germane: that Dr. Kearns must exhaust the Judiciary 'remedy' to obtain his Constitutional standard of compensation - time - as an inventor; that his appearance is personal under Title 28 U.S. Code § 1654; and, that his appearance is restricted under an order regarding his *pro se* status [Exhibit J].

It is in the public interest for Dr. Kearns to exhaust the Judiciary 'remedy' to obtain his - time - as his family manufacturing and exporting to the defendants that were in the U.S. District Court in Detroit the incremental ($50 cost added to the already-present wiper motors, switches, wiring, etc.) IWWS component would make a difference in the U.S. trade deficit of 1.2 percent. He and his family manufacturing and exporting the whole ($200) IWW sub-assembly to the defendants would make a difference in

the U.S. trade deficit of 4.8 percent. The U.S. trade deficit is $10 billion per month and establishes the average U.S. citizen's standard-of-living. During the time consumed by the Judiciary review of the litigation of Exhibit I the U.S. citizen's standard-of-living has gone from 3rd in the world to 10th in the world!

Dr. Kearns had to spend three days, 30 October - 1 November, 1994, in traveling and being in Detroit to defend against the dismissal of another of his cases. After Dr. Kearns presented 12 legal case references, the District Judge took the dismissal "under advisement."

From the content of Rule 5 of the U.S. Supreme Court it is apparent that a lawyer attaining a Supreme Court appearance once is significant. But to attain the public interest identified above, Dr.

Kearns needs to prepare for multiple exposure to the Supreme Court and the CAFC. There are 60,000 $25,000-per-year jobs here that would flow from the Judiciary improving their rules and enforcing U.S. patents. In promulgating the Fed. R. Civ. P. did the U.S. Supreme Court intend to punish the inventor of a product which is allegedly (but not *Kearns* v. *Ford Motor Company*) infringed by every automobile assembler in the western world?

Dr. Kearns' present schedule requiring relief is:

first, an appellant's brief and appendix by 14 November 1994 in the CAFC in 94-1310 *Kearns* v. *United Technologies, Inc.* and *United Technologies Automotive, Inc.*;

second, a petition for writ of certiorari by 22 November 1994 in the U.S.

Supreme Court in *Kearns* v. *General Motors Corporation*;

third, an appellant's brief and appendix by 18 December 1994 in the CAFC in 95-1016 *Kearns* v. *Chrysler Corporation* and *American Motors Corporation*; and,

fourth, a petition for a writ of certiorari by 27 December 1994 in the Supreme Court of 93-1450, -1470 in *Kearns* v. *Chrysler Corporation* and *American Motors Corporation*.

To attain the goals of U.S. Const. Art. I, § 8, cl. 8 calls for the exercise of this Court's power of supervision after an understanding by the Supreme Court of the problems Dr. Kearns and the U.S. of A. faces. He prays for and needs enlargements of times and serializing of due dates from the U.S. Supreme Court that are applicable to a one-man team as stated. Comparable relief is concurrent-

ly being sought from the CAFC. Other windshield wiper patent cause litigation continues as well.

Respectfully submitted,

Robert W. Kearns, *Pro Se*

AFFIDAVIT OF SERVICE

Robert W. Kearns, being duly sworn states as follows:

1. I am the inventor, plaintiff and *pro se* representative of the civil actions of Exhibit I.

2. A copy of

Motion for Enlargement of Times to file under Supreme Court Rule 30.3.

Petitions for Writs of Certiorari to the Court of Appeals for the Federal Circuit

for the above two cases, and,

for the Due Dates to be Appropriately Serialized

was mailed this 3rd day of November 1994:

to General Motors Corporation

through:

also, to:

Allegretti & Witcoff, LTD.

Solicitor General,

Attn: D. Dennis Allegretti

Department of Justice,

75 State Street, 23rd Floor

Washington, D.C. 20530

Boston, Massachusetts 02109

(617) 345-9100

and, to Chrysler Corporation through:

Pillsbury, Madison & Sutro

Attn: Michael A. Conley, Esq.

1667 K Street, N.W.

Washington, D.C. 20011

(202) 887-0300.

3. All parties required to be served have been served by this mail.

Further, affiant sayest not.

_____

Robert W. Kearns

STATE OF MARYLAND)

) s.

COUNTY OF TALBOT)

Subscribed and sworn to before me on this 3rd day of November 1994.

_____

Notary Public

My commission expires _____.

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FILED OCT 26 3:42 PM 92

CLERK

U.S. DISTRICT COURT

EASTERN DIVISION

DETROIT

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 82-70748

CHRYSLER CORP.,

Defendant.

FINAL JUDGMENT

This case came on for trial beginning October 16, 1991 before the Court and a jury, the Honorable Avern Cohn, United States District Judge presiding.

On November 22, 1991 the issue of whether plaintiff, Robert Kearns

EX. A

(Kearns), proved by a preponderance of the evidence that defendant Chrysler Corporation (Chrysler) infringed the following patent claims: U.S. Patent No. 3,351,836, claim 16; U.S. Patent No. 3,564,374, claim 3; U.S. Patent No. 3,602,790, claim 14; and U.S. Patent No. 3,581,178, claim 7, was submitted to the jury. On December 10, 1991 the jury returned a unanimous verdict in favor of Kearns. On April 28, 1992 the Court granted Chrysler's motion to set aside the verdict and directed entry of judgment in favor of Chrysler on U.S. Patent No. 3,581,178, claim 7.

On April 27, 1992 the issue of whether Kearns proved by clear and convincing evidence that Chrysler willfully infringed and what damages Kearns proved by a preponderance of the evidence was submitted to the same jury. On June 11,

1992 the jury returned a unanimous verdict that Kearns did not prove by clear and convincing evidence willful infringement by Chrysler and that Kearns proved damages in the form of a reasonably royalty, for the total of 12,563,107 infringing units produced by Chrysler during the time period from May 1977 to August 1988, of 90 cents per unit. On June 11, 1992 a judgment was entered in favor of Kearns and against Chrysler in the amount of $11,307,696.30 and on July 31, 1992 an amended judgment was entered in favor of Kearns and against Chrysler in the amount of $11,306,696.30. Thereafter the Court determined the remaining unresolved matters.

IT IS THEREFORE ORDERED, ADJUDGED AND DECREED in substitution for the judgments entered June 11, 1992 and July 31, 1992.

1. Chrysler infringed the U.S. Patent No. 3,351,836, claim 16; U.S. Patent No. 3,564,374, claim 3; and U.S. Patent No. 3,602,790, claim 14, during the period May 1977 to August 1988.

2. The number of infringing units is 12,563,107.

3. The damages suffered by Kearns in the form of a reasonable royalty is 90 cents per unit.

4. Chrysler is indebted to Kearns in the amount of $11,306,696.30 for infringement.

5. Chrysler is indebted to Kearns in the amount of $8,075,193 for prejudgment interest and in the amount of $25,898.75 for costs taxed while Chrysler is entitled to a credit of $667,322.62 under

the Order of August 27, 1992 making the total amount due Kearns under this final judgment $18,740,465.43.

6. All claims, prayers, requests, and motions for relief not specifically adjudged herein are denied and dismissed with prejudice.

7. Still pending is chrysler's motion for a judgment as a matter of law or in the alternative for a new trial.

/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: OCTOBER 26, 1992 AS OF
JUNE 11, 1992
Detroit, Michigan

I hereby certify that the foregoing is a true copy of the original on file in this Office.

CLERK, U.S. DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN

By /s/ Judy Cassady
Deputy

301 Houghton Laboratory Lane

Queenstown, Maryland 21658

26 July 1994

U.S. Court of Appeals for

the Federal Circuit

Attn: Panel for Appeal

No. 93-1535

The National Courts Building

717 Madison Place, N.W.

Washington, D.C. 20439

PETITION FOR REHEARING UNDER RULE 40.

In a late-night Law Library study by Dr. Kearns on 26 July 1994, Dr. Kearns found the law which supports Dr. Kearns' argument that the dismissal of *Kearns v. General Motors* (Civil No. 85-70461) from the Detroit District Court was premature. Therein, Dr. Kearns needed full discovery from General Motors before being able to specify complete patents and claims. In essence, Dr.

Ex. B

Kearns was asked by the Detroit court to limit his case to expired patents. We now know that additionally, GM was infringing live 'routine life' patents. The need for Dr. Kearns' discovery is shown, for example, by these facts (1) Dr. Kearns received only A-159 and A-160 which are only partial GM copies [attached as A-1 and A-2] and (2) did not receive A-3 and A-4 which are complete GM copies of A-1 and A-2 until given to this panel by GM at the oral hearing.

The District Judge required that Dr. Kearns limit his case first by voluntary agreement - and second only then would the District Judge allow Dr. Kearns discovery of the details of operation of the GM devices. See p. 10 of DR. KEARNS' RESPONSE TO BRIEF OF THE DEFENDANT-APPELLEE GENERAL MOTORS CORPORATION in CAFC No. 93-1535 (attached as A-5) wherein:

THE COURT: No, liability comes first. If you are willing to confine yourself to the two Delco circuits and then identify which claims of which patents you believe they infringe, then I think you could go forward with a deposition of someone from GM to describe in more detail how these circuits operate.

The following Federal Rules Decisions case indicates the Detroit District Court was in error when it limited Dr. Kearns' ability to obtain circuit-detail discovery necessary to his ability to identify the patents and claims in accordance with the District Judge Cohn's order. In doing so, Judge Cohn abused his discretion leading to Dr. Kearns no being able to comply with the Judge's Order to identify the claims as he had not had discovery from GM. To wit:

Smith et al. v. Buckeye Incubator Co., 2 FRD 134 [A-5]

p.135R:

Defendant [the infringer] submits that its motions are filed in

accordance with Rule 12(e) [Read 41(b)] of the Rules of Civil Procedure, 28 U.S.C.A. following section 723c.

Plaintiffs [the inventors] submit that the request, if proper at all, should be brought by way of discovery and not under Rule 12(e);

p. 136L:

"Request 2(h) asks that plaintiff be required to state the claims of the patent in suit that plaintiff will rely upon at the trial of the cause as covering defendant's machines. In accordance with established practice, plaintiff is willing to advise defendant provided plaintiff is permitted to inspect the defendant's form of egg turning mechanisms for incubators as included in its products for the period since the date of issuance of the patent in suit, August 22, 1939, and prior to the filing of the bill of complaint; or, defendant gives to plaintiff drawings and full information with respect to such egg turning mechanisms in such detail as will permit of plaintiff properly to specify such claims. *Holske v. Harder Refrigerator Corp.* [D.C.] 28 F. Supp 344; *Morton Trust Co. v. American Car & Foundry*, 3 Cir., 129 F. 916. And again, "Plaintiffs herein are entirely willing to specify the claims to be relied upon, provided they are permitted to obtain full information regarding the types of egg turning

mechanisms for incubators made, used or sold by defendant since the date of the issue of patent in suit".

The court finds that so much of defendant's motion as is contained in sub-paragraph (h) of Request 2 is well taken, and that the motion to that extent should be, and it is, sustained, provided the procedure is followed and the information just above outlined is supplied to plaintiffs by defendant as suggested in and quoted from the briefs of counsel for plaintiffs.

p. 137R:

The ruling of the court is to the effect only that the information sought should not be supplied in accordance with defendant's present motions "For Bill of Particulars and more definite statement." This is the view also expressed in *Brinley v. Lewis*, D.C., 27 F. Supp. 313, at page 314, wherein it is stated by the court

> "It is evident that the framers of these rules did not intend that compliance with Rule 8 should expose a plaintiff to a motion under Rule 12(e). Attention is called to Rules 33 to 37 inclusive, which provide a simple and expeditious method of obtaining detailed information as to the cause of action and of limiting the issues to be tried."

Thus, to Dr. Kearns the inventor files the patents alleged to be infringed and following discovery the Final Pretrial Order contains the details of each patents infringement. Otherwise, as Dr. Kearns told the District Court, the Complaint would have to be revised, say monthly, as discovery progresses in a patent case. Fed. R. Civ. P. Rules 33 to 37 inclusive, with supplementing answers as required, allow the details of the Final Pretrial Order to be developed in an orderly manner including expansion of the list of patents stated in the Complaint.

In this petition for rehearing, the District Court abused its discretion by not allowing Dr. Kearns discovery **before** asking him to limit his case. Judge Cohn promised discovery **after** Dr. Kearns would so limit his case. The proper order was

reversed here by the District Court.

Respectfully submitted,

/s/ Robert W. Kearns

Robert W. Kearns, Pro Se

(410) 827-9337 (Tel/Fax)

CERTIFICATE OF SERVICE

THIS IS TO CERTIFY that a copy of PETITION FOR REHEARING UNDER RULE 40 with associated APPENDIX was mailed to Clerk CAFC and Allegretti & Witcoff, LTD., Attn: D. Dennis Allegretti, 75 State Street, 23rd floor, Boston, Massachusetts 02109 this 29th day of July, 1994.

/s/ Bob Kearns

Bob Kearns

EXHIBIT B

United States Court of Appeals for the Federal Circuit

ORDER

Before LOURIE, Circuit Judge, RADER, Circuit Judge, and SCHALL, Circuit Judge.

A petition for rehearing having been filed by the APPELLANT,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate will issue August 31, 1994.

FOR THE COURT,

FRANCIS X. GINDHART,

CLERK

Dated:

August 24, 1994 by/s/ Diane M. Frye

Diane M. Frye

Chief Deputy Clerk

EX. C

cc: ROBERT W. KEARNS

D. DENNIS ALLEGRETTI

FILED
U.S. COURT OF
APPEALS FOR
THE FEDERAL
CIRCUIT
AUG. 24, 1994
FRANCIS X.
GINDHART
CLERK

KEARNS V. GENERAL MOTORS,
93-1535
(DCT - 85-70461)

****
* Note: Pursuant to Fed. Cir. R. *
* 47.6, this order is not citable *
* precedent. It is a public record*
****

United States Court of Appeals for the

Federal Circuit

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant,

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

Robert W. Kearns, of Queenstown, Maryland, argued Pro Se.

Robert P. Taylor, Pillsbury, Madison & Sutro, of Washington D.C., argued for defendant/appellant. With him on the brief was Lawrence F. Scinto, Fitzpatrick, Cella, Harper & Scinto, of New York, New York. Of counsel were Deanne C. Siemer and Michael A. Conley.

William D. Durkee, Arnold, White & Durkee, of Houston, Texas, was on the

EX. D

brief for Amicus Curiae, Arnold, White & Durkee. Of counsel were William B. Allison and James G. Munisteri, Sewell & Riggs, of Houston, Texas.

Richard L. Aitken and Andrew C. Aitken, Lane, Aitken & McCann, of Washington, D.C., were on the brief for Amicus Curiae, Houston Inventors Association.

Appealed from: U.S. District Court for the Eastern District of Michigan

Judge Cohn

United States Court of Appeals for the
Federal Circuit

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant,

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

DECIDED: August 11, 1994

Before LOURIE, RADER, and SCHALL,
Circuit Judges.

LOURIE, Circuit Judge.

Chrysler Corporation and Robert W. Kearns appeal and cross-appeal, respectively, from the final judgment of the United States District Court for the

Eastern District of Michigan awarding Kearns $18,740,465.43. The judgment was entered on jury verdicts that three patents owned by Kearns were infringed by Chrysler. Kearns v. Chrysler Corp., Civil No. 82-70748 (E.D. Mich. Oct. 30, 1992). The court denied Chrysler's motion for judgment as a matter of law or in the alternative for a new trial. Kearns v. Chrysler Corp., Civil No. 82-70748 (E.D. Mich. June 3, 1993). We affirm the judgment in all respects.

BACKGROUND

In 1982, Kearns filed an action against Chrysler alleging infringement of U.S. Patents 3,351,836, 3,564,374, 3,602,790, and 3,581,178, all relating to electronic intermittent windshield wipers (IWWs) for use in automotive vehicles. At the time the suit was filed, Kearns had three similar suits pending against

other automobile manufacturers and distributors involving the same patents, Kearns v. Ford Motor Co., Civil Action No. 78-70740 (E.D. Mich.); Kearns v. Wood Motors, Inc., Civil Action No. 78-70642 (E.D. Mich.); SWF-Spezialfabrik fur Autozubehor Gustav Rav GmbH v. Kearns, Civil Action No. 79-74451 (E.D. Mich.).[1]

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[1]Kearns subsequently filed other infringement actions involving patents relating to IWWs, e.g., Kearns v. General Motors Corp., Civil Action No. 85-70461 (E.D. Mich.), aff'd, No. 93-1535 (Fed. Cir. July 25, 1994); Kearns v. Toyota, Civil Action No. 85-70459 (E.D. Mich.); Kearns v. Ferrari SpA., Civil Action No. 85-70459 (E.D. Mich.); Kearns v. American Motors Corp., Civil Action No. 85-70460 (E.D. Mich.) (consolidated with the in-

On October 22, 1982, proceedings in the Chrysler action were stayed pending resolution of the earlier filed suits. The stay was instituted pursuant to Chrysler's stipulation that it would be "bound by the judgment as to the validity of . . . U.S. patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790" in either Ford, Wood Motors, or SWF, whichever was the last to be adjudicated. The stipulation expressly provided, however, that Chrysler would "not be bound by any consent judgment."

In 1989, shortly before the Ford case went to trial, Chrysler renewed its stipulation regarding the issues of invalidity and unenforceability. Subject to continuation of the court-ordered stay,

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stant case by order of the district court on February 3, 1990).

Chrysler agreed to be "bound by the judgment (excluding a consent judgment) in the Kearns v. Ford case, C.A. 78-70740 as to the validity and enforceability of the patents involved in that action that are also involved in this action. Those patents included United States Patent Nos. 3,351,836, 3,564,374, 3,581,178, and 3,602,790." That stipulation was subsequently entered by the court on February 15, 1990.

1. The Ford Litigation

The liability phase of the Ford case commenced on January 3, 1990. On January 29, 1990, the jury returned a unanimous verdict for Kearns, finding that Ford had not proved by clear and convincing evidence that claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790 patent, and claim 6 of the '178 patent were invalid or unenforceable. On

March 9, 1990, the district court entered partial judgment that the specified claims were valid, enforceable, and infringed by Ford. That partial judgment was eventually "made final" upon entry of the court's final judgment on November 14, 1990.

The damage phase of Ford was tried before the same jury in April 1990. The jury, however, was unable to reach a unanimous verdict and a second trial on damages was held in July 1990. The second jury ultimately returned a unanimous verdict in favor of Kearns, awarding $5,163,842 for the period from April 3, 1978 through 1988. On July 13, 1990, partial judgment was entered on the damage award assessed by the second jury. Although damages for the period from 1972 to April 3, 1978 remained in dispute, Ford and Kearns eventually reached a

settlement as to the total amount of liability. Consequently, the partial judgment on damages was vacated and Ford withdrew its pending post-verdict motions for judgment notwithstanding the verdict or in the alternative for a new trial and waived its appellate rights.

2. The Chrysler Litigation

The Chrysler case returned to active status in early 1991. On February 20, 1991, the district court issued a pretrial order stating that the issues to be adjudicated at trial concerned "infringement, damages, and willfulness." On May 3, 1991, Chrysler filed a motion to have the pretrial order modified to add patent validity as an issue for trial. In support of its motion, Chrysler argued that the pretrial stipulations of October 15, 1982 and February 15, 1990 did not bar Chrysler from challenging the patents in

suit. Chrysler claimed that because the final judgment in Ford was entered pursuant to a settlement agreement between Ford and Kearns, it was a "consent judgment" within the meaning of the stipulations.

The district court denied the motion and limited trial to the issues stated in the pretrial order. In reflecting Chrysler's argument, the district court noted that although a settlement had been reached in Ford on the issue of damages, the issue of validity was "hotly" contested by the parties at trial, resulting in a unanimous jury verdict and a final judgment in favor of Kearns. Moreover, the court found that the stipulations did not obligate Ford to pursue post-trial motions and exhaust all rights or appeal in order for the judgment in Ford to be binding on the parties in Chrysler.

By order of the court, the Chrysler action was bifurcated into separate jury trials on the issues of liability and damages. On December 10, 1991, the jury returned verdicts that Chrysler's accused IWW circuits, designated the "1977 Circuit" and the "1980 Circuit," infringed claim 12 of the '836 patent, claim 6 of the '374 patent, and claim 14 of the '790 patent.[2] On June 11, 1992, the same jury

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[2]The jury also found that Chrysler infringed claim 7 of the '178 patent. Due to an inconsistency between the jury's general verdict of infringement and its answer to a special question, the district court set aside the jury's finding and entered judgment on noninfringement pursuant to Fed. R. Civ. P. 49(b). The court's judgment respecting claim 7 is not at issued in this appeal.

returned a verdict that Chrysler's infringement was not willful and assessed a reasonable royalty of $.90 per unit for a total of 12,564,107 infringing units.[3] Pursuant to the jury's verdicts, the district court entered final judgment in favor of Kearns in the amount of $18,740,465.43, including prejudgment interest and costs.[4]

Chrysler subsequently filed a motion for judgment as a matter of law (JMOL),

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[3]The Court subsequently revised the number of infringing units downward to 12,563,107 units.

[4]Specifically, the judgment consisted of $11,306,696.30 for infringement damages, $8,075,193 for prejudgment interest, and $25,898.75 for costs, less $667,322.62 in costs, expenses, and attorneys' fees awarded to Chrysler.

asserting that the jury's findings of infringement were not supported by substantial evidence. Alternatively, Chrysler moved for a new trial, claiming that the district court improperly excluded evidence and misinstructed the jury on critical legal issues. The district court denied Chrysler's post-verdict motions. The court considered the expert testimony adduced at trial together with the documentary evidence of record to be a sufficient basis upon which the jury could have supported its findings of infringement. Further, the court determined that the exclusion of evidence was not prejudicial to Chrysler's substantive rights and that the jury was correctly instructed on the interpretation of the claims and their application to the accused circuits.

DISCUSSION

Chrysler now appeals, asserting that the district court's judgment should be reversed as a matter of law because the underlying jury verdicts of infringement were not supported by substantial evidence, or in the alternative, that a new trial is warranted in view of the prejudicial error committed by the district court in barring Chrysler from introducing prior art evidence necessary to properly construe the claims at issue and to challenge their validity and enforceability. Kearns cross-appeals certain rulings of the court that allegedly deprived him of the total compensation to which he claims he is entitled.

New Trial

We first address the district court's denial of Chrysler's motion for a new

trial. "The denial of a motion for new trial can be reversed only if the district court abused its discretion." Arachnid, Inc. v. Medalistic Marketing Corp., 972 F.2d 1300, 1301, 23 USPQ2d 1946, 1948 (Fed. Cir. 1992) (citation omitted); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1367, 21 USPQ2d 1321, 1326 (Fed. Cir. 1991), cert. denied, 113 S. Ct. 60 (1992). An abuse of discretion may be established by showing that the district court either made an error of law, a clear error of judgment, or made findings which were clearly erroneous. See Mendenhall v. Cedarapids, Inc., 5 F.3d 1557, 1569, 28 USPQ2d 1081, 1091 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 1540 (1994).

1. Invalidity and Unenforceability

In support of its contention that a new trial is required, Chrysler claims that the district court erred as a matter of law in excluding evidence allegedly showing that the patents in suit are invalid and unenforceable. Chrysler claims that the district court's decision to exclude such evidence was based on an erroneous interpretation of the pretrial stipulation of February 15, 1990,[5] in which Chrysler agreed to be bound by the

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[5]The district court did not rely on the first stipulation of October 15, 1982 in making its disputed evidentiary rulings. The court considered that stipulation to be functus officio in view of the February 15, 1990 stipulation. We will therefore limit our discussion to the latter stipulation.

judgment rendered in the Ford case on the issues of invalidity and unenforceability. It is Chrysler's position that the Ford judgment was in fact a consent judgment, which, under the terms of the stipulation, was not binding on Chrysler.

The proper interpretation of the parties' pretrial stipulation, like any contract, presents a legal question that we address de novo. See Intel Corp. v. ULSI Sys. Technology, Inc., 995 F.2d 1566, 1569, 27 USPQ2d 1136, 1138 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 923 (1994). As always, our inquiry begins with the language of the agreement memorializing the intent of the parties.

The controlling language of the agreement between Chrysler and Kearns provides that Chrysler "shall be bound by the [Ford] judgment (excluding a consent

judgment) . . . as to the validity and enforceability" of the patents in suit. [Emphasis added.] Chrysler asserts that the existence of the "consent judgment" exception in the stipulation indicates that it only intended to be bound by a judgment respecting invalidity and unenforceability where those issues were "fully litigated" by Ford, i.e., only after Ford vigorously defended its position at trial and exhausted all available post-trial remedies. Chrysler insists that the final judgment entered in Ford was a "consent judgment" because the parties in that case reached a settlement on the issue of damages that effectively mooted Ford's post-trial motions and forced Ford to forfeit its appellate rights.

We reject Chrysler's attempts to avoid the consequences of its stipulation by

redefining its terms. The fact that Ford was precluded from proceeding with its post-trial motions or seeking appellate review because of its damage settlement does not render the court's judgment a "consent judgment." In our effort to give effect to the original intent of the parties, we adhere to the well-settled rule that words in an agreement are interpreted in accordance with their ordinary and commonly accepted meanings. See Hol-Gar Mfg. Corp. v. United States, 351 F.2d 972, 979 (Ct. Cl. 1965). The term "consent judgment" is defined as "[a] judgment, the provisions and terms of which are settled and agreed to by the parties to the action." Black's Law Dictionary 842 (6th ed. 1990). This meaning is in contradistinction to a judgment that is rendered by a court without agreement of the parties. The

commonly accepted meaning of the term "consent judgment" prevails here because the stipulation is devoid of any indication that the parties intended a different meaning.

Although it is undisputed that Ford settled the amount of compensation due Kearns, no such settlement or agreement was reached between the parties in Ford respecting the issues of validity, enforceability, and infringement of the asserted patent claims. Indeed, as the trial court noted, those issues were "hotly," "vigorously," and "fully" contested by the parties during a lengthy jury trial.[6] Pursuant to unanimous ver-

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[6]The judge who presided over the Ford litigation also presided over the Chrysler litigation. In rejecting Chrysler's initial attempts to avoid its stip-

dicts returned by the jury, the court entered partial (and later final) judgment holding claim 16 of the '836 patent, claim 6 of the '374 patent, claim 14 of the '790 patent, and claim 3 of the '936 patent valid, enforceable, and infringed. Because neither party in Ford "settled and agreed" on the issues of validity and enforceability, the district court's

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ulation, Judge Cohn stated, "I know that I entered a Partial Judgment of Validity, after a hotly contested trial. To my way of thinking . . . there was no Consent Judgment on Validity. Validity was contested. Kearns won, Ford lost and it chose not to appeal, and it withdrew its Motions JNOV or New Trial. That doesn't obviate the fact that it was judgment contested arising in a contested environment."

judgment respecting those issues was not a "consent judgment" within the meaning of the stipulation. Chrysler is thus bound by that judgment. See Restatement (Second) of Judgments § 40 (1982) ("A person who agrees to be bound by the determination of issues in an action between others is bound in accordance with the terms of his agreement.").

In a further attempt to avoid the consequences of its stipulation, Chrysler urges that "public policy" favors allowing it to challenge the patents' validity and enforceability. Even were we to agree with this proposition, we do not see how it aids Chrysler here. Chrysler was certainly entitled to raise the defenses of invalidity and/or unenforceability when it was accused of infringement, but it chose instead to rely on the judgment rendered in Ford on those issues.

Public policy will not rescue Chrysler from a decision which it later finds to be imprudently made. On the contrary, public policy favors preventing Chrysler from reneging on an agreement into which it freely entered and upon which Kearns and the district court relied. See Interspiro USA Inc. v. Figgie Int'l Inc., 18 F.3d 927, 930, 30 USPQ2d 1070, 1072 (Fed. Cir. 1994); Bank of America Nat'l Trust and Savings Assoc. v. United States, No. 93-5059, slip op. at 4-5 (Fed. Cir. April 29, 1994).

Accordingly, we agree with the district court that Chrysler was barred under the stipulation from introducing prior art evidence directed toward challenging the validity and enforceability of the asserted patents in this case.

2. Interpretation of Claims

Next, Chrysler contends that the district court committed reversible error by excluding prior art evidence allegedly essential to the proper construction of the claims at issue. As a result of that error, Chrysler asserts that a new trial is warranted because the jury's infringement analysis was predicated on distorted claim interpretations.

"The decision to admit or exclude evidence is within the sound discretion of the trial court and will be reversed on appeal only for a clear abuse of that discretion." Smith & Lee Assocs., Inc. v. City of Taylor, Mich., 13 F.3d 920, 928 (6th Cir. 1993). In order to show that the district court abused its discretion in excluding the prior art evidence, Chrysler must demonstrate that the exclusion prejudiced its substantive rights. See DMI, Inc. v. Deere & Co.,

802 F.2d 421, 428, 231 USPQ 276, 280-81 (Fed. Cir. 1986). Here, Chrysler has failed to make that showing.

It is well-settled that reference may be had to prior art when it will assist a court in determining how a disputed claim is understood by those skilled in the art. See Palumbo v. Don-Joy Co., 762 F.2d 969, 975, 226 USPQ 5, 8 (Fed. Cir. 1985); Tandon Corp. v. International Trade Comm'n, 831 F.2d 1017, 1021, 4 USPQ2d 1283, 1286 (Fed. Cir. 1987). However, when claim language is clear and unambiguous on its face, resort to prior art may be unnecessary.

Whether a claim has been infringed requires first interpreting the claim and then comparing the properly construed claim to the accused device. See Read Corp. v. Portec, Inc., 970 F.2d 816, 821, 23 USPQ2d 1426, 1431 (Fed. Cir. 1992).

When, as here, prior art is not required to resolve the underlying legal question concerning what a claim means, it necessarily has little relevance to the ultimate factual question of infringement. Such evidence is by definition "irrelevant" and need not be admitted by a trial court. See Fed. R. Evid. 401, 402.

At trial, Chrysler attempted to introduce prior art patents ostensibly for the purpose of aiding in the interpretation of the claims at issue. Specifically, Chrysler intended to show that under Kearns' interpretations of the claims, the claims were impermissibly broad because they read upon or were obvious over the prior art. The district court, however, concluded that the claims could be construed according to their plain meaning and that reference to prior art was

not required.[7] Moreover, and highly significant here, the district court believed that Chrysler's attempts to offer such evidence constituted a disguised, "back door" attack on the validity of the patents, which was expressly proscribed by the binding stipulation.

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[7]The claims at issue contain limitations expressed in "means-plus-function" format. 35 U.S.C. § 112 ¶ 6 (1988). The court's ruling is consistent with the rule that "[i]t is not necessary to consider the prior art in applying section 112, paragraph 6. Even if the prior art discloses the same or an equivalent structure, the claim will not be limited in scope thereby." Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 842, 20 USPQ2d 1161, 1179 (Fed. Cir. 1991).

The district court's reasoning adequately supports its refusal to admit the proffered evidence. "[That] we might have reached a different result or might have affirmed had the district court gone the other way are insufficient bases for reversal under the abuse of discretion standard which applies to our review of this part of the court's judgment." RCA Corp. v. Data General Corp., 887 F. 2d 1056, 1065, 12 USPQ2d 1449, 1457 (Fed. Cir. 1989). Moreover, even if the court committed error in not admitting any particular prior art evidence, we have not been persuaded that the claims were erroneously construed and that Chrysler was thereby prejudiced. The district court's denial of Chrysler's motion for a new trial is therefore affirmed.

Judgment as a Matter of Law

We now consider Chrysler's argument that the district court erred in denying its motion for judgment as a matter of law on the issue of infringement. Chrysler contends that no substantial evidence supports the jury's findings that Chrysler literally infringed claim 14 of the '790 patent, claim 16 of the '836 patent, and claim 6 of the '374 patent.

"We reverse a denial of a motion for JMOL only if the jury's factual findings, presumed or express, are not supported by substantial evidence or, if they are, that the legal conclusions implied from the jury's verdict cannot in law be supported by those findings." Arachnid, Inc. v. Medalistic Marketing Corp., 972 F.2d at 1301, 23 USPQ2d at 1948 (citation omitted). The "substantial evidence" standard "requires us to decide for ourselves whether reasonable jurors viewing

the evidence as a whole could have found the facts needed to support the verdict in light of the applicable law. If we conclude that no reasonable findings of fact, supported by substantial evidence, could support the verdict that was incorporated into the trial court's judgment, then we must conclude that the trial court erred in not granting the motion for [JMOL]." Lemelson v. General Mills, Inc., 968 F.2d 1202, 1207, 23 USPQ2d 1284, 1288 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 976 (1993). Moreover, we review the evidence in the light most favorable to Kearns, the nonmoving party, drawing all reasonable inferences in his favor. See Amsted Indus. Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 181, 30 USPQ2d 1462, 1464 (Fed. Cir. 1994).

Chrysler devotes the bulk of its appeal to challenging the jury's findings

that the accused circuits performed the functions required by each of the asserted means-plus-function clauses by means of structure taught in the specification or an equivalent of those structures. In doing so, Chrysler pays mere lip service to the substantial evidence standard by ignoring the evidence upon which the jury reasonably relied in reaching its verdicts and by rearguing the merits of the infringement issues. An appeal, however, is not to be used as a means of retrying a case. See DMI, 802 F.2d at 4266, 231 USPQ at 279. Under the substantial evidence standard, the appellate court's function is exhausted once a sufficient evidentiary basis is deemed to exist to support the jury's findings. See Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1235, 9 USPQ2d 1913, 1919 (Fed. Cir.), cert. denied, 493 F.2d 853 (1989).

Trial on the issue of infringement lasted approximately four weeks, during which expert testimony was introduced by both parties. Specifically, as the district court stated, "the expert testimony first construed each of the asserted claims and then went on to describe how the Chrysler system responded to each of the elements of each of the claims. . . . It is this expert testimony together with admissions in Chrysler's documents describing the gestation of the Chrysler system which constituted, for the most part, the substantial evidence supporting the jury's verdict of infringement." After receiving instructions on the law governing infringement of means-plus-function claims,[8] the jury returned ver-

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[8]"In order to meet a means-plus-function limitation, an accused device must

dicts that the asserted claims were literally infringed by Chrysler's accused IWW circuits. Each of the jury's verdicts of infringement was supported by a number of detailed special interrogatories (referred to at trial as "special questions") that addressed specific issues that had been the focus of expert testimony at trial.[9]

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(1) perform the identical function recited in the means limitation and (2) perform that function using the structure disclosed in the specification or an equivalent structure." Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1578, 27 USPQ2d 1836, 1840 (Fed. Cir. 1994).

[9]The jury decided some 39 special questions concerning the issue of infringement. Five special questions were

We have recognized that "[t]he use of special interrogatories . . . facilitates appellate review . . . for such use frees the court from having to survey every possible basis for the jury's decision." American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1361, 220 USPQ 763, 773 (Fed. Cir.), cert. denied, 469 U.S. 821 (1984). The district court, in denying Chrysler's post-trial motions, analyzed all of the special interrogatories answered by the jury and cited evidence presented to the jury pertinent to each interrogatory, including expert witness testimony. Thus, it is clear

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directed to infringement of claim 5 of '790 patent, 17 special questions to claim 16 of the '836 patent, and five special questions to claim 6 of the '374 patent.

that the jury verdicts were supported by substantial evidence. The detailed nature of the special interrogatories, as well as the extensive analysis by the trial judge in considering Chrysler's post-trial motions, are impressive indeed, giving great credibility to the decisions reached.

We conclude that Chrysler has failed to show that on the entirety of the record reasonable persons could not have found the facts necessary to support the jury's verdicts of infringement. Because substantial evidence supports the jury's verdicts and because the legal conclusions implied from those verdicts are consistent with the jury's findings, the district court's denial of Chrysler's motion for judgment as a matter of law is affirmed.

Cross-Appeal

Kearns now cross-appeals a number of rulings issued by the district court that Kearns claims precluded him from obtaining all the relief and compensation to which he was entitled under the law. At issue are the district court's orders (1) granting Chrysler's motion for summary judgment on Kearns' right to seek injunctive relief, (2) granting Chrysler's motion for summary judgment on Kearns' right to recover lost profits as damages, (3) denying Kearns' motion to disqualify Chrysler's counsel for conflict of interest, (4) precluding Kearns from challenging the number of infringing units without filing supporting documentary evidence, (5) denying Kearns' motion to offer separate evidence of willful infringement by American Motors, (6) granting Chrysler's motion for a directed verdict on the issue of willfulness, (7)

assessing prejudgment interest for the period from March 2, 1982 to June 11, 1992 at simple interest rather than 2% above the prime rate, and (8) awarding Chrysler $677,332.62 for attorneys' fees and expenses. We will address each of these rulings in turn to the extent necessary.

1. Post-expiration Injunctive Relief

Shortly before trial, Kearns expanded his claim for relief to include injunctive relief. Kearns believed that Chrysler's infringement deprived him of the "full value" of his patents during their respective terms by effectively extinguishing his exclusive right to sell his patented IWW systems to automobile manufacturers. Kearns urged that Chrysler should be enjoined from manufacturing infringing IWW systems for a period of sufficient duration "to put him in [a]

position where the harm [caused by] past infringement during the terms of the patents in suit is rectified." The district court refused to grant such relief because the patents had already expired.[10] The court concluded that "there is nothing in statute or common law giving [Kearns] the right to an injunction against practicing the disclosures in an expired patent."

In arguing that the district court erred in denying him post-expiration relief, Kearns claims that the $11 million damage award is not adequate to compensate him for the loss he sustained as a result of Chrysler's infringement. Kearns contends that Chrysler's infringe-

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[10]The '836 patent expired in 1984 and the '790 and '374 patents both expired in 1988.

ment stripped him of "exclusive time" over his patents in violation of his rights under the U.S. Constitution and the patent laws, and that he is entitled to have that time restored to him. That contention, however, finds no basis in the statutory scheme governing patent infringement remedies.

Under the laws enacted by Congress, a patent grants the patent owner the right to exclude others from making, using, or selling the claimed invention in the United States for the term of seventeen years. 35 U.S.C. § 154 (1988). When that exclusive right is infringed, the patent owner is authorized to obtain compensation in the form of damages, measured, e.g., by lost profits or a reasonable royalty. 35 U.S.C. §§ 281, 284 (1988). Moreover, the statute expressly provides for the grant of injunc-

tions "in accordance with the principles of equity." 35 U.S.C. § 283 (1988). In view of the fact that the principal right afforded by a patent is the "right to exclude," we have noted that "[t]he nature of the patent grant . . . weighs against holding that monetary damages will always suffice to make the patentee whole." H.H. Robertson Co. v. United Steel Deck, Inc., 820 F.2d 384, 387-88, 2 USPQ2d 1926, 1930 (Fed. Cir. 1987). Indeed, "[w]hile monetary relief is often the sole remedy for past infringement, it does not follow that a monetary award is also the sole remedy against future infringement." Atlas Powder Co. v. Ireco Chemicals, 773 F.2d 1230, 1233, 227 USPQ 289, 292 (Fed. Cir. 1985) (emphasis added). However, § 283 relief is available only to "prevent the violations of any right secured by patent." Thus, when the

rights secured by a patent are no longer protectable by virtue of expiration or unenforceability, entitlement to injunctive relief becomes moot because such relief is no longer available. See Illinois Tool Works, Inc. v. Grip-Pak, Inc., 906 F.2d 679, 681, 15 USPQ2d 1307, 1308 (Fed. Cir. 1990).

An invention claimed in a patent passes into the public domain upon termination of the patent's 17-year statutory term. Because the rights flowing from a patent exist only for the term of the patent, there can be no infringement once the patent expires. Here, all the asserted patents expired before the commencement of trial. Therefore, Kearns "can no longer obtain injunctive relief with respect to [those patents]." See Kinzenbaw v. Deere & Co., 741 F.2d 383, 386, 222 USPQ 929, 931 (Fed. Cir. 1984),

cert. denied, 470 U.S. 1004 (1985); see also Standard Oil Co. v. Nippon Shokubai Kagaku Kogyo, Ltd., 754 F.2d 345, 347, 224 USPQ 863, 865 (Fed. Cir. 1985). Granting the relief requested by Kearns would impermissibly extend the statutory term beyond that established by Congress. Congress has the power to provide for patent term extension in appropriate circumstances, see 35 U.S.C. §§ 155, 156 (1988), but it has not done so here and we cannot legislate in its place. See Denkler v. United States, 782 F.2d 1003, 1008 (Fed. Cir. 1986) ("Should Congress wish to extend the [statute's scope], it knows how to do so."). The expiration of Kearns' patents precludes the grant of injunctive relief and the judgment for $11 million in damages thus amounts to adequate and full compensation under the

law for Chrysler's past violation of his patent rights.

Kearns argues that our decision in Roche Prods., Inc. v. Bolar Pharmaceutical Co., Inc., 733 F.2d 858, 221 USPQ 937 (Fed. Cir.), cert. denied, 469 U.S. 856 (1984), suggests that the availability of post-expiration equitable relief is simply a matter within the discretion of the trial court. In Roche, the trial court denied the patent owner's request for a permanent injunction because it found there was no infringement. Although the trial court's finding on noninfringement was reversed on appeal, the request for injunctive relief became "no longer . . . necessary" because the patent had expired. Despite the patent's expiration, the case was remanded to the lower court with directions to fashion an appropriate equitable remedy to redress the harm to

the patent owner caused by past acts of infringement. Id. at 865, 221 USPQ at 942. Kearns argues that the district court should consider taking action similar to that contemplated in Roche. Kearns, however, is not in a position to benefit from such relief.

The post-expiration relief discussed in Roche was intended to return the parties to the status quo before infringement (e.g., destruction of data obtained as a result of the infringement) and was not intended to prohibit future use of the invention. Importantly, the relief was also considered in the context of harm to a patent owner that had been selling the patented product. Thus, deferral of competition by an infringer who had entered the market prematurely, i.e., before the patent expired, was considered as a means of equitably com-

pensating the patent owner. In contrast, because Chrysler has been manufacturing and selling its infringing IWWs for many years and Kearns has not (see infra), there is no basis for granting relief similar to that contemplated by the court in Roche.

We sympathize with Kearns' complaint that his patents have expired without his ever being able to exclude others from practice of his invention, especially since he is an individual inventor contending with a multitude of giant corporations.[11] While it is of course the essence of a patent that it provides the right to exclude, the same statute that

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[11]The fact that Kearns has fired several of his attorneys and attempted to conduct massive multiple suits pro se may be relevant to his dilemma.

grants that right also permits other parties, including accused infringers, to challenge the validity of a patent and to contest a charge of infringement. See 35 U.S.C. § 282 (1988). Moreover, entitlement to an injunction implementing the right to exclude, as compared with only assessing damages against an infringer, is not absolute even during the life of a patent, but is discretionary. See 35 U.S.C. § 283 ("courts having jurisdiction of cases under this title may grant injunctions" (emphasis added)); see also City of Milwaukee v. Activated Sludge, Inc., 69 F.2d 577, 593, 21 USPQ2d 69, 85-86 (7th Cir. 1937); Vitamin Technologists, Inc. v. Wisconsin Alumni Research Found., Inc., 146 F.2d 941, 944-45, 63 USPQ 262, 267 (9th Cir. 1944). Here, because Kearns' patents have expired, the district court certainly did

not abuse its discretion in denying injunctive relief.

It is unfortunate that Kearns feels that he never enjoyed an exclusive status under his patents, but that is simply a consequence of the right of others to challenge his patents and the fact that his patents have expired. The patent statute does provide for increased damages and attorney fees as additional relief for aggrieved patent owners, see 35 U.S.C. §§ 284, 285 (1988), but Kearns did not persuade the district court that he was entitled to such relief.

We therefore conclude that the district court properly granted summary judgment in favor of Chrysler on Kearns' request for post-expiration injunctive relief.

2. Lost Profits

Kearns argues that the district court erred in granting Chrysler's motion for summary judgment on Kearns' claim for damages based on lost profits, rather than a reasonable royalty. A patent owner bears the burden of proof on damages. Fromson v. Western Litho Plate and Supply Co., 853 F.2d 1568, 1574, 7 USPQ 1606, 1612 (Fed.Cir. 1988). Kearns has not carried that burden with respect to lost profits.

A lost profits award is appropriate only if the patent owner can prove there was a reasonable probability that "but for" the infringement, it would have made the infringer's sales. Water Technologies Corp. v. Calco, Ltd., 850 F.2d 660, 671, 7 USPQ2d 1097, 1106 (Fed.Cir.), cert. denied, 488 U.S. 968 (1988). One way to establish "but for" causation is to meet the four-part test pronounced in

Panduit Corp. v. Stahlin Bros. Fiber Works, 575 F.2d 1152, 1156, 197 USPQ 726, 729-30 (6th Cir. 1978). See Standard Havens Prods., 953 F.2d at 1372-73, 21 USPQ2d at 1331. To recover under that test, the patent owner must prove (1) a demand for the patented product, (2) an absence of acceptable noninfringing substitutes, (3) manufacturing and marketing capability to exploit the demand, and (4) the amount of profit the patent owner would have made. Id. (emphasis added).

In ruling against Kearns, the district court concluded that Kearns failed to prove the Panduit requirements for lost profits, particularly with regard to whether he possessed the capability to manufacture and market IWWs. The court determined that "[a]t best plaintiff's offer of proof demonstrates plans for manufacture that were tentative, specula-

tive and contingent. Plaintiff does not suggest he ever made any sales of intermittent windshield wipers or had the manufacturing capability in hand to do so." Kearns disputes the court's finding, stating that his company "Kearns Engineers" had the capacity to manufacture, market, and sell IWWs since the 1960's and that Chrysler's infringement prevented him from selling his IWWs to Chrysler. That contention, however, is not supported by the record.[12] Where, as here, a patent owner fails to prove lost profits, the court is left with no alter-

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[12]We note that the appendices filed by Kearns on appeal contain documents not considered by the district court. We, of course, must limit our review to the record produced at trial. DMI, 802 F.2d at 426, 231 USPQ at 279.

native but to have damages determined on the basis of a reasonable royalty. See Water Technologies, 850 F.2d at 673-74, 7 USPQ2d at 1108.

Accordingly, we affirm the district court's grant of summary judgment in favor of Chrysler on the issue of lost profits.

3. Other Rulings

We have carefully reviewed the district court's other rulings respecting willful infringement, disqualification of counsel, prejudgment interest, and attorneys' fees and costs. The rulings are adequately supported by the record and are consistent with governing law. We need not address Kearns' contentions in detail. For purposes of our decision, suffice it to say that Kearns has not identified any reversible error in law or fact made by the district court in reach-

ing its decisions. Accordingly, we affirm the district court's rulings.

CONCLUSION

The district court did not err in denying Chrysler's post-verdict motions. Nor did the district court commit any reversible error in ruling on the various issues disputed by Kearns. Accordingly, the district court's judgment is affirmed in all respects.

AFFIRMED

301 Houghton Laboratory Lane
Queenstown, Maryland 21658

23 August 1994

Court of Appeals for the Federal Circuit

Attn: Francis X. Gindhart for Panel

93-1450,-1470

717 Madison Place, N.W.

Washington, D.C. 20439

Suggestion for Rehearing in Banc

Background

It was on 22 October 1963, that Cross-Appellant Robert W. Kearns, ("Dr. Kearns") troubles with the patent law began. That was 31 years ago. He sought engineering specifications from Ford Motor Company ("Ford") engineers to complete the development phase of his inventions. On that occasion he was unsuccessful. On 29 October 1963, Dr. Kearns sought the engineering specifications

EX. E

from Chrysler Corporation ("Chrysler"). Again, he was unsuccessful. On 29 June 1964,(the same month at age 36 he was awarded his doctorate in engineering) Dr. Kearns experimentally learned himself how to stop the transistors from leaking at an ambient temperature of 270 degrees fahrenheit to allow a dwell of the wiper motor. He then started his life test. On 16 November 1964, Dr. Kearns' life test completed 3,400,000 cycles of operation without failure (400,000 more cycles than the standard for a wiper motor alone). He filed an application for his patent "Windshield Wiper System with Intermittent Operation" on 1 December 1964.

On 14 November 1990, Judge Cohn told Dr. Kearns, "Well, you won one today!" Won? How can an inventor "win" the trial and "lose" his Constitutional standard of

compensation - 'time'? The litigation consumed 13 years of 'time'. Earlier, after 12 years of litigation Judge Cohn remarked from the bench, "I had all I could do not to drive my car into a ditch" when Ford abandoned its 21-year defense against infringement in the Pre-trial Order and challenged only the validity of Dr. Kearns' patents on the 20,500,000 electronic IWWSs it had sold to that date.

When the Court "entertains" an unsuccessful challenge to the validity of a patent, can it be allowed to simply walk away free having consumed the inventor's Constitutional 'exclusive time'? Should a sailor run aground using (outside the U.S.) a nautical chart purchased from Defense Mapping here in Washington, D.C. due to the map's error, the U.S. Government stands ready to make a 'remedy'.

'Remedy' for a sailor - no 'remedy' for an inventor?

For the reasons discussed herein, Dr. Kearns believes he is entitled to a complete 'remedy'. During those same 31 years of Dr. Kearns' patent law 'troubles' the standard-of-living of the average U.S. citizen has gone from 3rd in the world to 10th! It is in the public's interest for this Court to provide such a 'remedy'.

Should a ten dollar bill circulate among Mary, Helen and Jane within a family -- that is economic activity. But how does that economic activity help their Uncle Sam pay the rent? It doesn't. It is necessary for one of them to go outside the family boundaries earn and bring money in to pay the rent. We, U.S. citizens, are such a family within our borders. It is necessary for some of us to

go outside our borders, earn and make 'foreign' sales of our products to pay for the Saudi oil, Japanese electronics, etc. to maintain our standard-of-living.

Ford controls Ford-the-windshield-wiper market. Chrysler controls Chrysler-the-windshield-wiper market. Ford and Chrysler denied Dr. Kearns an entering wedge into their market and satisfied their needs through infringement. Dr. Kearns was the only outside supplier to quote his patented products to them. All the automobile assemblers remaining in the western world (except Fiat who does no business in the U.S.) controlled their respective markets, denied Dr. Kearns entry as a supplier, and supply their own markets through 'alleged (for now)' infringement. [A-132] They are all in litigation against Dr. Kearns in Judge Cohn's Court. Without a market to serve,

Dr. Kearns could not make a sale. Without Dr. Kearns making a sale for profit, the infringers gained again when Judge Cohn limited damages to a reasonable royalty. All control their market, all satisfy their needs through infringment, all save on the damages, and, all make the 'foreign - to them' U.S. sales economic activity and profits through infringement for the benefit of their families and to the detriment of the U.S. family standard-of-living while Dr. Kearns lost: the economies-of-scale of the U.S. market; and, use of his foreign patent base.

Dr. Kearns holds 21 U.S. patents in windshield wiper systems. The foreign sales of Dr. Kearns' *incremental* intermittent windshield wiper systems make a difference of 1.2 percent of the entire U.S. trade deficit (nominally $10 billion

per month). Those U.S. patents of Dr. Kearns apply to the system - controlling the motors, switches, connectors, cabling, etc. The foreign sales of those *whole* wiper systems increase the difference to 4.8 percent! When Ford-the-market and Chrysler-the-market ignored Dr. Kearns' quotations to them in favor of Ford-the-infringer and Chrysler-the-infringer, did they invest in additional plants and sales facilities to sell separately *whole* windshield wiper systems to foreign 'families'. No! They lacked the patent base upon which to secure such an investment. But Dr. Kearns had the U.S. and foreign patent base.

'Remedy' for a sailor - no 'remedy' for an inventor?

Know SWF-Spezialfabrik fur Autozebehor Gustav Rau, G.m.b.H. ("SWF") a corporation of the Federal Republic of Germany

supplies Mercedes and Porsche the *et al.* in the *Kearns* v. *Wood Motors et al.* infringement case. SWF's first complaint was filed against Dr. Kearns in 1978. Dr. Kearns' infringement case against Wood Motors was filed in March 1978. Subtract March '78 from '94. Dr. Kearns is in his 17th year of patent litigation AND BOTH CASES HAVE YET TO COME TO TRIAL! When Dr. Kearns "wins" these infringement cases, as he has against Ford and Chrysler will the U.S. family have 'lost' again -- the benefits of Dr. Kearns' inventions while he waited for trial? By the merit panels ruling the family has already 'lost'. Can a District Court Judge's conduct deny to an inventor his Constitutional rights and thereby deny the U.S. family the benefits of his inventions *without* trial? The merits panels ruling says it is happening legally.

What do you - sitting in banc - say?

Perhaps you viewed CBS's Street Stories program, filmed in Dr. Kearns' office and in the District Court. The Japanese also flew a TV crew to Dr. Kearns' office during the *Kearns* v. *Chrysler Corp. and American Motors Corp* trial. Their resulting TV program was aired in seven segments throughout Japan. It was a big deal in Japan. The producer wrote in English the title of the video on the side of the complimentary copy they sent to Dr. Kearns. The title? "INTELLECTUAL PROPERTY WAR"! The 'WAR' is over jobs and trade.

From 9-19 October 1994 the Italian Government is sponsoring a "Reunion of Friendship" for their members of the resistance and the veterans of the Office of Strategic Services of WWII of which Dr. Kearns is a member. Has Dr. Kearns

lived long enough to be in another "war"? If so, this Court sitting in Banc is defending the U.S. public interest this 'time' in the front trenches.

The CAFC Opinion

#1. District Court's ruling: p. 18, line 5 "[T]here is nothing in statute ... giving [Kearns] the right to an injunction against practicing the disclosures of an expired patent."

#2. Merits panel ruling: 1. Post-expiration Injunctive Relief ... (continuing) p. 18, line 15 finds no basis in the statutory scheme governing patent infringement remedies.

In his Appendix of this *Kearns* v. *Chrysler* appeal at p. 37 ("[A-37]") Dr. Kearns submitted a copy of the U.S. Constitution with Article I, Section 8, Clause 8. emphasized. The words of section 8 show the Power to be optional. A result of a logic study of Clause 8 is

that to exercise the Power, Congress need do nothing more than establish the time period for the 'limited Times'. Currently, Congress has chosen "the term of 17 years, of the right to exclude others ..." for that time period in Title 35 [A-40]:

> **§ 154 Contents and terms of patent**
> Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof.

Notice there is no phrase "from the date of this grant" following the phrase "for the term of seventeen years" as there is in the patent grant [A-39].

Moreover, Dr. Kearns' Canada patent grant [A-38] is

> "subject to adjudication in respect thereof before any court of competent jurisdiction"

while Dr. Kearns' U.S. patent grant [A-39] is not subject to adjudication of

court. The '836 U.S. patent grant is only

> "subject to the payment of issue fees as provided by Law"[1].

Since Dr. Kearns paid his issue fees, why wasn't his '836 patent grant enforced promptly? Why is it now in danger of being lost <u>*without*</u> trial in *Wood* and *SWF*? Why are his patent grants in danger of being lost during adjudication in the District Court in violation of the right secured to him by the U.S. Constitution?

Historically, there is support for the use of the phrase "from the date of this grant" in the repealed Title 35 statute [A-131] as the section title is **§ 40. Same; contents and duration.** A duration has only an end in time. The new Congressional law, **§ 154 Contents and term of patent**[A-40] now uses exclusively

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[1] Currently:"subject to the payment of fees as provided by Law".

the word "term" which has both a beginning in time and an end in time. Since, in *Roche Products* v. *Bolar Pharmaceutical Co.*, 733 F.2d 858 (1984) there is cited with approval by the Federal Circuit:

> "There is no affirmative obligation on Congress to explain why it deems a particular enactment wise or necessary, or to demonstrate that it is aware of the consequences of its action. See *Harrison* v. *PPG Industries, Inc.*, 446 U.S. 578, 592,... (1979). Rather, because "laws are presumed to be passed with deliberation, and with full knowledge of all existing ones on the same subject," T. Sedgwick, *The Interpretation and Construction of Statutory and Constitutional Law* 106 (2d ed. 1874), we must presume Congress ..." (continue reading the following)

changed on July 19, 1952, c. 950, § 1, 66 Stat. 804 the title word 'duration' in Repealed Title 35 § 40 to the new title word 'term' of Title 35 § 154 with deliberation and with full knowledge so that the Constitutional 'limited Times' period of the Inventor's 'exclusive Right' to

her(is) 'Discoveries' does not necessarily start with the issuance of the U.S. patent grant [A-39]. Likewise, Dr. Kearns' U.S. patents found valid and admitted infringed in *Kearns* v. *Ford* and stipulated valid and found infringed in *Kearns* v. *Chrysler* do not necessarily start with their respective issue dates to be in conformance with the U.S. Constitution and the revised Title 35 law of Congress. How can the exclusive right to use, make and sell be granted when an infringer is using, making and/or selling the patent on the issue date? Obviously, the patent's term has not begun. Both Ford and Chrysler were using[2] Dr. Kearns'

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[2]See *Roche Products* v. *Bolar Pharmaceutical Co.*, 733 F.2d 858, 862R, line 16:"Hence, acts of infringement must attack the right of the patentee to these

patents on their issue dates. Moreover, once the exclusive right is properly started, how can the 'exclusive time' right be 'lost' by the patent holder when the U.S. Government interrupts the exclusive time Constitutional right.to entertain a judicial (officer-of-the-court) review time period when the patent holder "wins" the unsuccessful challenge to either validity, infringement or both? The interruption is a potential violation of a right secured by patent and upon the patent holder "winning" the judicial review the Judicial Branch is authorized to provide a remedy for that interruption to prevent the violation of any right secured by patent on such terms as the court deems reasonable under Title 35 U.S. Code § 283.

Should the validity not be challenged and/or an infringement not be occurring on the issue date the 17 year

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emoluments, and either turn them aside in to other channels or prevent them from accruing in favor of anyone."

period starting from the date of issuance may be appropriate.

To "win", yet "lose" after 31 years of patent 'troubles' is a disincentive to Dr. Kearns inventing again - yet he stands on the frontier of knowledge in the arts of his patents.

> "Of the various enumerated powers it [Art. I, § 8, cl 8] is the only one which states the purpose of the authority granted Congress." Justice Douglas, dissenting, *Special Equipment Co.* v *Coe*, 324 U.S. 370, 381.
>
> "The Congress is given no general power to issue letters patent or to reward inventors as it will. An experience with grants of monopoly in England was fresh in the minds of the Fathers; the lesson had been underlined in recent differences with the Crown." Hamilton, *Patents and Free Enterprise* (1941), p. 1152, Temporary National Economic Committee, Monograph No. 31, 76th Cong., 3d Sess.
>
> The purpose "to promote the progress of science and useful arts" accordingly provides the standards for the exercise of the power and sets the limits beyond which it may not go. We should not pass on to Congress the duty to remove the private prerequisites which we have grafted on the patent laws. This Court was responsible for their creation. This Court should take the responsibility for

> their removal. I (Justice Douglas) would adopt the view of *Hoe* v *Knap, supra*. In a case like the present (*Butterworth* v *Hoe*, 112 U.S. 50, 61), as infringement suits (*Morton Salt Co.* v *Suppiger Co.*, 314 U.S. 488, 492-494), the Court sits as a court of equity."

Dr. Kearns is frequently asked, "Why don't you forget this litigation and go invent something else and get on with your Kearns Engineers business?" Dr. Kearns' answer? "If the system doesn't work, you'd have to be a fool to do it twice!"

That remark is in keeping with Galileo's[3] second comment, *infra*:

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[3] Kettering Award Address, Honorable Giles W. Rich in The Vague Concept of "Invention" as Replaced by Sec. 103 of the 1952 Patent Act, 46 J. Pat. Off. Soc'y 855, at 857 (1964)(the year after Dr. Kearns demonstrated his IWWS technology to Ford and Chrysler.)

> "it is not being fit that this invention, which is my own, discovered by me with great labor and expense, be made the common property of everyone;"

and also, that if he were granted the privilege,

> "I shall the more attentively apply myself to new inventions for universal benefit."

In *Kearns* v. *Chrysler*, George Frost was Chrysler's expert. He was the past Chief Patent Counsel of General Motors who wrote during the early years of his career the Congressional subcommittee study, *The Patent System and the Modern Economy*[4]. After Mr. Frost identified the following writing as his own, Dr. Kearns in leading cross-examination queried Mr.

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[4] Study No. 2 of the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary, 84th Cong., 2d sess. (1957), page 5. Congressional Library Microfilm #11997.

Frost on the validity of the writing. Dr. Kearns said he had carried in his wallet for many, many years the following words from that study:

> "(T)he patent system provides a protected market with the opportunity for unusual profit necessary to justify the heavy investment in time, effort, and capital necessary to bring the improvement to the public. This same protected market provides an entering wedge by which a business enterprise entering a new field can overcome the obstacles that otherwise discourage entry into an industry already populated."

The U.S. Constitution and studies like George's are the stuff inventors have time to read - and do believe. That's the origin of their incentive. They aren't knowledgeable in the fine print filling a law library.

Ford used[5] Dr. Kearns' patents in developing the intermittent windshield wiper system it experimentally tested, tooled, and produced in volume for its

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[5] *Roche, supra.*

1969 models on sale in 1968. Knowledge of that use and inquiry by Dr. Kearns led to Ford challenging the validity in writing of Dr. Kearns' patents on 18 February 1972. Ford admitted the infringement. The validity of Dr. Kearns' patents were not judicially re-establish by the U.S. Government in *Kearns* v. *Ford* until 9 March 1990 and their validity and infringement remain challenged in *Kearns* v. *Chrysler* through the present date. Due to Ford and Chrysler's use of Dr. Kearns patents from before they issued, Dr. Kearns has not had one day of the U.S. Constitutional standard of compensation to inventors, namely, time to exclude others. Because of his on-going patent judicial review problems and relatively poor financial condition, he had to abandon: Kearns Engineers; his Computer Central© products he manufactured and sold

throughout the U.S., France and Japan [A-1424]; and the utilization of his succeeding U.S. patents [A-1429].

Dr. Kearns' patent rights to exclude Ford and Chrysler having now been found valid and admitted infringed by Ford and found infringed by Chrysler, the Court 'may grant injunctions in accordance with the principles of equity to prevent the violation of any of Dr. Kearns' patent rights secured by patent, on such terms as the court deems reasonable' knowing that to date Dr. Kearns has not had one day of the Government securing for 'limited Times (17 years)' the 'exclusive right to him of his discoveries.' The time to exclude may start now and Dr. Kearns requests an injunction issue to do so.

Moreover, issued U.S. patents do not leave the U.S. Patent Office in the same

order in which the applications were received. Examiner challenges to patentability, benefit of earlier filing dates, divisional applications, appeals to the Board of Appeals, interferences, civil action to obtain patent, civil action in case of interference, etc. all work to vary the order of issue date from the date the application was received in the patent office. Dr. Kearns knows. See Dr. Kearns'

Patent No.	Filing Date	Issue Date
4,531,066	1/3/67	6/23/85

A time period of 18 years, 6 months and 20 days for Dr. Kearns' '066 application to issue from the Patent Office.

Dr. Kearns' injunction to exclude others issuing now is appropriate relief.

In *Franklin* v *Gwinnett County Schools*, 90-918 argued 11 December 1991 and decided 26 February 1992, the Supreme Court stressed, via a majority opinion written by Justice White:

"... a longstanding principle [is] that federal courts possess wide discretion to impose any remedy ... to make good a violation of federal law."

Justice White further noted, "Congress likewise made no effort ... to alter the traditional presumption in favor of any appropriate relief for violation of a federal right."

#3 Merits panel ruling: p. 18, line 20: When that exclusive right is infringed, the patent owner is authorized to obtain compensation

No! When that exclusive right is infringed, the patent owner "shall have remedy by civil action." Title 35 U.S. Code § 281. Compensation results in nothing more than a judicially imposed compulsory license. The U.S. under our Constitution can not be like Canada where a compulsory license section exists in Canada patent law. In the U.S., the U.S. Congress has elicited the public's appraisal of a compulsory license provision in the patent laws, e.g., in the McFarland Compulsory Licensing Bill in the Hearing on H.R. 9259 before the O'Malley Committee, 75th Cong., 3rd Sess.

(1938); **and**, in RECOVERY IN PATENT INFRINGEMENT SUITS; relevant portions being extracted as follows by Dr. Kearns from the references identified.

There is no Mystery About Patents, by William R. Ballard, J.M. Barrett Corp., *Publishers*, 220 East 42nd Street, N.Y.17,N.Y. 1946

> "The public's appraisal of the patent system has been elicited more than once by legislative proposals to introduce into it a compulsory licensing provision. Such a provision, while ostensibly leaving the system intact, would in fact reduce the value of the patent grant to a mere shadow, as the testimony on each occasion has made clear. The latest attempt was in March, 1938 when extended hearings were held on H.R. 9259 - the McFarland bill .... Seventy of the seventy-four witnesses vigorously opposed the bill. It was defeated. * * *

RECOVERY IN PATENT INFRINGEMENT SUITS, Hearing before the U.S. Congress, House Committee on Patents. House of Representatives 79th Congress, 2d sess., on H.R. 5231, A Bill to Amend Revised Statutes, 4921 (U.S.C. Title 35, Patents,

Sec. 70), Providing That Damages be Ascertained on the Basis of Compensation for Infringement, as in Actions for Infringement in the U.S. Court of Claims. (Subsequently amended, reintroduced, and reported as H.R.5311) January 29, 1946

> Mr. Davis. I would like to say that the American Bar Association specifically in 1932 had under consideration the language "reasonable royalty" as suggested by Mr. Stedman in exactly the same manner. The association as a body very emphatically refused to adopt that language as amendment to the statute, and they felt at the time that it was tantamount to compulsory licensing.
>
> Mr. C. Henry. ... How would such an arrangement work out in cases of trespass to realty? Suppose we had a law that only a reasonable rental could be collected for any such trespass, wouldn't that amount to a compulsory leasing of realty? Is it unreasonable to suppose that a person intending to trespass upon and occupy the realty would first offer to purchase a lease and, upon refusal, proceed to trespass and occupy anyway knowing full well that he wouldn't be out of pocket any more than if his offer had been accepted in the first place? The right to injunction in cases of patent infringement does not

alter the situation because the granting of an injunction is not mandatory....

Mr. C. Henry. Gentlemen, before we close I would like to make the suggestion that this committee reject every compulsory license proposal regardless of how it is hidden or in whatever disguised form it may be submitted to this committee. It has been rejected by every Congress that has considered the matter for the past 20 years, often after voluminous testimony.

The Chairman. All in favor of rejecting everything Mr. Stedman has said with reference to the last amendments, indicate by saying "Aye"; opposed, "No."(The motion was unanimously carried.)

Mr. Conder C. Henry is the Assistant Commissioner of Patents.

Mr. Chester L. Davis is from the Amer. Bar Assoc., Patent Section

John Stedman is from the Department of Justice.

While an injunction is not mandatory as Mr. Henry notes, it is for the District Court only "in the first instance[6]."

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[6] *Roche, supra*, 865R,line 33 (Fed.

#4 Cautionary p. 19, line 13: [W]hen the rights secured **Merits panel ruling** by patent are no longer protectable by virtue of expiration or unenforceability, entitlement to injunctive relief becomes moot because such relief is no longer available.

Dr. Kearns believes the panel's statement identified herein to be literally true with the correct definition of terms [pun]. All patents arrive at the day when they expire with the result stated. In *Illinois*, the case concerns relief from denial of a motion for a preliminary injunction. The Court is entitled to make that decision but at the expense of restoring the exclusive time to the inventor should the Court be wrong in its preliminary decision. In the District Court Dr. Kearns was denied a preliminary injunction. The following quotation is from the Memorandum and

---

Cir. 1984).

Order [10 Jan. '80] concerning Dr. Kearns' request for a Preliminary Injunction.

> "It is true that if plaintiff's patent were to expire prior to a decision finding the patent valid and infringed, the plaintiff's anticipated position as a major supplier of the windshield wiper systems would be undermined. The short answer to this contention is that this action will be completed before the expiration date of plaintiff's patent. The Court would therefore be able to enjoin the infringement of this patent if plaintiff is successful on the merits and plaintiff would be allowed the marketing foothold which he fears would otherwise be lost. Pursuant to the foregoing, the Court will deny plaintiff's Motion for a Preliminary Injunction.

However, the merits panel ruling #4 may not be true if only the 'routine life' has expired.

> **#5 Merits panel ruling:** p. 19, line 23: Here, all the asserted <u>patents expired before the commencement of trial.</u>

Inventors are entitled to remedy on the filing of a Complaint for infringe-

ment in a civil action under Title 35 U.S. Code § 281--not upon starting trial. The subsequent expiration of the patent's 'routine life' does not make the Complaint moot and they may be entitled to both § 283 & § 284 for a remedy. In *Kinzenbaw*, the Court decided the Keeton patent, p. 387L, line 2:

> "claim for damages arising from Kenze's infringement of the Keeton patent was released by the Settlement Agreement dated April 1, 1983." Accordingly, as Deere recognizes, any issue concerning the validity of the Keeton patent is moot.

not the expiration later of the Keeton patent on 14 March 1984.

> **#6 Merits panel ruling:** Granting the relief requested by Kearns would impermissibly extend the statutory <u>term beyond that established by Congress.</u>
> See the argument in #1 and #2 *supra*.

> **#7 Merits panel ruling:** p. 20, line 7: [I]t has not done so here <u>and we cannot legislate in its place.</u>

Congress legislated what is required

in this appeal in 1952. There is no need for the Judicial Branch to legislate in its place.

> **#8 Merits panel ruling:** p. 20, line 11: $11 million in damages thus amounts to adequate and full compensation under the law for Chrysler's past violation of his patent rights.

Money damages alone of any magnitude comprise a compulsory license rejected by Congress, *supra*; are a violation of the U.S. Constitution; are not adequate compensation under the law for Chrysler' past violation of his patent rights; and, are not in the public's interest. (Remember, INTELLECTUAL PROPERTY WAR.)

> **#9 Merits panel ruling:** p. 20, line 14: Kearns argues ... the availability of post-expiration equitable relief is simply a matter within the discretion of the trial court.

Kearns argues the 'routine life' of a patent does not necessarily begin with the issuance of the patent. The availability of post-'routine life' expiration is in the statute, #1 and #2, *supra*. Congress' rejection of a compulsory li-

cense section in the patent law, *supra*, leaves money damages inadequate as a remedy by the Judicial Branch. Dr. Kearns has maintained the exclusivity of his patents. Kearns has never licensed any of his 29 U.S. patents.

Congress knows how to extend the statute' scope and it did so.

> **#10 Merits panel ruling:** p. 20, line 18: In Roche ... the request for injunctive relief became "no longer ... necessary" because <u>the patent had expired.</u>

In Roche, the expiration of the patent did not make the case nor remedy moot as

> "other remedies can be fashioned against Bolar's past infringement.... Whether an injunction should issue in *this* case, and of what form it should take, certainly depends on the equities of the case.... Since "the standards of the public interest, not the requirements of private litigation, measure the propriety and need for injunctive relief .... we remand this case to the district court for further proceedings to consider what this interest is and what measures it

calls for."

#11 Merits panel ruling: p. 21, line 2: Kearns, however, is not in a position to benefit from such relief. Ah, but he is! See #1 & #2, *supra*.

#12 Merits panel ruling: p. 21, line 4: The post expiration relief discussed in Roche was intended to return the parties to the status quo before infringement ...

What was to be "fashioned" is "relief against Bolar's past infringement." *Roche*, *supra*, p. 865R, line 4. A remedy

(§ 281). **#13 Merits panel ruling**: p. 21, line 12: In contrast, because Chrysler has been manufacturing and selling its infringing IWWS for many years and Kearns has not there is no basis for granting relief similar to that contemplated by the court in *Roche*.

There is no requirement under the law for an inventor to manufacture and sell her(is) inventions to receive her(is) Constitutional standard of compensation, namely, 'time'. In *HARTFORD-EMPIRE CO. et al. v U.S.*, 323 U.S. 386, 432,

"2.(aa) The owner of a patent is under no obligation to use the patent

or to grant its use to others."

In Chisum, REMEDIES FOR PATENT INFRINGEMENT, page 393:

> A patent owner's right to monetary and injunctive relief is restricted by the equitable doctrines of laches and estop-pel, the statutory six-year damage limitation, and the marking requirements. (Emphasis added.)

As to the pre-infringement status quo, Dr. Kearns manufactured production modules and drawings for Daimler-Benz and Porsche at their request for tests with delivery made in January, 1979 and made available to them at a price of zero before Chrysler ever manufactured and sold its IWWs. Dr. Kearns also manufactured IWW controls, installed them in cars for Chrysler tests [A-147, 150, 154] and made them available to them at a price of zero before Chrysler ever manufactured and sold its IWWs which by Similarity and Access [A-429] were a copy of

Dr. Kearns' designs.

> **#14 Merits panel ruling:** p. 21, line 21: While it is of course the essence of a patent that it provides the right to exclude, the same statute that grants that right also permits other parties, including accused infringers, to challenge the validity of a patent and to contest a charge of infringement.... p. 22, line 11: Here, because Kearns' patents have expired, the district court certainly did not abuse its discretion in denying injunctive relief.

See, #1 and #2, *supra*. Both of these contests are in the public's interest but the law doesn't say the public interest in the 'time to exclude others' must be sacrificed without replacement? In *HARTFORD-EMPIRE CO. et al.* v *U.S.*, 323 U.S. 386, 415:

> That a patent is property, protected against appropriation both by individuals and by government, has long been settled. *James* v *Campbell*, 104 U.S. 356, 357, 358; *Hollister* v *Benedict & Burnham Mfg. Co.*, 113 U.S. 59,67; *Wm.Cramp & Sons Co.* v *International Curtis Marine Co.*, 246 U.S. 28, 39,40; *United States* v *Dubilier Condenser Corp.*, 289 U.S. 178, 189.

(Emphasis added.)

Regarding the panel's statement that Judge Cohn "certainly did not abuse its discretion in denying injunctive relief" in *Heat and Control, Inc.* v *Hester Indus., Inc.*, 785 F.2d 1017, 1022 (Fed. Cir. 1986), this court said:

> "An abuse of discretion occurs when
>
> (1) the court's decision is 'clearly unreasonable, arbitrary or fanciful; (2) the decision is based on an erroneous conclusion of law; (3) the court's findings are clearly erroneous; or, (4) the record contains no evidence on which the district court rationally could have based its opinion."

Judge Cohn's abuse meets the conditions of (2) and (4): with (2) being inapposite to the presentation in #1 and #2, *supra*; and (4) being Judge Cohn denied Dr. Kearns the opportunity for an evidentiary hearing in ruling their was no need to "reinvent the wheel" from his decision in *Kearns* v. *Ford* wherein his attorneys

denegrated and omitted Dr. Kearns' true position as the merits panel saw in the appendix. However, Dr. Kearns submitted PLAINTIFF'S FINDINGS OF FACT AND OFFER OF PROOF RELATING TO EQUITABLE RELIEF on 6 Feb. 1991 [A-1] in an attempt to inform Judge Cohn that his patents had not expired under the new law legislated by Congress in 1952.

> **#15 Merits panel ruling:** p. 21, line 17: The patent statute does provide for increased damages ..., but Kearns did not persuade the district court that he was entitled to such relief.

Nor, would he persuade the merits panel since they applied *Panduit*, a 1978 case. Chrysler manufactured but 59,000 electronic modules in their first year of infringement. An assembly person at Kearns Engineers could assemble the five components comprising Dr. Kearns' module in five minutes [A-676, 1031]. That is 12 per hour; 100 per day; 500 per week; and 25,000 per year. Thus three assembly persons plus support staff were all that was needed for Kearns Engineers to meet

Chrysler's needs.Chrysler-the-infringer and Kearns Engineers were the only two suppliers to Chrysler-the-market to submit a quotation. Kearns Engineers submitted 20 modules pre-tested in accordance with PS-6338 [1013].

> "Frequently, the patent owner and infringer are the only suppliers in the market, and the owner is seeking to recover profits lost through every sale made by the infringer. *See, Water Technologies Corp.* v *Calco Ltd.*, 850 F.2d 660, 672, 7 USPQ2d at 1106; *Amster Corp.* v *Envirotech Corp.*, 823 F.2d 1538, 1543, 3 USPQ2d at 1065, 219 USPQ at 675. In the two-supplier market, it is reasonable to assume, provided the patent owner has the manufacturing and marketing capabilities, that it would have made the infringer's sales. *See, Del Mar Avionics, Inc.* v *Quinton Instrument Co.*, 836 F.2d 1320, 1327, 5 USPQ2d 1255, 1260 (Fed. Cir. 1987). Where there are but two suppliers, the law assumes the inventor would obtain the business. The law is clear and well stated[7].

State Industries, supra, was the law 11

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[7] State Industries, Inc. v Mor-Flo Industries, Inc., 883 F.2d 1573 (Fed. Cir. 1989)

years after *Panduit* with the result Dr. Kearns is entitled to his lost profits [A-1426a] on the 16,514,053 IWWs [A-1629] in trial as the IWWs serving the rear windows are subject to Dr. Kearns' patents too.

> **#16 Merits panel ruling:** p. 22, line 22: We therefore conclude that the district court properly granted summary judgment in favor of Chrysler on Kearns' request for post-expiration injunctive relief.

For the reasons presented in #1 - #15 above, despise not Dr. Kearns' suggestion, but in your clemency hear Dr. Kearns in banc.

Respectfully submitted,

Robert W. Kearns, Pro Se
(410) 827-9337 (Tel/Fax)

P.S. To allow Harness, Dickey & Pierce to enter a precedent into the patent law that 'switching sides' is OK with not even a reprimand from the CAFC is a disincentive to invent and to use attorneys.

Dr. Kearns' reasonable lost profits including the rear window intermittent windshield wiper systems is:

$$\frac{16,514,053}{12,563,107} = \frac{X}{\$82,399,089.13}$$

$$X = \$108,313,702.66$$

CERTIFICATE OF SERVICE

THIS IS TO CERTIFY that a copy of Suggestion for Rehearing in Banc was mailed first-class, postage prepaid to Chrysler's Pillsbury, Madison & Sutro, Attn: Michael Conley, 1667 K Street, N.W., Washington, D.C. 20011; Houston Inventor's Association's Lane, Aitken and McCann, Attn: Richard L. Aitken, Esq., Watergate Office Building, 2600 Virginia Ave., N.W., Washington, D.C. 20037; and Arnold, White & Durkee Corporation, Attn: Bill Durkee, P.O. Box 4433, Houston, Texas 77210 this 25th of August 1994.

Bob Kearns

UNITED STATES COURT OF APPEALS FOR THE

FEDERAL CIRCUIT

93-1450,-1470

ROBERT W. KEARNS,

Plaintiff/Cross-Appellant

v.

CHRYSLER CORPORATION,

Defendant/Appellant,

and

AMERICAN MOTORS CORPORATION,

Defendant.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT

EASTERN DISTRICT

OF MICHIGAN

in CASE NO(S) 82-70748

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED.

AFFIRMED

EX F

ENTERED BY ORDER

DATED AUG 11 1994 OF THE COURT

/s/ Francis X. Gindhart, Clerk

Francis X. Gindhart, Clerk

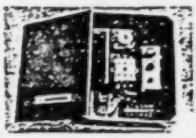
ISSUED AS A MANDATE: October 5, 1994

EXHIBIT F

メカトロニクス
機械と電子を結ぶ技術
1976

EXHIBIT G

ＥＬブレーキ



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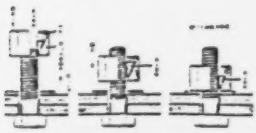

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小形直流安定化電源

DD/Aコンバータ
MODEL 840
新製品
デジタル型の差を
アナログ型に
変換する装置
■最高精度
1/1000 %
■変換時間
2μsec.
株式会社 チトセ商会

バルブコントロールモータ
VCモータ
モーターバルブ
バランシングリレー
株式会社 川電機器製作所
サンスイ機工株式会社

ミスト・コレクト

U.S. PATENTS: Patents held by Robert W. Kearns

Patent No.	Title	Filing Date	Issue Date
2 959 347	Means for Extending the Useful Frequency Response of Measuring Instruments	Aug 26, '57	Nov 8, '60
3 123 753	Bi-directional Step Motor Drive Voltage Divider Switching Apparatus	May 16, '60	Mar 3, '64
3 259 706	Magnetically Actuated Control Device	Jan 30, '62	Jul 5, '66
3 351 836	Windshield Wiper System with Intermittent Operation	Dec 1, '64	Nov 17, '67
3 422 331	Motor Speed Control Systems	Mar 7, '66	Jan 14, '67
3 483 459	Pulsed Windshield Wiper Control	Mar 7, '66	Dec 9, '69
3 500 159	Electronic Control for Windshield Wipers	Mar 7, '66	Dec 9, '69
3 529 227	Windshield Wiper Control	Mar 3, '67	Sep 15, '70
3 564 374	Intermittent Control Device	Sep 21, '67	Feb 16, '71
3 573 584	Motor Speed Control	Sep 1, '67	Apr 6, '71
3 581 178	Windshield Wiper Control Device	Apr 10, '69	May 25, '71
3 582 747	Intermittent Windshield Wiper System with Electrodynamic Braking	May 23, '68	June 1, '71
3 593 090	Intermittent Windshield Wiper Control	Apr 16, '69	Jul 13, '71

EXHIBIT H

3 593 090	Intermittent Windshield Wiper Control	Apr 16, '69	Jul 13, '71
3 602 790	Intermittent Windshield Wiper System	Oct 18, '67	Aug 31, '71
3 604 910	Parallel Comparator with Simultaneous Carry Generator and Analog Output	Aug 31, '67	Sep 14, '71
3 721 115	Structure for and Method of Surface Condition Sensing and Indicating and Motor Speed Control	Jun 8, '70	Mar 20, '73
3 728 603	Windshield Wiper Control	Oct 27, '70	Apr 17, '73
3 737 750	Motor Speed Control	Apr 27, '70	Jun 5, '73
3 774 091	Intermittent Windshield Wiper System with Electrodynamic Braking	Dec 22, '70	Nov 20, '73
3 796 936	Windshield Wiper Control Device	Dec 15, '72	Mar 12, '74
8 876 919	Structure for and Method of Surface Condition Sensing and Indicating and Motor Speed Control	Mar 12, '73	Apr 8, '75
3 902 106	Intermittent Windshield Wiper Control Device	Nov 7, '69	Aug 26, '75
4,339,698	Control Apparatus for Windshield Wiper System	Apr 12, '79	Jul 13, '82
4,494,059	Structure for and Method of Surface Conditioning Sensing and Indicating and Motor Speed Control	Jan 9, '80	Jan 15, '85

4,494,107 with James G.H. Quan	Digital to Analog Converter	Nov 3, '69	Jan 15, '85
4,531,066	Variable Bias Logic Circuit	Jan 3, '67	Jul 23, '85
4,544,870 with Tim Kearns	Intermittent Windshield Wiper Control System with Improved Motor Speed Control	Sep 7, '82	Oct 1, '85
3,458,589 21U by David Tann	Intermittent Windshield Wiper Cleaning System	Apr 8, '66	Aug 5, '69
3,643,145 21V by David Tann	Intermittent Control Device	Apr 18, '69	Feb 15, '72

CASES

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v.

WOODS MOTORS, INC., DAIMLER-BENZ AKTIENGESELLSCHAFT, and DR. ING. h.c.f. PORSCHE A.G.,

Defendants.

Civil No. 78-CV-70642
Honorable Avern Cohn
Special Master Barker

ROBERT W. KEARNS,

Plaintiff,

v.

FORD MOTOR COMPANY,

Defendant.

Civil No. 78-CV-70740
Honorable Avern Cohn

SWF-SPECIALFABRIK fur AUTOZEBEHOR GUSTAV RAU G.m.b.H., a corporation of the Federal Republic of Germany

Plaintiff,

v.

ROBERT W. KEARNS,

Defendant.

Civil No. 79-CV-74451
Honorable Avern Cohn
Special Master Barker

ROBERT W. KEARNS,

Plaintiff,

v.

CHRYSLER CORPORTION, and AMERICAN MOTORS CORPORATION,

Defendant.

Civil No. 82-70748
Honorable Avern Cohn
Special Master Barker

EXHIBIT I

UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT

ROBERT W. KEARNS, Plaintiff	:	MISC. NO. 2:92 MC 16 (PCD) District Judge Peter Dorsey
VS.	:	
CHRYSLER CORPORATION, ET AL Defendants	:	MARCH 11, 1992

ROBERT W. KEARNS,

Plaintiff,

v.

FRED LAVERY PORSCHE, WOOD MOTORS, INC., VOLKSWAGEN WERKE A.G. WOLFSBURG, and AUDI NSU AUTO UNION, A.G.

Defendants.

Civil No. 82-70749
Honorable Avern Cohn
Special Master Barker

ROBERT W. KEARNS,

Plaintiff,

v.

FERRARI S.p.A.,
AB-VOLVO,
ALFA ROMEO S.p.A.,
AUTOMOBILES-CITROEN, S.A.
BAYERISCHE MOTOREN WERKS, A.G.,
B-L, PLC (British Leland)
FUJI HEAVY INFUSTRIES, LTD.
GROUP LOTUS CARS CO.
HONDA MOTOR CO.
ISUZU MOTOR CO., LTD.
MITSUBISHI MOTORS CORP.
NISSAN MOTOR CO., LTD.
OFFICIENE ALFIERE MASERATI,
PEUGEOT, S.A.
REGIE NATIONALE RENAULT
ROLLS ROYCE MOTORS, LTD.
SAAB-SCANIA AB,
TOYO KOGYO CO., LTD (Mazda)
TOYOTA MOTOR CO., LTD

Civil No. 85-70459
Honorable Avern Cohn
Special Master Barker

Dealers in the Detroit area:

BARNETT PONTIAC-DATSUN, INC.
BAVARIAN MOTOR VILLAGE, LTD
DALGLIESH CADILLAC-PEUGEOT
JOE DWYER SUBARU VOLVO, INC.
FALVEY OF TROY
GROSSE POINTE AMC-JEEP RENAULT
LA FONTAINE TOYOTA
SEAWAY MOTORS, INC.
SPORTS CAR EXCHANGE, INC.
TAMAROFF BUICK-DMC-HONDA-ROLLS ROYCE, and
WOOD MOTORS, INC.

Defendants.

ROBERT W. KEARNS,

Plaintiff,

v.

GENERAL MOTORS CORPORATION,

Defendant.

Civil No. 85-70461
Honorable Avern Cohn
Special Master Barker

ROBERT W. KEARNS,

Plaintiff,

v.

THE UNITED STATES,

Defendant.

United States Claims Court
No. 436-84C

ROBERT W. KEARNS,

Plaintiff,

v.

UNITED TECHNOLOGIES CORP., and
UNITED TECHNOLOGIES AUTOMOTIVE, INC.

Filed 13 Mar 1992 2:23p
Civil No. 92-71408DT
Honorable Avern Cohn

ROBERT W. KEARNS,

Plaintiff,

v.

Civil No. 92-73649

AMERICAN ARBITRATION ASSOCIATION,
and, ARNOLD, WHITE & DURKEE CORP.

No. 436-84C	RWK v. U.S. (Court of Claims)	840823
No. 85-645	RWK v. U.S. (Court of Appeals for the Federal Circuit)	
No. 84-1849	RWK v. U.S. (Supreme Court)	850525

ROBERT W. KEARNS,

Plaintiff,

v.

THE UNITED STATES,

Defendant.

United States Claims Court
No. 436-84C

ROBERT W. KEARNS,

Plaintiff,

v.

THE UNITED STATES,

Defendant.

United States Court of Appeals
for the Federal Circuit
No. 85-645

ROBERT W. KEARNS,

Plaintiff,

v.

UNITED STATES,

Defendant.

Supreme Court of the United States
No. 84-1849

ROBERT W. KEARNS,

Plaintiff,

v.

FRED LAVERY PORSCHE AUDI CO.,
WOOD MOTORS, INC.
VOLKSWAGENWERK A.G. and,
AUDI NSU AUTO UNION, A.G.

Defendant.

United States Court of Appeals
for the Federal Circuit
No. 84-655

ROBERT W. KEARNS,

Plaintiff,

v.

FRED LAVERY PORSCHE AUDI CO.,
WOOD MOTORS, INC.
VOLKSWAGENWERK A.G. and,
AUDI NSU AUTO UNION, A.G.

Defendant.

Supreme Court of the United States
No. 84-907

Court of Appeals for the Federal Circuit
Appeal #92-1531 Kearns v. Chrysler

ROBERT W. KEARNS,

Plaintiff-Appellant,

v.

Ford Motor Company,
Wood Motors, Inc.,
Robert Bosch Corp.,
Daimler-Benz Aktiengesellschaft,
Porsche, A.G.

Defendant-Appellees,

U.S. Court of Appeals for the Federal Circuit
No. 87-1356

SWF-Specialfabrik fur
Autozebehor Gustav Rau, G.m.b.H.,

Plaintiff-Appellee,

v.

ROBERT W. KEARNS,

Defendant-Appellant,

Appeal from the U.S. District Court for the Eastern District of Michigan - Southern Division
Chief Judge Philip Pratt

of Memorandum opinion and Order imposing sanctions and permitting withdrawal of counsel.
(Wood docket #313)

UNITED STATES OF AMERICA
IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

ROBERT W. KEARNS,

Plaintiff,

v.

Civil Action No.
93-966-A

GENERAL MOTORS CORPORATION, and
BROWN'S BUICK & ISUZU

Defendants.

Defendants.

UNITED STATES OF AMERICA
UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

WILLIAM O. BITTMAN, et al., Plaintiffs, Counterclaim Defendants, v. ROBERT W. KEARNS, Defendant, Counterclaim Plaintiff, v. REED SMITH SHAW & McCLAY, Counterclaim Defendant.	Civil Action No. 92-0501 Judge Norma Holloway Johnson

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

WILLIAM O. BITTMAN, et al., Plaintiffs, Counterclaim Defendants, v. ROBERT W. KEARNS, Defendant, Counterclaim Plaintiff, v. REED SMITH SHAW & McCLAY, Counterclaim Defendant.	Civil Action No. 2:93-CV-74013 Honorable Avern Cohn

KEARNS v. CHRYSLER & AMERICAN MOTORS, 94-1303
KEARNS v. TOYOTA, 94-1305, -1321

KEARNS v. FERRARI, 94-1306
KEARNS v. WOODS v. SWF, 94-1307
KEARNS v. FRED LAVERY PORSCHE, 94-1308
KEARNS v. UNITED TECHNOLOGIES, 94-1310
KEARNS v. BITTMAN, 94-1311
KEARNS v. AMERICAN ARBITRATION ASSOC, 94-1313
KEARNS v. FOLEY & LARDNER
KEARNS v. FULBRIGHT & JAWORSKI
KEARNS v. CHRYSLER (4th) 95-1016

RECEIVED OCT 27 1992

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

v. Civil No. 85-70461

GENERAL MOTORS

CORPORATION,

Defendant.

ORDER

A.

The Court has under consideration the question of whether plaintiff, Robert W. Kearns (Kearns), should be required to obtain counsel to prosecute this case and, if he does not obtain counsel, what action the Court should take. This case is one of a number of patent cases before the Court in which Kearns is plaintiff. The court has had the opportunity to

EX. J

observe the conduct of Kearns in lengthy proceedings already concluded, including two full patent liability trials, three damage trials, and innumerable pretrial hearings and conferences. Kearns was represented in one of the damage trials and now represents himself in all of the cases. The Court is satisfied that Kearns has the ability to obtain competent counsel, and that competent counsel has been and continues to be available if and when Kearns chooses to accept representation. Kearns has been repeatedly advised by the Court that he should obtain counsel. The several cases present complex issues and difficult legal questions which are, in the Court's view, beyond Kearns' competence to handle. While the Court lacks the authority to require Kearns to be represented by counsel, it does have the authority to enter

this order to assure that Kearns does not surreptitiously represent himself as a pro se litigant while at the same time utilize the services of counsel. O'Reilly v. New York Times Company, 692 F.2d 863 (2nd Cir. 1982) cert. den. 488 U.S. 856 (1988).

B.

This order is entered in the interests of judicial efficiency and to avoid any misunderstanding concerning the procedures, conditions and requirements regarding Kearns' continued representation of himself in this case.

Accordingly -

1. To the extent that Kearns acts as his own counsel, he is subject to the same rules, regulations and sanctions which are applicable to attorneys appearing before the Court under the same circumstances.

2. While Kearns continues to be admonished that he should have counsel represent him, he may not employ or retain counsel, or seek the aid or assistance of counsel to perform any function with respect to this case, without such counsel formally entering an appearance, at which time Kearns' right to proceed pro se shall terminate. Kearns shall provide a copy of this order to any counsel employed or retained by him while this order is in effect.[1]

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[1] The Court expresses no opinion and this order does not extend to any person who is not eligible for admission to the Bar of this Court. Local Rule 110.1. To the extent that Kearns utilizes the services of such a person as functional counsel the laws and rules regarding the unauthorized practice of law apply.

3. Kearns is admonished that his need to retain counsel is immediate. The Court will look with disfavor upon any application for an enlargement of time, whether presented by Kearns or by any counsel which Kearns may belatedly retain, and any assertion of complexity, difficulty, or burden will not be regarded as good cause for an enlargement of time under Fed. R. Civ. P. 6(b), or as excusable neglect to avoid sanctions for any failure to act, when the need for additional time might have been obviated by the retention of counsel. The Court will view with disfavor any application by Kearns or any later retained counsel to disavow, amend or depart from any position taken or statement made by Kearns during his personal persecution of this case, and will view with disfavor any application for reconsideration or

relief from any order, or for judgment notwithstanding the verdict, when such application is grounded in whole or in part on an assertion that Kearns lacked adequate legal representation.

4. To permit defendant's counsel to properly prepare for trial, and to avoid any disruption or delay immediately before or during trial, the Court will not permit Kearns to retain counsel and terminate his personal representation in this case after the approval of the joint pretrial statement.

SO ORDERED.

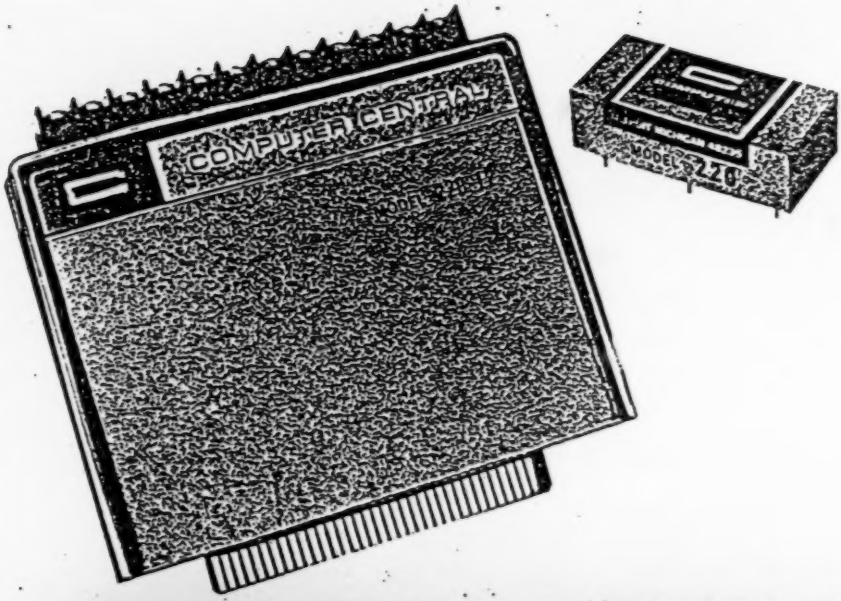
/s/ Avern Cohn

AVERN COHN

UNITED STATES DISTRICT JUDGE

DATED: OCT 26 1992

Detroit, Michigan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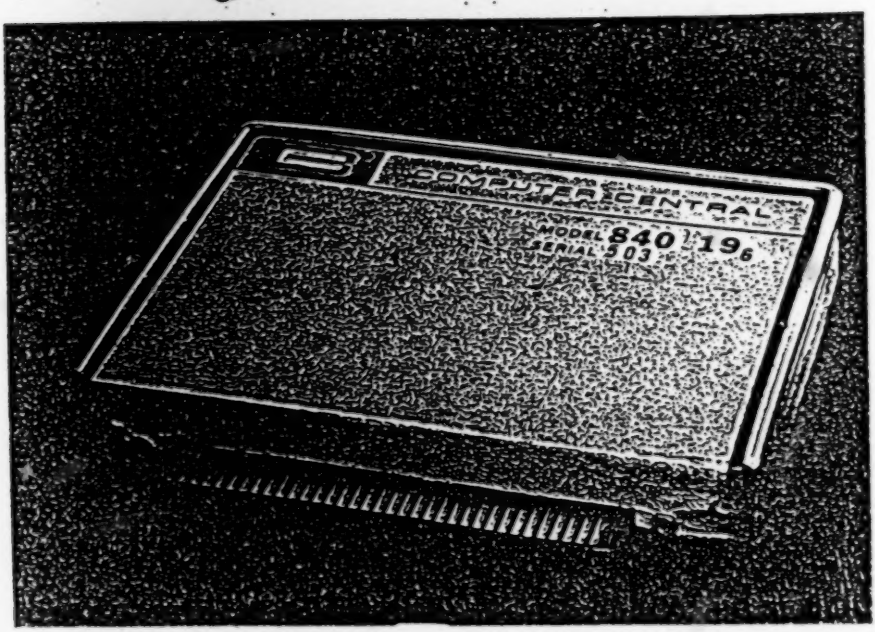
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機械と電子を結ぶ技術設計速報誌

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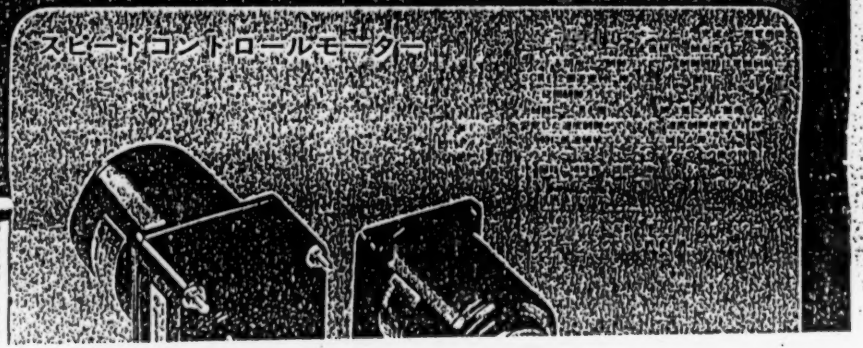

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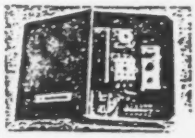

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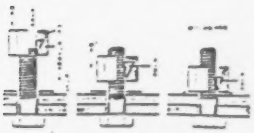

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小形直流安定化電源

LIST OF CASES

Cases in the U.S. District Court for the Eastern District of Michigan, Southern Division:

LITIGANT	CIVIL NO.
Kearns v. Wood Motors, Inc., Daimler-Benz Aktiengesellschaft and, *Dr. Ing. h.c.f. Porsche A.G.*	78-CV-70642
Kearns v. Ford Motor Co.	78-CV-70740
SWF - Specialfabrik fur Autozebehor Gustav Rau F.m.b.H., a corporation of the Federal Republic of Germany (ITT Corp.) v. Kearns	79-CV-74451
Kearns v. Fred Lavery Porsche, Wood Motors, Inc., Volkswagen Werke A.G. Wolfsburg, and Audi NSU Auto Union, A.G.	82-70749

A-C

LITIGANTS (con't.)	CIVIL NO.
Kearns v. Ferrari S.p.A., *AB-Volvo; Alfa Romeo S.p.A.; Automobiles-Citroen, S.A.; Bayerische Motoren Werks, A.G.; B-L PLC (British Leland); Fuji Heavy Industries, Ltd.; Group Lotus Cars Co.; Honda Motor Co.; Isuzu Motor Co., Ltd.; Mitsubishi Motors Corp.; Nissan Motor Co., Ltd.; Officiene Alfiere Maserati; Peugeot, S.A.; Regie Nationale Renaut; Rolls Royce Motors, Ltd.; Saab-Scania AB; Toyo Kogyo Co., Ltd. (Mazda); Toyota Motor Co., Ltd.;* Dealers in the Detroit area: *Barnett Pontiad-Datsun, Inc.; Bavarian Motor Village, Ltd.;*	85-70459

LITIGANTS (con't.)	CIVIL NO.
Dagliesh Cadillac-Peugeot; Joe Dwyer Subaru Volvo, Inc.; Falvey of Troy; Grosse Pointe AMC-Jeep Renault; La Fontaine Toyota; Seaway Motors, Inc.; Sports Car Exchange, Inc.; Tamaroff Buick-DMC-Honda-Rolls Royce; and Wood Motors, Inc.	
Kearns v. General Motor Corp.	85-70461
Kearns v. United Technologies Corp. and United Technologies Automotive, Inc.	92-71408

Other cases:

LITIGANTS	COURT & NO.
Kearns v. United States	U.S. Claims 436-84C
Kearns v. United States	U.S. Court of Appeals for the Fed. Cir. 85-645
Kearns v. United States	Supreme Court 84-1849
Kearns v. Fred Lavery Porsche Audi Co.; Wood Motors, Inc.; Volkswagenwerk, A.G.; and Audi NSU Auto Union, A.G.	U.S. Court of Appeals for the Fed. Cir. 84-655
Kearns v. Ford Motor Company; Wood Motors, Inc.; Robert Bosch Corp.; Daimler-Benz Aktien-	U.S. Court of Appeals for the Fed. Cir.

LITIGANTS (con't.)	COURT & NO.
gesellschaft; Porsche, A.G.; SWF-Specialfabrik fur Autozebehor Gustav Rau, G.m.b.H. v. Kearns	87-1356
Kearns v. Chrysler Corp. and American Motors Corp.	U.S. Court of Appeals for the Fed. Cir. 92-1531

RECEIVED JAN 11 1980

WHITEMORE, _____ & _____

UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF MICHIGAN

SOUTHERN DIVISION

ROBERT W. KEARNS,

Plaintiff,

vs. CIVIL ACTION

WOOD MOTORS, INC., NO. 78-70642

DAIMLER-BENZ

ARTIENGESELLSCHAFT and

Dr. Ing. h.c.F. PORSCHE A.G.,

Defendants.

MEMORANDUM OPINION AND ORDER

REGARDING PLAINTIFF'S MOTION

FOR A PRELIMINARY INJUNCTION

Plaintiff Dr. Robert Kearns is the owner of seven United States patents dealing with transistorized windshield wiper control systems. Kearns has

A-P

brought this action against three defendants for patent infringement in violation of 35 U.S.C. §271 (a) and 271 (b). This suit was begun on March 21, 1978. Over 17 months later, plaintiff filed the instant Motion for a Preliminary Injunction. In this motion plaintiff requests that the defendants and their officers and agents be enjoined from infringing one of the seven patents.[1]

The parties have submitted extensive briefs on the propriety of a preliminary injunction in this case and have argued their positions orally. The primary

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[1]The patent at issue in this motion is U.S. Patent No. 3,564,374 an intermittent control device. Dr. Kearns originally applied for this patent on December 1, 1964 and the patent has a date of issue of February 16, 1974.

point of contention between the parties concerns the standards which must guide the Court in considering a request for preliminary relief in a patent case. It is to this threshold question that the Court must first turn.

Plaintiff has argued in its various submissions that the factors which govern the Court's exercise of discretion in every other preliminary injunction request are also fully applicable in patent litigation. Defendants on the other hand suggest that plaintiff in such motions faces a far stricter standard than that which obtains in the ordinary case.

To a certain extent plaintiff has correctly stated the law. As in other cases, the Court, in deciding such a motion, is required to weigh four factors: plaintiff's probability of success on the merits; the irreparable injury

suffered by plaintiff as a result of defendants' actions; the balancing of harm to the plaintiff if such relief is granted relative to the harm suffered by defendants if a preliminary injunction issues; and the public interest in granting or denying the injunction. However, in giving substance to these generalities, federal courts have attached various rules in patent cases which operate to make plaintiff's burden substantially greater.

This stricter standard is particularly apparent in examining plaintiff's probability of ultimate success. To establish this element plaintiff must prove his title to the patent, the patent's validity, and infringement on the part of defendant. But while in the ordinary preliminary injunction request plaintiff would have to prove these elements suffi-

ciently to establish a strong or substantial likelihood of success on the merits, see e.g., Mason County Medical Ass'n. v. Knebel, 563 F.2d 256 (6th Cir. 1977), this standard is not applicable in patent cases. Instead, the widely accepted rule is that entry of an injunction in patent litigation requires that title, validity, and infringement be established "beyond question" or "beyond a reasonable doubt". See Mayview Corp. v. Rodstein, 480 F.2d 714 (9th Cir. 1973); Eli Lilly and Company, Inc. v. Generix Drug Sales, Inc., 460 F.2d 1096 (5th Cir. 1972); Carter-Wallace, Inc. c. Davis-Edwards Pharmachal Corp., 443 F.2d 867 (2nd Cir. 1971), cert. den. 412 U.S. 929 (1973); Leavitt v. McBee, 124 F.2d 938 (1st Cir. 1942); 8

Walker on Patents § 686 (Deller 2nd Ed., 1973).[2]

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[2]It has been suggested that the Sixth Circuit does not require such a high standard of proof. See Dorr and Duft "Patent Preliminary Injunction Relief" 60 J.Pat.Off.Soc. 597, 632 fn. 7 (hereinafter Dorr & Duft). The authors of that article reach that conclusion based on indications gleaned from the text of City of Grand Rapids v. Warren Bros., Inc., 196 F. 892 (6th Cir. 1912), Crescent Specialty Co. v. National Fireworks Dist. Co., 219 F. 130 (6th Cir. 1915) and
Blount v. Societe' Anonyme Du Filtre, 53 F. 98 (1892). This conclusion is open to question in light of the near unanimity in the other federal courts favoring the stricter standard in cases far more re-

cent than these three Sixth Circuit cases. See Dorr & Duft, supra at 632. Furthermore, drawing a firm conclusion from these cases is difficult because of an apparent inconsistency between the three holdings. The two earliest cases, Blount and City of Grand Rapids may indeed be read as incorporating traditional preliminary injunction standards into patent litigation. The third case however casts some doubt on this reading. In Crescent Specialty, the Court stated that a preliminary injunction could be ordered where title was clear, plaintiff demonstrates a fair probability that the patents are valid, and "there is sufficient showing of public acquiescence therein", id. at 132. This seemingly mandatory proof of public acquiescence is surely not consistent with the Sixth Circuit's

Federal courts have recognized that validity and infringement can be established beyond question if there has been a prior adjudication of the patent in question or if there has been public acquiescence in the patent. Defendants have argued here that proof of either of these two elements is a prerequisite to injunctive relief in any patent case. It is therefore argued that because there has been no prior adjudication of the patent or prior acquiescence this motion must be denied.

The Court agrees that plaintiff cannot claim either of the two exceptions,[3] but

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earlier rulings that traditional equitable principles would govern patent cases.

[3]Plaintiff has asserted that the officers of Dambler-Benz and Porsche made offers to settle this case shortly after

the Court is unable to accept the argument that proof of acquiescence or prior adjudication is a necessary precondition to the granting of preliminary relief. The federal courts appear to have reached contradictory conclusions on this subject, but in this Court's view the better rule of law is contained in the Fifth Circuit's decision in Eli Lilly v.

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suit was filed. Plaintiff contends that this demonstrates that these defendants impliedly acknowledged these patents to be valid. The settlement offers are of little or no value in proving that defendants conceded validity or infringement, for they merely reinforce the position defendants have taken throughout this litigation, i.e., the costs of defending this suit exceed any possible liability for infringement they may have.

Generix Drug Sales, supra, where the Court held that plaintiff's burden of establishing validity and infringement beyond question "is ameliorated where the patent at issue has been the subject of long acquiescence or has been adjudicated to be valid". Id. at 1099. Thus while acquiescence or prior adjudication are not prerequisites to a preliminary injunction, absent proof of one of these elements, plaintiff has the difficult task of demonstrating validity and infringement beyond question by other evidence. Since plaintiff has presented no evidence of prior adjudication or acquiescence, it is this high standard which controls the Court's consideration of the motion for preliminary injunction.

In their memoranda in opposition to the plaintiff's motion defendants have argued that plaintiff is unable to prove

validity or infringement beyond a reasonable doubt for any number of reasons. Of principal concern to the Court is the claim that the patent at issue here is invalid under 35 U.S.C. § 102(b) since it was "on sale" more than one year before the December 1, 1964 application filing date. Section 102 (b) of Title 35 provides that a person may be entitled to a patent unless:

> "the invention was . . . on sale in this country more than one year prior to the last date of application for patent in the United States."

Defendants have asserted that one year before his application, Dr. Kearns demonstrated a working model of his system to several employees and agents of the Ford Motor Company. Defendants have also submitted affidavits signed by Dr. kearns and testimony given by Kearns in prior litigation which, in defendants' view,

imply that these demonstrations were intended as a solicitation for the sale of the invention.

Plaintiff on the other hand has suggested that the demonstration of the patent before the Ford employees was designed for personal informational purposes only. It is claimed that the intermittent windshield wiper control system was not operational at this time, particularly in light of the fact that the system when housed in the automobile would have to withstand temperatures which might adversely affect the operation of the system which was demonstrated to the Ford engineers.

The Court has reviewed carefully the submissions of counsel on this issue and it must conclude that defendants have raised a reasonable doubt as to the validity of the patents under 35 U.S.C.

§ 102(b). A logical inference which can be drawn from statements made by plaintiff himself in prior testimony and affidavits is that he was most interested in becoming the Ford supplier for such wiper systems and that this was his direct goal in conducting the demonstration. It further appears from Dr. Kearns' testimony that the system was at the time of the demonstration in a marketable state.

It is neither necessary or prudent for the Court to go into great depth into the relative merits of the parties' position or the question of § 102(b)'s application. The ultimate disposition of this question of validity of the Kearns' patent must be left to a later time. But, in the present procedural context the Court is only concerned with whether plaintiff has established the validity of

his patent beyond question. The Court must conclude that he has not.

Regardless of its conclusion on the merits of plaintiff's claim, the Court would be constrained to deny the instant motion because of plaintiff's failure to establish irreparable injury. As noted by the Supreme Court in Sampson v. Murray, 415 U.S. 61 (1974), "[t]he basis of injunctive relief in the federal courts has always been irreparable harm and inadequacy of legal remedies". Id. at 88.

Plaintiff has claimed several examples of irreparable harm which would result if a preliminary injunction is not issued. Plaintiff's primary argument is premised on his contention that, except for the defendants' infringement of his patents, plaintiff would be the major manufacturer and supplier of these systems. He has

therefore argued that this status is being denied him while defendants continue infringing his patents. Plaintiff further claims that he may be forever denied a foothold in the market as a supplier of these goods since the patent at issue here expires in four years.

The Court notes that plaintiff's inability to become a supplier of defendants' allegedly unlawful use of plaintiff's patent does not establish irreparable harm. Such claims for lost profits if proved with sufficient definition at trial, could be the basis for a damage award which would fully recompense plaintiff for the violations. See Panduit Corp. v. Stahlin Bros. Fibre Works, 575 F.2d 1152 (6th Cir. 1978); H.K. Porter Co., Inc. v. Goodyear Tire & Rubber Comp., 536 F.2d 1115 (6th Cir. 1976).

It is true that if plaintiff's patent were to expire prior to a decision finding the patent valid and infringed, the plaintiff's anticipated position as a major supplier of the windshield wiper systems would be undermined. The short answer to this contention is that this action will be completed before the expiration date of plaintiff's patent. The Court would therefore be able to enjoin the infringement of this patent if plaintiff is successful on the merits and plaintiff would be allowed the marketing foothold which he fears would otherwise be lost.

Pursuant to the foregoing, the Court will deny plaintiff's Motion for a Preliminary Injunction.

IT IS SO ORDERED.

/s/ Philip Pratt

PHILIP PRATT

United States District Judge

Dated: January 10, 1980

Detroit, Michigan

Plaintiffs 956 Exhibit	Intermittent Windshield Wipers **Profit as a Share of Revenues** All U.S. and Canadian Vehicles 1978 - 1988

Year	U.S.		Canada	
	Variable Profit	Net Profit	Variable Profit	Net Profit
1978	0.80	0.76	0.90	0.89
1979	0.86	0.83	0.87	0.86
1980	0.86	0.82	0.87	0.83
1981	0.81	0.73	0.83	0.75
1982	0.84	0.76	0.86	0.79
1983	0.86	0.81	0.87	0.86
1984	0.86	0.82	0.86	0.80
1985	0.87	0.84	0.86	0.81
1986	0.86	0.81	0.84	0.80
1987	0.86	0.85	0.83	0.82
1988	$0.93	$0.92	$0.93	$0.92
Weighted Average	0.85	0.82	0.87	0.83

Weighted Average All U.S. and Canada	0.85	0.82

A-Q

Patent 3,351,836

Claim 4:

"In combination with a vehicle having a windshield, a windshield cleaning system comprising wiper blade means slidably engaging said windshield, motor actuated drive means for driving said wiper blade means through repeating wiping cycles, and automatic control means for activating said drive means to drive said wiper blade means through said repeating wiping cycles, said automatic control means including means for automatically varying the time between wiping cycles in response to the degree of dryness of the windshield."

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THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

Whereas, THERE HAS BEEN PRESENTED TO THE

Commissioner of Patents

A PETITION PRAYING FOR THE GRANT OF LETTERS PATENT FOR AN ALLEGED NEW AND USEFUL INVENTION THE TITLE AND DESCRIPTION OF WHICH ARE CONTAINED IN THE SPECIFICATION OF WHICH A COPY IS HERETO ANNEXED AND MADE A PART HEREOF, AND THE VARIOUS REQUIREMENTS OF LAW IN SUCH CASES MADE AND PROVIDED HAVE BEEN COMPLIED WITH, AND THE TITLE THERETO IS, FROM THE RECORDS OF THE PATENT OFFICE IN THE CLAIMANT(S) INDICATED IN THE SAID COPY, AND WHEREAS, UPON DUE EXAMINATION MADE, THE SAID CLAIMANT(S) IS(ARE) ADJUDGED TO BE ENTITLED TO A PATENT UNDER THE LAW.

NOW, THEREFORE, THESE Letters Patent ARE TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF SEVENTEEN YEARS FROM THE DATE OF THIS GRANT, SUBJECT TO THE PAYMENT OF ISSUE FEES AS PROVIDED BY LAW, THE RIGHT TO EXCLUDE OTHERS FROM MAKING, USING OR SELLING THE SAID INVENTION THROUGHOUT THE UNITED STATES.

In testimony whereof I have hereunto set my hand and caused the seal of the Patent Office to be affixed at the City of Washington this fifth day of June, in the year of our Lord one thousand nine hundred and seventy-three, and of the Independence of the United States of America the one hundred and ninety-seventh.

Attest:

Attesting Officer

Commissioner of Patents

... TO GRANT UNTO THE SAID CLAIMANT(S) AND THE SUCCESSORS, HEIRS OR ASSIGNS OF THE SAID CLAIMANT(S) FOR THE TERM OF **SEVENTEEN** YEARS FROM THE DATE OF THIS GRANT, ... (Emphasis added.)

A-5

judgment because Dr. Burzynski allegedly defrauded the Respondent by not advising it that his treatment was illegal in Texas. There is a direct conflict between the federal courts and the Texas state court. Petitioner urges this Court to at least hear the case and decide whether the lower federal courts improperly interfered with the state judicial process.

REPLY

Petitioner wishes to correct several misstatements contained in Respondent's Brief.

1. Respondent asserts that the Medical Board's licensing case was commenced "long after" the federal district court granted summary judgment in late 1992. (See Respondent's Brief at page 3.) This is incorrect. The medical licensing case was commenced in August 1988. Based its inaccurate time sequence, Respondent incorrectly argues that the "subsequently" filed medical board case is no reason for a federal court to abstain from deciding this "previously" filed federal case.

In any event, the previously filed medical board case was *the* proceeding by which the legality of Dr. Burzynski's treatment was to be determined. Thus, Respondent's analogy to concurrent federal and state bank robbery prosecutions (for different banks) is not analogous, and its attempt to deny or downplay the logical relationship between the two cases is unpersuasive.

2. Respondent claims that Petitioner did not raise

abstention prior to the appeal. (Respondent's Brief at page 4). This is incorrect. In opposition to Plaintiff's Motion for Summary Judgment, Petitioner suggested that abstention may be appropriate if the district court was considering making a ruling on Texas law. However, Petitioner argued that the district court did not have to make a ruling on Texas law.

In his Motion to Reargue submitted to the district court, Petitioner urged the court to rescind its ruling on Texas law because of the pending state court proceedings.

In any event, abstention is not a waivable argument, and a court may abstain *sua sponte, Bellotti v. Baird,* 428 U.S. 132, 49 L.Ed.2d 844, 96 S.Ct. 2857 (1976), *Muskegon Theatres, Inc. v. Muskegon*, 507 F.2d 199 (6th Cir.1974), even on appeal *AFA Distributing Co. v. Pearl Brewing Co.*, 470 F.2d 1210, (4th Cir. 1973).

3. Respondent incorrectly characterized the Texas Administrative Law Judge's decision as being related to burden of proof. (Respondent's Brief at page 3). Administrative Law Judge Corbitt made it abundantly clear that in his opinion, as a matter of law, it is and always was legal for Dr. Burzynski to use his medications. The Medical Board's decision reversing Judge Corbitt stated that it was illegal for Dr. Burzynski to use his medicine on patients, which decision has itself been reversed. Therefore, it mischaracterizes the state proceedings for

§ 40. Same; contents and duration

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant) throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. R.S. § 4884; May 23, 1930, c. 312, § 1, 46 Stat. 376.

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§ 154. Contents and term of patent

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. July 19, 1952, c. 950, § 1, 66 Stat. 804. (Emphasis added.)

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Dr. Kearns Cross-Examination of Expert Witness George Frost

Transcript p. 2581:

CROSS EXAMINATION BY DR. KEARNS

Q Mr. Frost, I was wondering if you had seen the words before.

DR. KEARNS: This is Plaintiff's Exhibit 675, your Honor. (reproduced here)

"(T)he patent system provides a **protected market** with the opportunity for **unusual profit** necessary to justify the heavy investment in time, effort, and capital necessary to bring the improvement to the public. This same **protected market** provides an **entering wedge** by which a business enterprise entering a new field can overcome the obstacles that otherwise discourage entry into an industry already populated[1]."

A Should I answer?

Yes.

Q And you are the author of those words?

A Those are words taken from a very substantial document I

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[1] Congressional Library Microfilm #11997.

H-V

prepared for the U.S. Senate, that is correct.

Q How old were you when you wrote those words?

A I would have to do some figuring, Dr. Kearns. I imagine that was, about 1957. I was about 40 years old I guess, somewhere around there.

Q These words say that the patent system provides a protected market.

A That is correct. ...

Q What happens when they infringe that patent and remove the right of a protected market?

A Then we go to the patent law provisions, Dr. Kearns, and they provide the remedies.

Q Now, sir, do you understand that I carried you words as a banner for a major portion of my life?

A Well, I'm flattered, if you did, sir. I appreciate that.

Q And I have quoted these words for the last 15 years so I am pleased -- I am truly pleased to have an opportunity to meet you ...

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CROSS EXAMINATION (CONTINUED)
BY DR. KEARNS.

Q Good morning.

A Morning.

Q Mr. Frost, I'm putting Plaintiff's Exhibit 675 before you again.
On the matter of these words, Mr. Frost, were you backing away from these words yesterday?

A No.

THE COURT: Keep you [sic] voice up, Mr. Frost.

A No, I was not.

Q (By Dr. Kearns, continuing:) Now, for the subcommittee of Patents and Copyrights for the Senate Committee of the Judiciary, what was your role, or does that fit your writing, *The Patent System in the Modern Economy*, how does that fit in with the study of the Senate Committee?

A I was asked by Senator O'Mahoney to write a paper he had in mind giving the views of people he respected in the field. And I was asked to write a paper expressing my

views as to what the patent system was all about, how it operated, and particularly from the standpoint of the economics and that type of thing.

And he wanted to have someone do it who is a card-carrying patent lawyer and also knows the economics and the antitrust law, and had been doing a good deal of teaching. And those are the reasons he asked me.

I did not have to connect it up with anything, the committee did. It was simply a request I was asked to do for the U.S. Senate, and it had nothing to do particularly with either the views of Senator O'Mahoney, or general counsel of the committee, or anyone else. It was just, please tell us what you think, type of thing.

Q Well, did they put a stamp of approval on it, or was it simply like calling an expert into court and you can simply state your own views?

A Well, it certainly wasn't like -- they put no stamp of approval on it. They did publish it and I think if you'll check, you'll find they put out a notice that said, in effect, they thought the views were to be respected and they offered them for consideration of everyone involved in the field.

But they did not say that they agreed with everything, nor did they say they disagreed.

THE COURT: Mr. Frost?

A Yes, sir.

THE COURT: Were your views released as part of an act of congress?

A Only in the sense the committee had an appropriation, and the act of congress in giving the committee an appropriation, I believe -- I cannot be certain -- but I believe it called for studies at the option of the subcommittee.